EXHIBIT H

Chapter 1400 Correction of Patents

1400.01 Introduction
1401 Reissue
1402 Grounds for Filing
1403 Diligence in Filing
1404 Submission of Papers Where Reissue Patent Is in Litigation
1405 Reissue and Patent Term
1406 Citation and Consideration of References Cited in Original Patent
1410 Content of Reissue Application
1410.01 Reissue Applicant, Oath or Declaration, and Consent of All Assignees
1411 Form of Specification
1411.01 Certificate of Correction or Disclaimer in Original Patent
1411.02 New Matter
1412 Content of Claims
1412.01 Reissue Claims Must Be for Same General Invention
1412.02 Recapture of Canceled Subject Matter
1412.03 Broadening Reissue Claims
1412.04 Correction of Inventorship
1413 Drawings
1414 Content of Reissue Oath/Declaration
1414.01 Supplemental Reissue Oath/ Declaration
1415 Reissue Application and Issue Fees
1415.01 Maintenance Fees on the Original Patent
1416 No Physical Surrender of Original Patent
1417 Claim for Benefit Under 35 U.S.C. 119(a)-(d)
1418 Notification of Prior/Concurrent Proceedings and Decisions Thereon, And of Information Known To Be Material To Patentability
1430 Reissue Files Open to the Public and, Notice of Filing Reissue Announced in, *Official Gazette*
1440 Examination of Reissue Application
1441 Two-Month Delay Period
1441.01 Protest in Reissue Applications
1442 Special Status
1442.01 Litigation-Related Reissues
1442.02 Concurrent Litigation
1442.03 Litigation Stayed
1442.04 Litigation Involving Patent
1442.05 Court Ordered Filing of Reissue Application
1443 Initial Examiner Review
1444 Review of Reissue Oath/Declaration
1445 Reissue Application Examined in Same Manner as Original Application
1448 Fraud, Inequitable Conduct, or Duty of Disclosure Issues
1449 Protest Filed in Reissue Where Patent Is in Interference
1449.01 Concurrent Office Proceedings
1449.02 Interference in Reissue
1450 Restriction and Election of Species Made in Reissue Application
1451 Divisional Reissue Applications; Continuation Reissue Applications Where the Parent is Pending
1452 Request for Continued Examination of Reissue Application
1453 Amendments to Reissue Applications
1454 Appeal Brief
1455 Allowance and Issue
1456 Reissue Review
1457 Design Reissue Applications and Patents
1460 Effect of Reissue
1470 Public Access of Reissue Applications
1480 Certificates of Correction — Office Mistake
1480.01 Expedited Issuance of Certificates of Correction — Error Attributable to Office
1481 Certificates of Correction – Applicant's Mistake
1481.01 Correction of Assignees' Names
1481.02 Correction of Inventors' Names
1481.03 Correction of 35 U.S.C. 119 and 35 U.S.C. 120 Benefits
1485 Handling of Request for Certificates of Correction
1490 Disclaimers

1400.01 Introduction [R-2]

A patent may be corrected or amended in four ways, namely:

(A) by reissue,

(B) by the issuance of a certificate of correction which becomes a part of the patent,

(C) by disclaimer, and

(D) by reexamination.

The first three ways are discussed in this chapter while the fourth way (reexamination) is discussed in MPEP Chapter 2200 >for *ex parte* reexamination and MPEP Chapter 2600 for *inter partes* reexamination<.

1401 Reissue [R-3]

35 U.S.C. 251. Reissue of defective patents.

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

The provisions of 35 U.S.C. 251 permit the reissue of a patent to correct an error in the patent made without any deceptive intention and provide criteria for the reissue. 37 CFR 1.171 through *>1.178< are rules directed to reissue.

1402 Grounds for Filing [R-5]

A reissue application is filed to correct an error in the patent which was made without any deceptive intention, where, as a result of the error, the patent is deemed wholly or partly inoperative or invalid. An error in the patent arises out of an error in conduct which was made in the preparation and/or prosecution of the application which became the patent.

There must be at least one error in the patent to provide grounds for reissue of the patent. If there is no error in the patent, the patent will not be reissued. The present section provides a discussion of what may be considered an error in the patent upon which to base a reissue application.

In accordance with 35 U.S.C. 251, the error upon which a reissue is based must be one which causes the patent to be "deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent." Thus, an error under 35 U.S.C. 251 *has not been presented* where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. 251. These corrections to a patent do not provide a basis for reissue (although these corrections may also be included in a reissue application, where a 35 U.S.C. 251 error is already present).

These corrections may be made via a certificate of correction; see MPEP § 1481.

The most common bases for filing a reissue application are:

(A) the claims are too narrow or too broad;

(B) the disclosure contains inaccuracies;

(C) applicant failed to or incorrectly claimed foreign priority; and

(D) applicant failed to make reference to or incorrectly made reference to prior copending applications.

An attorney's failure to appreciate the full scope of the invention was held to be an error correctable through reissue in the decision of *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). The correction of misjoinder of inventors in divisional reissues has been held to be a ground for reissue. See *Ex parte Scudder*, 169 USPQ 814 (Bd. App. 1971).The Board of Appeals held in *Ex parte Scudder*, 169 USPQ at 815, that 35 U.S.C. 251 authorizes reissue application to correct misjoinder of inventors where 35 U.S.C. 256 is inadequate.

Reissue may no longer be necessary under the facts in *Ex parte Scudder, supra,* in view of 35 U.S.C. 116 which provides, *inter alia*, that:

> "Inventors may apply for a patent jointly even though . . . (3) each did not make a contribution to the subject matter of every claim in the patent."

See also 37 CFR 1.45(b)(3).

If the only change being made in the patent is correction of the inventorship, this can be accomplished by filing a request for a certificate of correction under the provisions of 35 U.S.C. 256 and 37 CFR 1.324. See MPEP § 1412.04 and § 1481. A Certificate of Correction will be issued if all parties are in agreement and the inventorship issue is not contested..

A reissue was granted in *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968), where the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under 35 U.S.C. 119(a)-(d) before the patent was granted.

In *Brenner*, the claim for priority had been made in the prosecution of the original patent, and it was only necessary to submit a certified copy of the priority document in the reissue application to perfect priority. Reissue is also available to convert the "error" in failing to take any steps to obtain the right of foreign priority under 35 U.S.C. 119(a)-(d) before the patent was granted. >See *Fontijn v. Okamoto*, 518 F.2d 610, 622, 186 USPQ 97, 106 (CCPA 1975) ("a patent may be reissued for the purpose of establishing a claim to priority which was not asserted, or which was not perfected during the prosecution of the original application")< In a situation where it is necessary to submit for the first time both the claim for priority and the certified copy of the priority document in the reissue application, and the patent to be reissued resulted from a utility or plant application which became the patent to be reissued was filed on or after November 29, 2000, the reissue applicant must (where it is necessary to submit for the first time the claim for priority) also file a petition for an unintentionally delayed priority claim under 37 CFR 1.55(c) in addition to filing a reissue application. See MPEP § 201.14(a).

The courts have not addressed the question of correction of the failure to adequately claim benefit under 35 U.S.C. 119(e) in the application (which became the patent to be reissued) via reissue. If the application which became the patent to be reissued was filed prior to November 29, 2000, correction as to benefit under 35 U.S.C. 119(e) would be permitted in a manner somewhat analogous to that of the priority correction discussed above. **>Where< the application, which became the patent to be reissued, was filed on or after November 29, 2000>, reissue may be employed to correct an applicant's mistake by adding or correcting a benefit claim under 35 U.S.C. 119(e). A petition under 37 CFR 1.78(a)(6) for an unintentionally delayed claim under 35 U.S.C. 119(e) would <u>not</u> be required in addition to filing a reissue application.<

Section 4503 of the American Inventors Protection Act of 1999 (AIPA) amended 35 U.S.C. 119(e)(1) to state that:

> No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section ***during the pendency of the application***. (Emphasis added.)

**>The court in *Fontijn* held that 35 U.S.C. 251 was sufficiently broad to correct a patent where the applicant failed to assert or failed to perfect a claim for foreign priority during the prosecution of the original application even though 35 U.S.C. 119(b) at that time required a claim and a certified copy of the foreign application to be filed *before the patent is granted*. Similarly, the Office may grant a reissue for adding or correcting a benefit claim under 35 U.S.C.119(e) that requires the benefit claim to a provisional application be submitted *during the pendency of the application*.<

Correction of failure to adequately claim benefit under 35 U.S.C. 120 in an earlier filed copending U.S. patent application was held a proper ground for reissue. *Sampson v. Comm'r Pat.*, 195 USPQ 136, 137 (D.D.C. 1976). If the utility or plant application which became the patent to be reissued was filed on or after November 29, 2000, the reissue applicant must file a petition for an unintentionally delayed priority claim under 37 CFR 1.78(a)(3) in addition to filing a reissue application. See MPEP § 201.11. For treatment of an error involving disclaimer of a benefit claim under 35 U.S.C. 120, see MPEP 1405. If the utility or plant application which became the patent to be reissued was filed prior to November 29, 2000 and therefore, not subject to the eighteen-month publication (e.g., one of the categories set forth in 37 CFR 1.78(a)(2)(ii)(A) – (C)), a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) would <u>not</u> be required to add/correct the benefit claim in the reissue application. This is so, even if the reissue application was filed on or after November 29, 2000. On the other hand, if applicant fails to file an amendment to add a claim for benefit of a prior-filed reissue application in a later-filed reissue application within the time period set forth in 37 CFR 1.78(a)(2), then a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) along with the surcharge set forth in 37 CFR 1.17(t) would be required if the later-filed reissue application is a utility or plant application filed on or after November 29, 2000 irrespective of whether the original application which became the original patent was filed prior to November 29, 2000. This is because the benefit claim is between the later-filed reissue application and the prior-filed reissue application and the benefit claim is not being added to make a correction as to a benefit of the original patent.

A reissue applicant's failure to timely file a divisional application covering the non-elected invention(s) following a restriction requirement is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such applicant's error is not correctable by reissue of the original patent under 35 U.S.C. 251. See MPEP § 1412.01.

A reissue may be based on a drawing correction that is substantive in nature, because such a correction qualifies as correcting an "error" under 35 U.S.C. 251 that may properly be deemed to render the patent wholly or partly inoperative. A reissue application cannot be based on a non-substantive drawing change, such as a reference numeral correction or addition, the addition of shading, or even the addition of an additional figure merely to "clarify" the disclosure. Non-substantive drawing changes may, however, be included in a reissue application that corrects at least one substantive "error" under 35 U.S.C. 251.

1403 Diligence in Filing [R-3]

When a reissue application is filed within 2 years from the date of the original patent, a rejection on the grounds of lack of diligence or delay in filing the reissue should not normally be made. *Ex parte Lafferty*, 190 USPQ 202 (Bd. App. 1975); but see *Rohm & Haas Co. v. Roberts Chemical Inc.*, 142 F. Supp. 499, 110 USPQ 93 (S.W. Va. 1956), *rev'd on other grounds*, 245 F.2d 693, 113 USPQ 423 (4th Cir. 1957).

The fourth paragraph of 35 U.S.C. 251 states:

> "No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."

Where any broadening reissue application is filed within two years from the date of the original patent, 35 U.S.C. 251 presumes diligence, and the examiner should not inquire why applicant failed to file the reissue application earlier within the two year period.

See MPEP § 1412.03 for broadening reissue practice. See also *In re Graff*, 111 F.3rd 874, 42 USPQ2d 1471 (Fed. Cir. 1997); *In re Bennett*, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985); *In re Fotland*, 779 F.2d 31, 228 USPQ 193 (Fed. Cir. 1985).

A reissue application that is filed on the 2-year anniversary date of the patent grant is considered as being filed within 2 years. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) (a similar rule in interferences).

A reissue application can be granted a filing date without an oath or declaration, or without the >basic< filing fee>, search fee, or examination fee< being present. See 37 CFR 1.53(f). Applicant will be given a period of time to provide the missing parts and to pay the surcharge under 37 CFR 1.16(*>f<). See MPEP § 1410.01.

1404 Submission of Papers Where Reissue Patent Is in Litigation [R-2]

>Marking of envelope:< Applicants and protestors (see MPEP § 1901.03) submitting papers for entry in reissue applications of patents involved in litigation are requested to mark the outside envelope and the top right-hand portion of the papers with the words "REISSUE LITIGATION" and with the art unit or other area of the United States Patent and Trademark Office in which the reissue application is located, e.g., Commissioner for Patents, Board of Patent Appeals and Interferences, Office of Patent Legal Administration, Technology Center, Office of Patent Publication, etc. ** >Marking of papers:< Any "Reissue Litigation" papers mailed to the Office should be so marked. The markings preferably should be written in a bright color with a felt point marker. Papers marked "REISSUE LITIGATION" will be given special attention and expedited handling. >(For IFW processing, see IFW Manual.)< See MPEP § 1442.01 through § 1442.04 for examination of litigation-related reissue applications. >Protestor's participation, including the submission of papers, is limited in accordance with 37 CFR 1.291(c).<

>

1405 Reissue and Patent Term [R-2]

35 U.S.C. 251 prescribes the effect of reissue on the patent term by stating that "the Director shall... reissue the patent... for the unexpired term of the original patent."

The maximum term of the original patent is fixed at the time the patent is granted. While the term may be subsequently shortened, e.g., through the filing of a terminal disclaimer, it cannot be extended through the filing of a reissue. Accordingly, a deletion in a reissue application of an earlier-obtained benefit claim under 35 U.S.C. 120 will not operate to lengthen the term of the patent to be reissued.

When a reissue application has been filed in an attempt to delete an earlier-obtained benefit claim under 35 U.S.C. 120, it should be treated as follows:

(A) More than one "error" (as defined by 35 U.S.C. 251) is described in a reissue declaration, and one of the errors identified is the failure to delete a 35 U.S.C. 120 benefit claim in the original patent, or the erroneous making of a claim for 35 U.S.C. 120 benefit.

If one of the errors identified is the presence of the claim for 35 U.S.C. 120 benefit in the patent, and patentee (1) states a belief that this error renders the original patent wholly or partly inoperative or invalid, and (2) is seeking to eliminate this error via the reissue proceeding, the Office will permit entry of an accompanying amendment deleting the benefit claim in the continuity data, and will not object to or reject the reissue declaration. Assuming the reissue declaration appropriately identifies or describes at least one other error being corrected, the reissue declaration would not be objected to for failure to comply with the requirements of 37 CFR 1.175.

Where the reissue declaration states that the patentee is making this correction in order to extend the term of the original patent, the examiner's Office action will merely refer to the statement in the declaration and then point out with respect to such statement that 35 U.S.C. 251 only permits reissue "... for the unexpired part of the term of the original patent."

(B) Only one "error" (as defined by 35 U.S.C. 251) is described in a reissue declaration, and that error is the failure to delete a 35 U.S.C. 120 benefit claim in the original patent, or the erroneous making of a claim for 35 U.S.C. 120 benefit.

(1) If the only error identified in the reissue declaration is stated to be the correction or adjustment of the patent term by deleting the 35 U.S.C. 120 benefit claim, a rejection under 35 U.S.C. 251 should be made, based on the lack of an appropriate error for reissue and failure to comply with 37 CFR 1.175.

(2) If the only error identified in the reissue declaration is the need to delete a 35 U.S.C. 120 benefit claim, which the patentee seeks to now delete in the reissue application, (and no reference is made as to increasing the term of the patent), the examiner should not make a rejection under 35 U.S.C. 251 based on lack of an appropriate error for reissue and failure to comply with 37 CFR 1.175. The examiner should examine the reissue application in accordance with 37 CFR 1.176 (MPEP § 1440). A statement should, however, be made in an Office action pointing out the lack of effect (of the change in the patent) on the patent term because 35 U.S.C. 251 only permits reissue "... for the unexpired part of the term of the original patent."<

1406 Citation and Consideration of References Cited in Original Patent [R-3]

In a reissue application, the examiner should consider and list on a PTO-892 form all references that have been cited during the original prosecution of the patent. See MPEP § 1455. An exception to this practice might be where the references cited in the original patent may no longer be relevant, e.g., in view of a narrowing of the claim scope in the reissue application.

Should applicants wish to ensure that all of the references which were cited in the original patent are considered and cited in the reissue application, an information disclosure statement (IDS) in compliance with 37 CFR 1.97 and 1.98 should be filed in the reissue application. See MPEP § 609. **>The requirement for a copy of each U.S. patent or U.S. patent application publication listed in an IDS has been eliminated, unless required by the Office. 37 CFR 1.98(a)(2) requires

(A) a legible copy of each foreign patent,

(B) each publication or that portion which caused it to be listed,

(C) each pending unpublished U.S. application unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system. The requirement in 37 CFR 1.98(a)(2)(iii) for a legible copy of the specification, including the claims and drawings of each cited pending U.S. patent application (or portion of the application which caused it to be listed) is *sua sponte* waived where the cited pending application is stored in the Office' s IFW system. See *Waiver of the Copy Requirement in 37 CFR 1.98 for Cited Pending U.S. Patent Applications*, 1287 O.G. 163 (Oct. 19, 2004),

(D) all other information or that portion which caused it to be listed.

See MPEP § 609.04(a). The< Office imposes no responsibility on a reissue applicant to resubmit, in a reissue application, all the "References Cited" in the patent for which reissue is sought. Rather, applicant has a continuing duty under 37 CFR 1.56 to timely apprise the Office of any information which is material to the patentability of the claims under consideration in the reissue application. See MPEP § 1418.

Where a copy of a reference >other than a U.S. patent or U.S. patent application publication< is not available and cannot be obtained through any source other than the reissue applicant (who has not submitted the copy), the examiner will not indicate on PTO-892 or **>PTO/SB/08< submitted by applicant that a reference has been considered.

1410 Content of Reissue Application [R-3]

37 CFR 1.171. Application for reissue.

An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications.

37 CFR 1.173. Reissue specification, drawings, and amendments.

(a) *Contents of a reissue application.* An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application. No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent, pursuant to 35 U.S.C. 251.

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for papers making up the reissue application other than those set forth in this section are set out in § 1.52. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be included. (See also § 1.178).

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

*****

The specification (including the claims and any drawings) of the reissue application is the copy of the printed patent for which reissue is requested that is submitted by applicant as part of the initial application papers. The copy of the printed patent must be submitted in double column format, each page of double column format being on only one side of the piece of paper. It should be noted that a re-typed specification is not acceptable in a reissue application; the full copy of the printed patent must be used. In addition, an applicant for reissue is required to file a reissue oath or declaration which, in addition to complying with 37 CFR 1.63, must comply with 37 CFR 1.175. Where the patent has been assigned, the reissue applicant must also provide a consent of assignee to the reissue and evidence of ownership. Where the patent has not been assigned, the reissue applicant should affirmatively state that the patent is not assigned.

An amendment may be submitted at the time of filing of a reissue application. The amendment may be made either by:

(A) physically incorporating the changes within the specification by cutting the column of the printed patent and inserting the added material and rejoining the remainder of the column >and then joining the resulting modified column to the other column of the printed patent. Markings pursuant to 37 CFR 1.173(d) must be used to show the changes. The columnar structure of the printed patent must be preserved, and the physically modified page must comply with 37 CFR 1.52(a)(1). As to compliance with 37 CFR 1.52(a)(1)(iv), the "written either by a typewriter or machine printer in permanent dark ink or its equivalent" requirement is deemed to be satisfied where a caret and line are drawn from a position within the text to a newly added phrase, clause, sentence, etc. typed legibly in the margin<; or

(B) providing a separate amendment paper with the reissue application.

In either case, the amendment must be made pursuant to 37 CFR 1.173(b) and must comply with all the provisions of 37 CFR 1.173(b)– (e) and (g).

>If the changes to be made to the patent are so extensive that reading and understanding the specification is extremely difficult and error-prone, a clean, typed copy of the specification may be submitted if accompanied by a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1).<

Pursuant to 37 CFR 1.173(a)(1), applicant is required to include a copy of any disclaimer (37 CFR 1.321), certificate of correction (37 CFR 1.322 – 1.324), or reexamination certificate (37 CFR 1.520) issued in the patent for which reissue is requested. It should also be noted that 37 CFR 1.178(b) requires reissue applicants to call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigation (litigation covers any papers filed in the court or issued by the court, such as, for example, motions, pleadings, and court decisions including court orders) and the results of such proceedings. This duty to submit such information is a continuing duty, and runs from the time the reissue application is filed until the reissue application is abandoned or issues as a reissue patent.

It is no longer required that the reissue applicant **>physically< surrender the original patent, see MPEP § 1416**.

Where appropriate, the reissue applicant may provide a claim for priority benefit under 35 U.S.C. 119 or 120, and may also file an Information Disclosure Statement.

The initial contents of a reissue application are discussed in detail in MPEP § 1410.01 through § 1418.

For expedited processing, new and continuing reissue application filings under 37 CFR 1.53(b) may be addressed to: Mail Stop REISSUE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. Mail Stop REISSUE should only be used for the initial filing of reissue applications, and should not be used for any subsequently filed correspondence in reissue applications. All new reissue filings should include a copy of a completed Reissue Patent Application Transmittal Form (PTO/SB/50) to ensure that the filing of the new application will be recognized as being for a reissue application.

The oath or declaration, any matters ancillary thereto (such as the consent of assignee), and the >basic< filing fee>, search fee, and examination fee< may be submitted after the filing date pursuant to 37 CFR 1.53(f).

The requirement for the assignee to consent to filing a reissue no longer includes a requirement for applicant to order a title report with the filing of the reissue application. Rather, the assignee entity is established by a statement on behalf of all the assignees under 37 CFR 1.172(a) and 37 CFR 3.73(b). See MPEP § 1410.01.

Form PTO/SB/50, Reissue Patent Application Transmittal, may be used for filing reissue applications.

**>

PTO/SB/50 (04-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REISSUE PATENT APPLICATION TRANSMITTAL

Address to: **Mail Stop Reissue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450**	Attorney Docket No.	
	First Named Inventor	
	Original Patent Number	
	Original Patent Issue Date (Month/Day/Year)	
	Express Mail Label No.	

APPLICATION FOR REISSUE OF: *(Check applicable box)* ☐ Utility Patent ☐ Design Patent ☐ Plant Patent

APPLICATION ELEMENTS (37 CFR 1.173)

1. ☐ Fee Transmittal Form (PTO/SB/56) (Submit a duplicate copy)
2. ☐ Applicant claims small entity status. See 37 CFR 1.27.
3. ☐ Specification and Claims in double column copy of patent format *(amended, if appropriate)*
4. ☐ Drawing(s) *(proposed amendments, if appropriate)*
5. ☐ Reissue Oath/Declaration (original or copy) (37 C.F.R. 1.175) (PTO/SB/51 or 52)
6. ☐ Power of Attorney
7. ☐ Original U.S. Patent currently assigned? ☐ Yes ☐ No
   (If Yes, check applicable box(es))
   ☐ Written Consent of all Assignees (PTO/SB/53)
   ☐ 37 CFR 3.73(b) Statement (PTO/SB/96)
8. ☐ CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table
   ☐ Landscape Table on CD
9. Nucleotide and/or Amino Acid Sequence Submission *(if applicable, items a. – c. are required))*
   a. ☐ Computer Readable Form (CRF)
   b. Specification Sequence Listing on:
      i ☐ CD-ROM (2 copies) or CD-R (2 copies); or
      ii ☐ paper
   c. ☐ Statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

10. ☐ Statement of status and support for all changes to the claims. See 37 CFR 1.173(c).
11. ☐ Foreign Priority Claim (35 U.S.C. 119) *(if applicable)*
12. ☐ Information Disclosure Statement (IDS) PTO/SB/08 or PTO-1449
    ☐ Copies of foreign patent documents, publications & other information
13. ☐ English Translation of Reissue Oath/Declaration *(if applicable)*
14. ☐ Preliminary Amendment
15. ☐ Return Receipt Postcard (MPEP 503) (Should be specifically itemized)
16. ☐ Other:

17. CORRESPONDENCE ADDRESS

☐ The address associated with *Customer Number:* ________ **OR** ☐ *Correspondence address below*

Name					
Address					
City		State		Zip Code	
Country		Telephone		Email	

Signature		Date	
Name (Print/Type)		Registration No. (Attorney/Agent)	

This collection of information is required by 37 CFR 1.173. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Mail Stop Reissue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

<

1410.01 Reissue Applicant, Oath or Declaration, and Consent of all Assignees [R-5]

37 CFR 1.172. Applicants, assignees.

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. All assignees consenting to the reissue must establish their ownership interest in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(b) of this chapter.

(b) A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

37 CFR 3.73. Establishing right of assignee to take action.

*****

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

**>

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or<

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

The reissue oath must be signed and sworn to by all the inventors, or declaration made by all the inventors, except as otherwise provided in 37 CFR 1.42, 1.43, and 1.47 (see MPEP § 409). Pursuant to 37 CFR 1.172, where the reissue application does *not* seek to enlarge the scope of any of the claims of the original patent, the reissue oath may be made and sworn to, or declaration made, by the assignee of the entire interest. Depending on the circumstances, either Form PTO/SB/51, Reissue Application Declaration by the Inventor, or Form PTO/SB/52, Reissue Application Declaration by the Assignee, may be used to prepare a declaration in a reissue application. These forms are reproduced in MPEP § 1414.

If an inventor is to be added in a reissue application, a proper reissue oath or declaration including the signatures of all of the inventors is required. If one or more inventors are being deleted in a reissue application, an oath or declaration must be supplied over the signatures of the remaining inventors. Note that although an inventor being deleted in a reissue application need not sign the oath or declaration, if that inventor to be deleted has any ownership interest in the patent (e.g., that inventor did not assign away his/her rights to the patent), the signature of that inventor must be supplied in the consent to filing the reissue application. See MPEP § 1412.04 as to correction of inventorship via reissue.

I. CONSENT TO THE REISSUE

Where no assignee exists, applicant should affirmatively state that fact. This can be done by simply checking the "NO" box of item 7 of Form PTO/SB/50 (which form may be signed by the inventors, or by a registered practitioner). If the file record is silent as to the existence of an assignee, it will be presumed that *an assignee does exist.* This presumption should be set forth by the examiner in the first Office action alerting applicant to the requirement. It should be noted that the mere filing of a written assertion of small entity status in no way relieves applicant of the requirement to affirmatively state that no assignee exists.

Where a written assertion of small entity status, or other paper in file indicates that the application/patent is assigned, and there is no consent by the assignee named in the written assertion of small entity, the examiner should make inquiry into the matter in an Office action, even if the record otherwise indicates that the application/patent is not assigned.

The reissue oath or declaration must be accompanied by the written consent of all assignees. 35 U.S.C. 111(a) and 37 CFR 1.53(b) provide, however, for according an application a filing date if filed with a specification, including claim(s), and any required drawings. Thus, where an application is filed without an oath or declaration, or without the consent of all assignees, if the application otherwise complies with 37 CFR 1.53(b) and the reissue rules, the Office of Initial Patent Examination (OIPE) will accord a filing date and send out a notice of missing parts setting a period of time for filing the missing part and for payment of any surcharge required under 37 CFR 1.53(f) and 1.16(f). If the reissue oath or declaration is filed but the assignee consent is lacking, the surcharge is required because, until the consent is filed, the reissue oath or declaration is defective, since it is not apparent that the signatures thereon are proper absent an indication that the assignees have consented to the filing.

The consent of assignee must be signed by a party authorized to act on behalf of the assignee. See MPEP § 324 for a discussion of parties authorized to act on behalf of the assignee. The consent to the reissue application may use language such as:

The XYZ Corporation, assignee of U.S. Patent No. 9,999,999, consents to the filing of reissue application No. 09/999,999 (or the present application, if filed with the initial application papers) for the reissue of U.S. Patent No. 9,999,999.

____

Lilly M. Schor

Vice President,

XYZ Corporation

Where the written consent of all the assignees to the filing of the reissue application cannot be obtained, applicant may under appropriate circumstances petition to the Office of Petitions (MPEP § 1002.02(b)) for a waiver under 37 CFR 1.183 of the requirement of 37 CFR 1.172, to permit the acceptance of the filing of the reissue application. The petition fee under 37 CFR 1.17(f) must be included with the petition.

The reissue application can then be examined, but will not be allowed or issued without the consent of all the assignees as required by 37 CFR 1.172. See *Baker Hughes Inc. v. Kirk*, 921 F.Supp. 801, 809, 38 USPQ2d 1885, 1892 (D.D.C. 1995), N. B. Fassett, 1877 C.D. 32, 11 O.G 420 (Comm'r Pat. 1877); *James D. Wright*, 1876 C.D. 217, 10 O.G 587 (Comm'r Pat. 1876).

Where a **continuation** reissue application is filed with a copy of the assignee consent from the parent reissue application, and the parent reissue application is not to be abandoned, the copy of the consent should not be accepted. Where a **divisional** reissue application is filed with a copy of the assignee consent from the parent reissue application, regardless of whether or not the parent reissue application is to be abandoned, the copy of the consent should not be accepted. The copy of the consent from the parent does not indicate that the assignee has consented to the addition of the new invention of the divisional reissue application to the original patent, or to the addition of the new error correction of the continuation reissue application. (Presumably, a new correction has been added via the continuation, since the parent is still pending.) As noted above, OIPE will accord a filing date and send out a notice of missing parts stating that there is no proper consent and setting a period of time for filing the missing part and for payment of any surcharge required under 37 CFR 1.53(f) and 1.16(f)

Where a continuation reissue application is filed with a copy of the assignee consent from the parent reissue application, and the parent reissue application is, or will be abandoned, the copy of the consent should be accepted by the Office.

Form paragraph 14.15 may be used to indicate that the consent of the assignee is lacking.

¶ *14.15 Consent of Assignee to Reissue Lacking*

This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

Examiner Note:

1. This form paragraph may be used in an Office action which rejects any of the claims on other grounds.
2. If a consent document/statement has been submitted but is insufficient (e.g., not by all the assignees) or is otherwise ineffective (e.g., a conditional consent, or a copy of the consent from the parent reissue application was filed in this continuation reissue application and the parent reissue application is not being abandoned), an explanation of such is to be included following this form paragraph.
3. If the case is otherwise ready for allowance, this form paragraph should be followed by form paragraph 7.51 (insert the phrase --See above-- in bracket 1 of form paragraph 7.51).

II. PROOF OF OWNERSHIP OF ASSIGNEE

The assignee that consents to the filing of the reissue application (as discussed above) must also establish that it is the assignee, *i.e.*, the owner, of the patent. See 37 CFR 1.172. *Accordingly, a 37 CFR 3.73(b) paper establishing the ownership of the assignee should be submitted at the time of filing the reissue application, in order to support the consent of the assignee.* The assignee must establish its ownership in accordance with 37 CFR 3.73(b) by:

(A) filing in the reissue application documentary evidence of a chain of title from the original owner to the assignee; or

(B) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

**Compliance with 37 CFR 3.73(b) may be provided as part of the same paper in which the consent by assignee is provided.

>In connection with option (A) above, the submission of the documentary evidence to establish ownership must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owners to the assignee was, or concurrently is, submitted for recordation pursuant to 37 CFR 3.11. Thus, when filing a 37 CFR 3.73(b) statement to establish ownership, an applicant or patent owner must also submit the relied-upon assignment document(s) to the Office for recordation, unless such a submission has already been previously made. If the 37 CFR 3.73(b) statement is not accompanied by a statement affirming that the documentary evidence was, or concurrently is, submitted for recordation pursuant to 37 CFR 3.11, then the 37 CFR 3.73(b) statement will **not** be accepted, and the assignee(s) will not have established the right to take action in the patent application or the patent for which the 37 CFR 3.73(b) statement was submitted. This could result, for example, in an incomplete response, where a party stated to be the "assignee" signs a consent to the reissue to obviate a requirement for submission of assignee consent made in an Office action.<

Upon initial receipt of a reissue application, the examiner should inspect the application to determine whether the submission under 37 CFR 1.172 and 37 CFR 3.73(b) establishing the ownership of the assignee is present and sufficient.

If an assignment document is attached with the 37 CFR 3.73(b) submission, the assignment should be reviewed to ensure that the named assignee is the same for the assignment document and the 37 CFR 3.73(b) statement, and that the assignment document is an assignment of the patent to be reissued to the assignee. If an assignment document is not attached with the 37 CFR 3.73(b) statement, but rather the reel and frame number where the assignment document is recorded in the USPTO is referenced in the 37 CFR 3.73(b) statement, it will be presumed that the assignment recorded in the USPTO supports the statement identifying the assignee. It will not be necessary for the examiner to obtain a copy of the recorded assignment document. If the submission under 37 CFR 1.172 and 37 CFR 3.73(b) is not present, form paragraph 14.16 may be used to indicate that the assignee has not provided evidence of ownership.

¶ *14.16 Failure of Assignee To Establish Ownership*

This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

Examiner Note:

1. This form paragraph may be used in an Office action which rejects any of the claims on other grounds.

2. If otherwise ready for allowance, this form paragraph should be followed by form paragraph 7.51 (insert the phrase --See above-- in bracket 1 of form paragraph 7.51).

Just as the consent of assignee must be signed by a party authorized to act on behalf of the assignee, the submission with respect to 37 CFR 3.73(b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. The signature of an attorney or agent registered to practice before the Office is not sufficient, unless that attorney or agent is authorized to act on behalf of the assignee.

If the submission under 37 CFR 3.73(b) to establish ownership is not signed by a party authorized to act on behalf of the assignee, the appropriate paragraphs of form paragraphs 14.16.01 through 14.16.06 may be used.

**>

¶ *14.16.01 Establishment of Ownership Not Signed by Appropriate Party*

This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172*(a). The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission is an appropriate party to sign on behalf of the assignee. 37 CFR 3.73(b)

A proper submission establishing ownership interest in the patent, pursuant to 37 CFR 1.172(a), is required in response to this action.

Examiner Note:

1. This form paragraph should be followed: by one of form paragraphs 14.16.02 through 14.16.04, and then optionally by form paragraph 14.16.06.

2. See MPEP § 1410.01.

<

¶ *14.16.02 Failure To State Capacity To Sign*

The person who signed the submission establishing ownership interest has failed to state his/her capacity to sign for the corporation or other business entity, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

Examiner Note:

1. This form paragraph is to be used when the person signing the submission establishing ownership interest does not state his/her capacity (e.g., as a recognized officer) to sign for the assignee, and is not established as being authorized to act on behalf of the assignee.

2. Use form paragraph 14.16.06 to explain how an official, other than a recognized officer, may properly sign a submission establishing ownership interest.

¶ *14.16.03 Lack of Capacity To Sign*

The person who signed the submission establishing ownership interest is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

¶ *14.16.04 Attorney/Agent of Record Signs*

The submission establishing ownership interest was signed by applicant's [1]. An attorney or agent of record is not authorized to sign a submission establishing ownership interest, unless he/she has been established as being authorized to act on behalf of the assignee. See MPEP § 324.

Examiner Note:

1. This form paragraph is to be used when the person signing the submission establishing ownership interest is an attorney or agent of record who is not an authorized officer as defined in MPEP § 324 and has not been established as being authorized to act on behalf of the assignee.

2. Use form paragraph 14.16.06 to explain how an official, other than a recognized officer, may properly sign a submission establishing ownership interest.

3. In bracket 1, insert either --attorney-- or --agent--.

¶ *14.16.06 Criteria To Accept When Signed by a Non-Recognized Officer*

It would be acceptable for a person, other than a recognized officer, to sign a submission establishing ownership interest, provided the record for the application includes a duly signed statement that the person is empowered to sign a submission establishing ownership interest and/or act on behalf of the assignee.

Accordingly, a new submission establishing ownership interest which includes such a statement above, will be considered to be signed by an appropriate official of the assignee. A separately filed paper referencing the previously filed submission establishing ownership interest and containing a proper empowerment statement would also be acceptable.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.16.02, 14.16.03 or 14.16.04.

2. When one of form paragraphs 14.16.02, 14.16.03 or 14.16.04 is used to indicate that a submission establishing ownership interest is not proper because it was not signed by a recognized officer, this form paragraph should be used to point out one way to correct the problem.
3. While an indication of the person's title is desirable, its inclusion is not mandatory when this option is employed.

Where the submission establishes the assignee's ownership as to the patent, ownership as to the reissue application will be presumed. Accordingly, a submission as to the ownership of the patent will be construed to satisfy the 37 CFR1.172 (and 37 CFR 3.73(b)) requirements for establishing ownership of the application. Thus, a terminal disclaimer can be filed in a reissue application where ownership of the patent has been established, without the need for a separate submission under 37 CFR 3.73(b) showing ownership of the reissue application.

Even if the submission states that it is establishing ownership of the reissue application (rather than the patent), the submission should be accepted by the examiner as also establishing ownership in the patent. The documentation in the submission establishing ownership of the reissue application must, of necessity, include chain of title as to the patent.

III. COMPARISON OF ASSIGNEE THAT CONSENTS TO ASSIGNEE SET FORTH IN SUBMISSION ESTABLISHING OWNERSHIP INTEREST

The examiner must inspect both the consent and documentary evidence of ownership to determine whether the requirements of 37 CFR 1.172 have been met. The assignee identified by the documentary evidence must be the same assignee which signed the consent. Also, the person who signs the consent for the assignee and the person who signs the submission of evidence of ownership for the assignee must both be persons having authority to do so. See also MPEP § 324.

The reissue patent will be granted to the original patentee, his or her legal representatives or assigns as the interest may appear.

1411 Form of Specification [R-3]

37 CFR 1.173. Reissue specification, drawings, and amendments.

(a) *Contents of a reissue application.* An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application. No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent, pursuant to 35 U.S.C. 251.

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for papers making up the reissue application other than those set forth in this section are set out in § 1.52. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be included. (See also § 1.178).

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

*****

The file wrappers of all /08 and earlier series reissue applications are stamped "REISSUE" above the application number on the front of the file. "Reissue" also appears below the application number on the printed label on the file wrapper of the application with 08/ and earlier series.

Reissue applications filed after July of 1998 (09/ series and later) are placed in an orange and white striped file wrapper and can be easily identified as reissue applications. (For IFW Processing, see IFW Manual.)

Reissue applications filed prior to November 7, 2000 should be furnished in the form of cut-up soft copies of the original patent, with only a single column of the printed patent securely mounted on a separate sheet of paper.

For reissue applications filed on or after November 7, 2000, 37 CFR 1.173(a)(1) requires that the application specification, including the claims, must be furnished in the form of a copy of the printed patent in double column format (so that the patent can be simply copied without cutting). Applicants are required to submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed (37 CFR 1.173(a)(2)). Any changes to the drawings must be made in accordance with 37 CFR 1.173(b)(3). Thus, a full copy of the printed patent (including the front page) is used to provide the abstract, drawings, specification, and claims of the patent for the reissue application. Each page of the patent must appear on only one side of each individual page of the specification of the reissue application; a two-sided copy of the patent is not proper. It should be noted that a re-typed specification is not acceptable in a reissue application; the full copy of the printed patent must be used. If, however, the changes to be made to the patent are so extensive/numerous that reading and understanding the specification is extremely difficult and error-prone, a clean copy of the specification may be submitted if accompanied by a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1).

Pursuant to 37 CFR 1.173(b), amendments may be made **at the time of filing** of a reissue application. The amendment may be made either by:

(A) physically incorporating the changes within the specification by cutting the column of the printed patent and inserting the added material and rejoining the remainder of the column >and then joining the resulting modified column to the other column of the printed patent. Markings pursuant to 37 CFR 1.173(d) must be used to show the changes. The columnar structure of the printed patent must be preserved, and the physically modified page must comply with 37 CFR 1.52(a)(1). As to compliance with 37 CFR 1.52(a)(1)(iv), the "written either by a typewriter or machine printer in permanent dark ink or its equivalent" requirement is deemed to be satisfied where a caret and line are drawn from a position within the text to a newly added phrase, clause, sentence, etc. typed legibly in the margin<; or

(B) providing a preliminary amendment (a separate amendment paper) directing that specified changes be made to the copy of the printed patent.

The presentation of the insertions or deletions as part of the original reissue specification is an amendment under 37 CFR 1.173(b). An amendment of the reissue application made at the time of filing of the reissue application must be made in accordance with 37 CFR 1.173(b)-(e) and (g); see MPEP § 1453. Thus, as required by 37 CFR 1.173(c), an amendment of the claims made at the time of filing of a reissue application must include a separate paper setting forth the status of all claims (i.e., pending or canceled), and an explanation of the support in the disclosure of the patent for the changes made to the claims.

If a chart, table, or chemical formula is amended and it spans two columns of the patent, it should not be split. Rather, the chart, table, or chemical formula should be provided in its entirety *as part of the column of the patent to which it pertains*, in order to provide a continuity of the description. When doing so, the chart, table, or chemical formula may extend beyond the width of the column. Change in only a part of a word or chemical formula is not permitted. Entire words or chemical formulas must be shown as being changed. Deletion of a chemical formula should be shown by brackets which are substantially larger and darker than any in the formula.

Where a terminal disclaimer was filed in the application for the patent to be reissued, a copy of that terminal disclaimer is not needed in the reissue application file. **>For a reissue application that is maintained in a paper file, the face of the file wrapper should be marked to indicate that a terminal disclaimer has been filed for the patent. For a reissue application that is maintained in IFW, the "Final SPRE Review" form will be filled in.<

Twice reissued patent:

Examples of the form for a twice-reissued patent are found in Re. 23,558 and Re. 28,488. Double underlining and double bracketing are used in the second reissue application, while **bold**-faced type and double bracketing appear in the printed patent (the second reissue patent) to indicate further insertions and deletions, respectively, in the second reissue patent.

When a copy of a first reissue patent is used as the specification of a second reissue application (filed as a reissue of a reissue), additions made by the first reissue will already be printed in italics, and should remain in such format. Thus, applicants need only present additions to the specification/claims in the second reissue application as double underlined text. Subject matter to be deleted from the first reissue patent should be presented in the second reissue application within sets of double brackets.

1411.01 Certificate of Correction or Disclaimer in Original Patent [R-2]

The applicant should include any changes, additions, or deletions that were made by a Certificate of Correction to the original patent grant in the reissue application without underlining or bracketing. The examiner should * make certain that all Certificate of Correction changes in the patent have been properly incorporated into the reissue application.

Certificate of Correction changes and disclaimer of claim(s) under 37 CFR 1.321(a) should be made without using underlining or brackets. Since these are part of the original patent and were made before the reissue was filed, they should show up in the printed reissue >patent< document as part of the original patent, i.e., not in italics or bracketed. If the changes are extensive and/or applicant has submitted them improperly with underlining and brackets, a clean copy of the specification with the Certificate of Correction changes in it may be requested by the examiner. >In order for the clean copy to be entered as a substitute specification, the reissue applicant must file a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1). The examiner' s request for the clean copy will generally serve as sufficient basis for granting the petition.<

1411.02 New Matter

New matter, that is, matter not present in the patent sought to be reissued, is excluded from a reissue application in accordance with 35 U.S.C. 251.

The claims in the reissue application must be for subject matter which the applicant had the right to claim in the original patent. *Any* change in the patent made via the reissue application should be checked to ensure that it does not introduce new matter. Note that new matter may exist by virtue of the omission of a feature or of a step in a method. See *United States Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 53 USPQ 6 (1942).

Form paragraph 14.22.01 may be used where new matter has been added anywhere in "the application for reissue" as prohibited by 35 U.S.C. 251.

¶ *14.22.01 Rejection, 35 U.S.C. 251, New Matter*

Claim [1] rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows: [2]

Examiner Note:

1. In bracket 2, fill in the applicable page and line numbers and provide an explanation of your position, as appropriate.
2. A rejection under 35 U.S.C. 112, first paragraph, should also be made if the new matter is added to the claims or is added to the specification and affects the claims. If new matter is added to the specification and does not affect the claims, an objection should be made based upon 35 U.S.C. 132 using form paragraph 7.28.

1412 Content of Claims

The content of claims in a reissue application is somewhat limited, as is indicated in MPEP § 1412.01 through MPEP § 1412.03.

1412.01 Reissue Claims Must Be for Same General Invention [R-2]

The reissue claims must be for the same invention as that *>**disclosed**< as being the invention in the original patent, as required by 35 U.S.C. 251. This does *not* mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention. The proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is "an essentially factual inquiry confined to the objective intent manifested by the **original patent**." *In re Amos*, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) (quoting *In re Rowand*, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975)) (emphasis added). See also *In re Mead*, 581 F.2d 257, 198 USPQ 412 (CCPA 1978). The "original patent" requirement of 35 U.S.C. 251 must be understood in light of *In re Amos, supra*, where the Court of Appeals for the Federal Circuit stated:

> We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the "original patent" clause if the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the

> specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.

953 F.2d at 618-19, 21 USPQ2d at 1275. Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

>The presence of< some disclosure (description and enablement) in the original patent should evidence that applicant intended to claim or that applicant considered the material now claimed to be his or her invention.

The original patent specification would indicate an intent not to claim the subject matter of the claims presented in the reissue application in a situation analogous to the following:

The original patent specification discloses that composition X is not suitable (or not satisfactory) for molding an item because composition X fails to provide quick drying. After the patent issues, it is found that composition X would be desirable for the molding in spite of the failure to provide quick drying, because of some other newly recognized benefit from composition X. A claim to composition X or a method of use thereof would not be permitted in a reissue application, because the original patent specification contained an explicit statement of intent *not* to claim composition X or a method of use thereof.

In most instances, however, the mere failure to claim a disclosed embodiment in the original patent (absent an explicit statement in the original patent specification of unsuitability of the embodiment) would **not** be grounds for prohibiting a claim to that embodiment in the reissue.

>FAILURE TO TIMELY FILE A DIVISIONAL APPLICATION PRIOR TO ISSUANCE OF ORIGINAL PATENT

Where a restriction requirement was made in an application and applicant permitted the elected invention to issue as a patent without the filing of a divisional application on the non-elected invention(s), the non-elected invention(s) cannot be recovered by filing a reissue application. A reissue applicant' s failure to timely file a divisional application covering the non-elected invention(s) in response to a restriction requirement is not considered to be error causing a patent granted on the elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Accordingly, such error is not correctable by reissue of the original patent under 35 U.S.C. 251. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). See also *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978). In this situation, the reissue claims should be rejected under 35 U.S.C. 251 for lack of defect in the original patent and lack of error in obtaining the original patent. Compare with *In re Doyle*, 293 F.3d 1355, 63 USPQ2d 1161 (Fed. Cir. 2002) where the court permitted the patentee to file a reissue application to present a so-called linking claim, a claim broad enough to read on or link the invention elected (and patented) together with the invention not elected. The non-elected invention(s) were inadvertently not filed as a divisional application.<

1412.02 Recapture of Canceled Subject Matter [R-5]

A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. >*North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005,< *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

I. THREE STEP TEST FOR RECAPTURE:

In Clement, 131 F.3d at 1468-70, 45 USPQ2d at 1164-65, the Court of Appeals for the Federal Circuit set forth a three step test for recapture analysis. In *Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600, the court restated this test as follows:

> Application of the recapture rule is a three-step process.
>
> The **first step** is to 'determine whether and in what aspect the reissue claims are broader than the patent claims.'....
>
> 'The **second step** is to determine whether the broader aspects of the reissued claim related to surrendered subject matter' ....
>
> **Finally**, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. [Emphasis added]

A. *The First Step - Was There Broadening?*

In every reissue application, the examiner must first review each claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim; see MPEP § 1412.03 for guidance as to the nature of a "broadening claim." If the reissue claim is not broadened in any respect as compared to the patent claims, the analysis ends; there is no recapture.

B. *The Second Step - Does Any Broadening Aspect of the Reissued Claim Relate to Surrendered Subject Matter?*

Where a claim in a reissue application is broadened in some respect as compared to the patent claims, the examiner must next determine whether the broadening aspect(s) of that reissue claim relate(s) to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued). Each limitation of the patent claims, which is omitted or broadened in the reissue claim, must be reviewed for this determination. This involves two sub-steps:

1. The Two Sub-Steps:

(A) It must first be determined whether there was any surrender of subject matter made in the prosecution of the original application which became the patent to be reissued.

If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the art, the omitted limitation relates to subject matter previously surrendered by applicant. The reliance by applicant to define the original patent claims over the art can be by way of presentation of new/amended claims to define over the art, or an argument/statement by applicant that a limitation of the claim(s) defines over the art. To determine whether such reliance occurred, the examiner must review the prosecution history of the original application file (of the patent to be reissued) for recapture. The prosecution history includes the rejections and applicant's arguments made therein.

If there was no surrender of subject matter made in the prosecution of the original application, again the analysis ends and there is no recapture.

(B) If there was a surrender of subject matter in the original application prosecution, it must then be determined whether any of the broadening of the reissue claims is in the area of the surrendered subject matter. All of the broadening aspects of reissue claims must be analyzed to determine if any of the omitted/broadened limitation(s) are directed to limitations relied upon by applicant in the original application to make the claims allowable over the art.

2. Examples of the *Pannu* Second Step Analysis:

(A) Example (1) - Argument without amendment:

In *Hester*, *supra*, the Federal Circuit held that the surrender which forms the basis for impermissible recapture "can occur through arguments alone". 142 F.3d at 1482, 46 USPQ2d at 1649. For example, assume that limitation A of the patent claims is omitted in the reissue claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. If the omitted limitation A was argued in the original application to make the application claims allowable over the art in the application, then the omitted limitation relates to subject matter previously surrendered in the original application, and recapture will exist. Accordingly, where claims are broadened in a reissue application, the examiner should review the prosecution history of the original patent file for recapture, even where the claims were never amended during the prosecution of the application which resulted in the patent.

Note: The argument that the claim limitation defined over the rejection must have been specific as to the limitation relied upon, rather than a general statement regarding the claims as a whole. A general 'boiler plate' sentence in the original application will not, by itself, be sufficient to establish surrender and recapture.

An example of a general "boiler plate" sentence of argument is:

> "In closing, it is argued that the limitations of claims 1-7 distinguish the claims from the teachings of the prior art, and claims 1-7 are thus patentable."

An argument that merely states that all the limitations of the claims define over the prior art will also not, by itself, be sufficient to establish surrender and recapture. An example is:

> "Claims 1-5 set forth a power-train apparatus which comprises the combination of A+B+C+D+E. The prior art of record does not disclose or render obvious a motivation to provide for a material-transfer apparatus as defined by the limitations of claim 1, including an A member and a B member, both connected to a C member, with all three being aligned with the D and E members."

This statement is simply a restatement of the entirety of claim 1 as allowed. No measure of surrender could be gleaned from such a statement of reasons for allowance. See *Ex parte Yamaguchi*, 61 USPQ2d 1043 (Bd. Pat. App. & Inter. 2001)(reported but unpublished, precedential).

In both of the above examples, the argument does not provide an indication of what specific limitations, e.g., specific element or step of the claims, cooperative effect, or other aspect of the claims, are being relied upon for patentability. Thus, applicant has not surrendered anything.

(B) Example (2) - Amendment of the claims without argument:

The limitation omitted in the reissue claim(s) was added in the original application claims for the purpose of making the application claims allowable over a rejection or objection made in the application. Even though applicant made no argument on the record that the limitation was added to obviate the rejection, the nature of the addition to the claim can show that the limitation was added in direct reply to the rejection. This too will establish the omitted limitation as relating to subject matter previously surrendered. To illustrate this, note the following example:

> The original application claims recite limitations A+B+C, and the Office action rejection combines two references to show A+B+C. In the amendment replying to the Office action, applicant adds limitation D to A+B+C in the claims, but makes no argument as to that addition. The examiner then allows the claims. Even though there is no argument as to the addition of limitation D, it must be presumed that the D limitation was added to obviate the rejection. The subsequent deletion of (omission of) limitation D in the reissue claims would be presumed to be a broadening in an aspect of the reissue claims related to surrendered subject matter. Accordingly, the reissued claims would be barred by the recapture doctrine.

The above result would be the same whether the addition of limitation D in the original application was by way of applicant's amendment or by way of an examiner's amendment with authorization by applicant.

(C) Example (3) - Who can make the surrendering argument?

Assume that the limitation A omitted in the reissue claims was present in the claims of the original application. The examiner's reasons for allowance in the original application stated that it was that limitation A which distinguished over a potential combination of references X and Y. Applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue.

Ex parte Yamaguchi, supra, held that a surrender of claimed subject matter cannot be based solely upon an applicant's failure to respond to, or failure to challenge, an examiner's statement made during the prosecution of an application. Applicant is bound only by applicant's revision of the application claims or a positive argument/statement by *applicant*. An applicant's failure to present on the record a counter statement or comment as to an examiner's reasons for allowance does not give rise to any implication that applicant agreed with or acquiesced in the examiner's reasoning for allowance. Thus, the failure to present a counter statement or comment as to the examiner's statement of reasons for allowance does not give rise to any finding of surrender. **The examiner's statement of reasons for allowance in the original application cannot, *by itself*, provide the basis for establishing surrender and recapture.**

It is only in the situation where applicant does file comments on the statement of reasons for allowance, that surrender may have occurred. Note the following two scenarios in which an applicant files comments:

> *Scenario 1- There is Surrender*: The examiner's statement of reasons for allowance in the original application stated that it was limitation C (of the combination of ABC) which distinguished over a potential combining of references X and Y, in that limitation C provided increased speed to the process. Applicant filed comments on the examiner's statement of reasons for allowance essentially supporting the examiner' s reasons. The limitation C is thus established as relating to subject matter previously surrendered.

> *Scenario 2- There is No Surrender*: On the other hand, if applicant's comments on the examiner's statement of reasons for allowance contain a counter statement that it is limitation B (of the combination of ABC), rather than C, which distinguishes the claims over the art, then limitation B would constitute surrendered subject matter, and limitation C has not been surrendered.

C. *The Third Step - Were the reissued claims materially narrowed in other respects to compensate for the broadening in the area of surrender, and thus avoid the recapture rule?*

As pointed out above, the third prong of the recapture determination set forth in *Pannu* is directed to analysis of the broadening and narrowing effected via the reissue claims, and of the significance of the claim limitations added and deleted, using the prosecution history of the patent (to be reissued), to determine whether the reissue claims should be barred as recapture.

The following discussion addresses analyzing the reissue claims, and *which claims* are to be compared to the reissue claims in determining the issue of surrender (for reissue recapture).

When analyzing a reissue claim for the possibility of impermissible recapture, there are two different types of analysis that must be performed. If the reissue claim "fails" either analysis, recapture exists.

First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution to define over the art. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. *In re Clement, supra.*

Second, it must be determined whether the reissue claim entirely omits any limitation that was added/argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. *Pannu v. Storz Instruments Inc., supra.* However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. *Ex Parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential). For example, if the key limitation added to overcome an art rejection was "an orange peel," and the reissue claim instead recites "a citrus fruit peel", the reissue claim may not be rejected on recapture grounds.

The following discussion is provided for analyzing the reissue claims.

1. Comparison of Reissue Claims Narrowed/Broadened *Vis-à-vis* the Canceled Claims

DEFINITION: "Canceled claims," in the context of recapture case law, are claims canceled from the original application to obtain the patent for which reissue is now being sought. The claims

(A) can simply be canceled and not replaced by others, or

(B) can be canceled and replaced by other claims which are more specific than the canceled claims in at least one aspect (to thereby define over the art of record). The "replacement claims" can be new claims which are narrower than the canceled claims, or can be the same claims amended to be narrower than the canceled version of the claims.

(a) Reissue Claims are Same or Broader in Scope Than Canceled Claims in All Aspects:

The recapture rule bars the patentee from acquiring, through reissue, claims that are in all aspects (A) of the same scope as, or (B) broader in scope than, those claims canceled from the original application to obtain a patent. *In re Ball Corp. v. United States*, 729 F.2d at 1436, 221 USPQ at 295.

(b) Reissue Claims are Narrower in Scope Than Canceled Claims in at Least One Aspect:

If the reissue claims are equal in scope to, or narrower than, the claims of the original patent (as opposed to the claims "canceled from the application") in all aspects, then there can never be recapture. The discussion that follows is not directed to that situation. It is rather directed to the situation where the *reissue claims are narrower than the claims 'canceled' from the application in some aspect, but are broader than the claims of the original patent in some other aspect.*

If the reissue claims are narrower in scope than the claims canceled from the original application by inclusion of *the limitation added to define the original application claims over the art*, there will be no recapture, even if the reissue claims are broader than the canceled claims in some other aspect (i.e., an aspect not related to the surrender made in the original application).

Assume combination AB was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABC (after which the patent issued). The reissue claims are then directed to combination $AB_{broadened}C$. The $AB_{broadened}C$ claims are *narrower* in scope when compared with the canceled claim subject matter AB *in respect to the addition of C* (which was added in the application to overcome the art), and there is no recapture.

As another example, assume combination ABZ was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABZC (after which the patent issued). The reissue claims are then directed to combination ABC (i.e., element Z is deleted from the canceled claims, while element C remains present). The ABC claims of the reissue are *narrower* in scope as compared to the canceled-from-the-original-application claim subject matter ABZ *in respect to the addition of C* (which was added in the application to overcome the art), and there is thus no recapture.

2. Comparison of Reissue Claims Narrowed/ Broadened *Via-à-vis* the Patent Claims

The "patent claims," in the context of recapture case law, are claims which issued in the original patent for which reissue is now being sought. As pointed out above, where the reissue claims are narrower than the claims of the original patent in all aspects, then there can never be recapture. If reissue claims are equal in scope to the patent claims, there is no recapture as to those reissue claims. Where, however, reissue claims are both broadened and narrowed as compared with the original patent claims, the nature of the broadening and narrowing must be examined to determine whether the reissue claims are barred as being recapture of surrendered subject matter. If the claims are 'broader than they are narrower in a manner directly pertinent to the subject matter... surrendered during prosecution' (*Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166), then recapture will bar the claims. This narrowing/broadening *vis-à-vis* the patent is broken down into four possibilities that will now be addressed.

The "limitation" presented, argued, or stated to make the claims patentable over the art (in the application) "generates" the surrender of claimed subject matter. For the sake of simplification, this limitation will be referred to throughout this section as the *surrender-generating limitation.* If a claim is presented in a reissue application that omits, in its entirety, the surrender-generating limitation, that claim impermissibly recaptures what was previously surrendered, and that claim is barred under 35 U.S.C. 251. This terminology will be used in the discussion of the four categories of narrowing/broadening *vis-à-vis* the **patent** that follows.

(a) Reissue Claims are Narrower in Scope Than Patent Claims, in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope by Omitting Limitation(s) Added/Argued To Overcome Art Rejection in Original Prosecution:

In this case, there is recapture.

This situation is where the patent claims are directed to combination ABC and the reissue claims are directed to ABD. Element C was either a limitation added to AB to obtain allowance of the original patent, or was argued by applicant to define over the art (or both). Thus, addition of C (and/or argument as to C) has resulted in the surrender of any combination of A & B that does not include C; this is the surrendered subject matter. Element D, on the other hand, is not related to the surrendered subject matter. Thus, the reissue claim, which no longer contains C, is broadened in an area related to the surrender, and the narrowing via the addition of D does not save the claim from recapture since D is not related to the surrendered subject matter.

Reissue claims that are broader than the original patent claims by not including the surrender-generating limitation (element C, in the example given) will be barred by the recapture rule even though there is narrowing of the claims not related to the surrender-generating limitation. As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu v. Storz Instruments Inc., supra*, then brings home the point by providing an actual fact situation in which this scenario was held to be recapture.

(b) Reissue Claims are Narrower or Equal in Scope, in Area Directed to Amendment/ Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope in Area Not Directed to Amendment/ Argument:

In this case, there is no recapture.

This situation is where the patent claims are directed to combination ABCDE and the reissue claims are directed to ABDE (element C is omitted). Assume that the combination of ABCD was present in the original application as it was filed, and element E was later added to define over that art. No argument was ever presented as to elements A-C defining over the art.

In this situation, the ABCDE combination of the patent can be broadened (in the reissue application) to omit element C, and thereby claim the combination of ABDE, where element E (the surrender generating limitation) is not omitted. There would be no recapture in this instance. (If an argument had been presented as to element C defining over the art, in addition to the addition of element E, then the ABCDE combination could not be broadened to omit element C and thereby claim combination of ABDE. This would be recapture; see the above discussion as to surrender and recapture based upon argument.)

Additionally, the reissue claims are certainly permitted to recite combination $ABDE_{specific}$ (where surrender-generating element E is narrowed). The patent claims have been broadened in an area not directed to the surrender (by omitting element C) and narrowed in the area of surrender (by narrowing element E to $E_{specific}$). This is clearly permitted.

As another example, assume limitation C was added to application claims AB to obtain the patent to ABC, and now the reissue application presents claims to AC or $AB_{broad}C$. Such reissue claims avoid the effect of the recapture rule because they are broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). Such claims are considered to be broader in an aspect not 'germane to a prior art rejection,' and thus are not barred by recapture. Note *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

Reissue claims that are broader than the original patent claims by deletion of a limitation or claim requirement other than the "surrender-generating limitation" will avoid the effect of the recapture rule, regardless of the nature of the narrowing in the claims, and even if the claims are not narrowed at all from the scope of the patent claims.

(c) **Reissue Claims are Narrower in Scope in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope in Area Not Directed to the Amendment/Argument:**

In this instance, there is clearly no recapture. In the reissue application, there has been no change in the claims related to the matter surrendered in the original application for the patent.

In this instance, element C was added to the AB combination to provide ABC and define over the art, and the patent was issued. The reissue omits element B and adds element Z, to thus claim ACZ. There is no recapture since the surrender generating element C has not been modified in any way. (Note, however, that if, when element C was added to AB, applicant argued that the association of newly added C with B provides a synergistic (unexpected) result to thus define over the art, then neither B nor C could be omitted in the reissue application.)

(d) **Reissue Claims Broader in Scope in Area Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; but Reissue Claims Retain, in Broadened Form, the Limitation(s) Argued/ Added to Overcome Art Rejection in Original Prosecution:**

Assume the combination AB was originally claimed in the application, and was amended in reply to an art rejection to add element C and thus provide the combination ABC (after which the patent issued). A reissue application is then filed, and the reissue application claims are directed to the combination $ABC_{broadened}$. The $ABC_{broadened}$ claims are narrowed in scope when compared with the canceled claim subject matter AB, because of the addition of $C_{broadened}$. Thus, the claims retain, in broadened form, the limitation argued/added to overcome art rejection in original prosecution. There is no recapture, since $ABC_{broadened}$ is narrower than canceled claim subject matter AB in an area related to the surrender. This is so, because it was element C that was added in the application to overcome the art. See *Ex Parte Eggert, supra*.

II. REISSUE TO TAKE ADVANTAGE OF 35 U.S.C. 103(b):

A patentee may file a reissue application to permit consideration of process claims which qualify for 35 U.S.C. 103(b) treatment if a patent is granted on an application entitled to the benefit of 35 U.S.C. 103(b), without an election having been made as a result of error without deceptive intent. See MPEP § 706.02(n). **This is not to be considered a recapture.** The addition of process claims, however, will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

III. REISSUE FOR ARTICLE CLAIMS WHICH ARE FUNCTIONAL DESCRIPTIVE MATERIAL STORED ON A COMPUTER-READABLE MEDIUM:

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the "article" claims) must have been made as a result of error without deceptive intent. The addition of these "article" claims will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

IV. REJECTION BASED UPON RECAPTURE:

Reissue claims which recapture surrendered subject matter should be rejected using form paragraph 14.17.

¶ *14.17 Rejection, 35 U.S.C. 251, Recapture*

Claim[1] rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131

F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

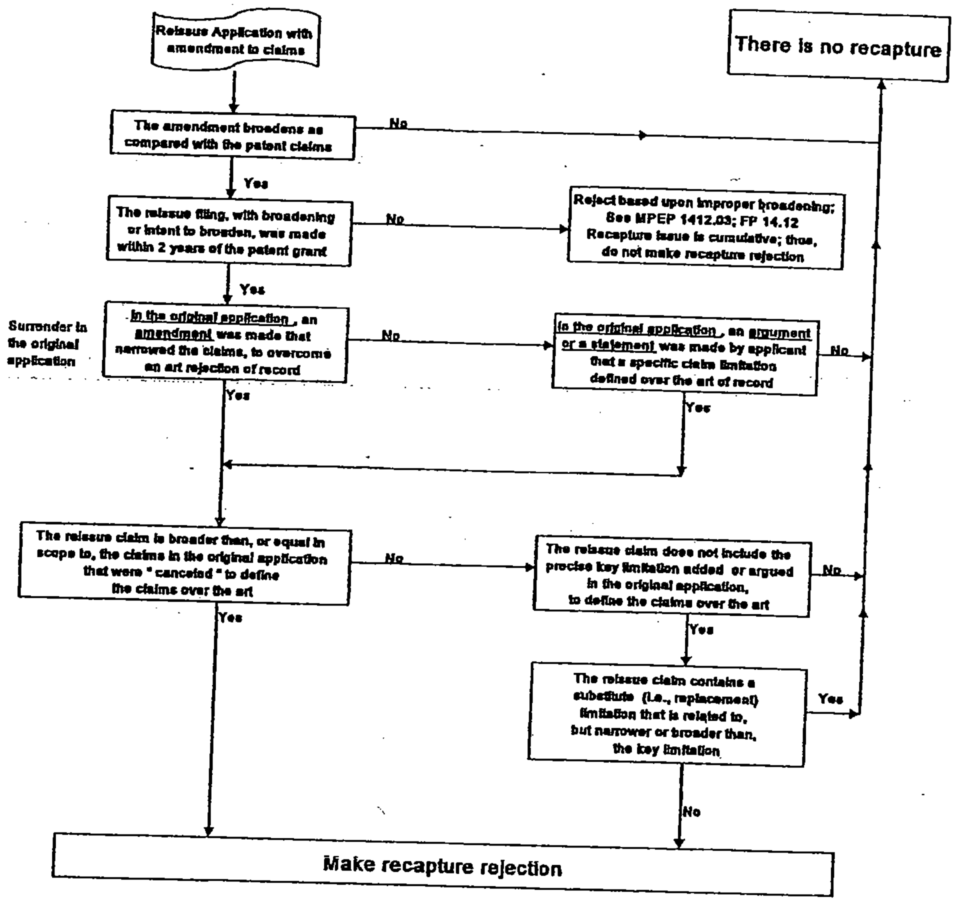
[2]

Examiner Note:

In bracket 2, the examiner should explain the specifics of why recapture exists, including an identification of the omitted/broadened claim limitations in the reissue which provide the "broadening aspect" to the claim(s), and where in the original application the narrowed claim scope was presented/argued to obviate a rejection/objection. See MPEP § 1412.02.

See the recapture-analysis flow chart which follows for assistance in determining whether recapture is present, consistent with the case law discussed above.

Reissue Recapture - Determining its presence or absence


Reissue Application with amendment to claims
The amendment broadens as compared with the patent claims
No
Yes
There is no recapture
The reissue filing, with broadening or intent to broaden, was made within 2 years of the patent grant
No
Reject based upon improper broadening; See MPEP 1412.03; FP 14.12 Recapture issue is cumulative; thus, do not make recapture rejection
Yes
Surrender in the original application
In the original application, an amendment was made that narrowed the claims, to overcome an art rejection of record
No
In the original application, an argument or a statement was made by applicant that a specific claim limitation defined over the art of record
No
Yes
Yes
The reissue claim is broader than, or equal in scope to, the claims in the original application that were "canceled" to define the claims over the art
No
The reissue claim does not include the precise key limitation added or argued in the original application, to define the claims over the art
No
Yes
Yes
The reissue claim contains a substitute (i.e., replacement) limitation that is related to, but narrower or broader than, the key limitation
Yes
No
Make recapture rejection

1412.03 Broadening Reissue Claims [R-3]

35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues:

> No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent.

>

I. < MEANING OF "BROADENED REISSUE CLAIM"

A broadened reissue claim is a claim which enlarges the scope of the claims of the patent, *i.e.*, a claim which is greater in scope than each and every claim of the original patent. If a disclaimer is filed in the patent prior to the filing of a reissue application, the disclaimed claims are <u>not</u> part of the "original patent" under 35 U.S.C. 251. The Court in *Vectra Fitness Inc. v. TNWK Corp.*, 49 USPQ2d 1144, 1147, 162 F.3d 1379, 1383 (Fed. Cir. 1998) held that a reissue application violated the statutory prohibition under 35 U.S.C. 251 against broadening the scope of the patent more than 2 years after its grant because the reissue claims are broader than the claims that remain after the disclaimer, even though the reissue claims are narrower than the claims that were disclaimed by the patentee before reissue. The reissue application was bounded by the claims remaining in the patent after a disclaimer is filed.A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in *at least one* respect, even though it may be narrower in other respects.

A claim in the reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the reissue contains within its scope any conceivable product or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims. *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (Fed. Cir. 1987); *In re Ruth*, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960); *In re Rogoff*, 261 F.2d 601, 603, 120 USPQ 185, 186 (CCPA 1958). A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement. Thus, where the original patent claims only the process, and the reissue application adds (for the first time) product claims, the scope of the claims has been broadened since a party could not be sued for infringement of the product based on the claims of the original patent.

The addition of combination claims in a reissue application where only subcombination claims were present in the original patent could be a broadening of the invention. The question which must be resolved in this case is whether the combination claims added in the reissue would be for "the invention as claimed" in the original patent. See *Ex parte Wikdahl*, 10 USPQ2d at 1549. The newly added combination claims should be analyzed to determine whether they contain every limitation of the subcombination of any claim of the original patent. If the combination claims (added in the reissue) contain every limitation of the subcombination (which was claimed in the original application), then infringement of the combination must also result in infringement of the subcombination. Accordingly, the patent owner **could not**, if a reissue patent issues with the combination claims, **sue any new party** for infringement who could not have been sued for infringement of the original patent. Therefore, **broadening does not exist**, in spite of the addition of the combination.

>

II. < SCOPE OF DEPENDENT CLAIM ENLARGED-NOT BROADENING

As pointed out above, a claim will be considered a broadened reissue claim when it is greater in scope than **each and every** claim of the patent to be reissued. A corollary of this is that a claim which has been *broadened in a reissue as compared to its scope in the patent* is not a broadened reissue claim if it is narrower than, or equal in scope to, any other claim which appears in the patent. A common example of this is where dependent claim 2 is broadened via the reissue (other than the addition of a process step to convert an intermediate to a final product as discussed in the preceding subsection), but independent claim 1 on which it is based is not broadened. Since a dependent claim is construed to contain all the limitations of the claim upon which it depends, claim 2 must be at

least as narrow as claim 1 and is thus not a broadened reissue claim.
>

III. < NEW CATEGORY OF INVENTION ADDED IN REISSUE - GENERALLY *>IS< BROADENING

The addition of process claims as a new category of invention to be claimed in the patent (*i.e.*, where there were no method claims present in the original patent) is generally considered as being a broadening of the invention. See *Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989). A situation may arise, however, where the reissue application adds a limitation (or limitations) to process A of making the product A claimed in the original patent claims. For example:

(1) a process of using the product A (made by the process of the original patent) to make a product B, disclosed but not claimed in the original patent; or

(2) a process of using the product A to carry out a process B disclosed but not claimed in the original patent.

Although this amendment of the claims adds a method of making product B or adds a method of using product A, <u>this is not broadening</u> (i.e., this is not an enlargement of the scope of the original patent) because the "newly claimed invention" contains all the limitations of the original patent claim(s).
>

IV. < WHEN A BROADENED CLAIM CAN BE PRESENTED

A broadened claim can be presented within two years from the grant of the original patent in a reissue application. In addition, a broadened claim can be presented *after* two years from the grant of the original patent in a broadening reissue >application< which was filed *within* two years from the grant. Where any intent to broaden is indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period. >Thus, a broadened claim may be presented in a reissue application after the two years, even though the broadened claim presented after the two years is different than the broadened claim presented within the two years.< Finally, if intent to broaden is indicated in a parent reissue application within the two years, a broadened claim can be presented in a continuing >(continuation or divisional)< reissue application after the two year period. In any other situation, a broadened claim <u>cannot</u> be presented, and the examiner should check carefully for the improper presentation of broadened claims.

A reissue application filed on the 2-year anniversary date from the patent grant is considered to be filed within 2 years of the patent grant. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) for a similar rule in interferences.

See also the following cases which pertain to broadened reissues:

In re Graff, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997) (Broadened claims in a continuing reissue application were properly rejected under 35 U.S.C. 251 because the proposal for broadened claims was not made (in the parent reissue application) within two years from the grant of the original patent and the public was not notified that broadened claims were being sought until after the two-year period elapsed.);

In re Fotland, 779 F.2d 31, 228 USPQ 193 (Fed. Cir. 1985), *cert. denied*, 476 U.S. 1183 (1986) (The failure by an applicant to include *an oath or declaration indicating a desire to seek broadened claims* within two years of the patent grant will bar a subsequent attempt to broaden the claims after the two year limit. Under the former version of 37 CFR 1.175 (the former 37 CFR 1.175(a)(4)), applicant timely sought a "no-defect" reissue, but the Court did not permit an attempt made beyond the two year limit to convert the reissue into a broadening reissue. In this case, applicant did not indicate any intent to broaden within the two years.);

In re Bennett, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985) *(en banc)* (A reissue application with broadened claims was filed within two years of the patent grant; however, the declaration was executed by the assignee rather than the inventor. The Federal Circuit permitted correction of the improperly executed declaration to be made more than two years after the patent grant.);

In re Doll, 419 F.2d 925, 928, 164 USPQ 218, 220 (CCPA 1970) (If the reissue application is timely filed within two years of the original patent grant and the applicant indicates in the oath or declaration that the claims will be broadened, then applicant may subsequently broaden the claims in the pending reissue prosecution even if the additional broadening occurs beyond the two year limit.).

Form paragraphs 14.12 and 14.13 may be used in rejections based on improper broadened reissue claims.

¶ *14.12 Rejection, 35 U.S.C. 251, Broadened Claims After Two Years*

Claim [1] rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. [2] A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Examiner Note:

The claim limitations that broaden the scope should be identified and explained in bracket 2. See MPEP §§ 706.03(x) and 1412.03.

¶ *14.13 Rejection, 35 U.S.C. 251, Broadened Claims Filed by Assignee*

Claim [1] rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. [2]A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Examiner Note:

The claim limitations that broaden the scope should be identified and explained in bracket 2. See MPEP §§ 706.03(x) and 1412.03.

>

V. < BROADENING REISSUE - OATH/ DECLARATION REQUIREMENTS

A broadening reissue application must be applied for by all of the inventors (patentees), that is, the original reissue oath or declaration must be signed by all of the inventors. See also MPEP § 1414. If a supplemental oath or declaration in a broadening reissue application is needed in the application in order to fulfill the requirements of 37 CFR 1.175, the supplemental reissue oath or declaration must be signed by all of the inventors. See *In re Hayes*, 53 USPQ2d 1222 (Comm'r Pat. 1999) and MPEP § 1414.01.

1412.04 Correction of Inventorship [R-5]

The correction of misjoinder of inventors has been held to be a ground for reissue. See *Ex parte Scudder*, 169 USPQ 814, 815 (Bd. App. 1971) wherein the Board held that 35 U.S.C. 251 authorizes reissue applications to correct misjoinder of inventors where 35 U.S.C. 256 is inadequate. See also *A.F. Stoddard & Co. v. Dann*, 564 F.2d 556, 567 n.16, 195 USPQ 97, 106 n.16 (D.C. Cir. 1977) wherein correction of inventorship from sole inventor A to sole inventor B was permitted in a reissue application. The court noted that reissue by itself is a vehicle for correcting inventorship in a patent.

I. CERTIFICATE OF CORRECTION AS A VEHICLE FOR CORRECTING INVENTORSHIP

While reissue is a vehicle for correcting inventorship in a patent, correction of inventorship should be effected under the provisions of 35 U.S.C. 256 and 37 CFR 1.324 by filing a request for a Certificate of Correction if:

(A) the only change being made in the patent is to correct the inventorship; and

(B) all parties are in agreement and the inventorship issue is not contested.

See MPEP § 1481 for the procedure to be followed to obtain a Certificate of Correction for correction of inventorship.

II. REISSUE AS A VEHICLE FOR CORRECTING INVENTORSHIP

Where the provisions of 35 U.S.C. 256 and 37 CFR 1.324 do not apply, a reissue application is the appropriate vehicle to correct inventorship. The failure to name the correct inventive entity is an error in the patent which is correctable under 35 U.S.C. 251. The reissue oath or declaration pursuant to 37 CFR 1.175 must state that the applicant believes the original patent to be wholly or partly inoperative or invalid through error of a person being incorrectly named in an issued patent as the inventor, or through error of an inventor incorrectly not named in an issued patent, and that such error arose without any deceptive intention on the part of the applicant. The reissue oath or declaration must, as stated in 37 CFR 1.175, also comply with 37**>CFR 1.63<.

The correction of inventorship does not enlarge the scope of the patent claims. Where a reissue application does not seek to enlarge the scope of the claims of the original patent, the reissue oath may be made and sworn to, or the declaration made, by the assignee of the entire interest under 37 CFR 1.172. An assignee of part interest may not file a reissue application to correct inventorship where the other co-owner did not join in the reissue application and has not consented to the reissue proceeding. See *Baker Hughes Inc. v. Kirk*, 921 F. Supp. 801, 809, 38 USPQ2d 1885, 1892 (D.D.C. 1995). See 35 U.S.C. 251, third paragraph. Thus, the signatures of the inventors are not needed on the reissue oath or declaration where the assignee of the entire interest signs the reissue oath/declaration. Accordingly, an assignee of the entire interest can add or delete the name of an inventor by reissue (*e.g.*, correct inventorship from inventor A to inventors A and B) without the original inventor's consent. See also 37 CFR 3.71(a) ("One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or reexamination proceeding **to the exclusion of** either **the inventive entity**, or the assignee(s) previously entitled to conduct prosecution." Emphasis added). Thus, the assignee of the entire interest can file a reissue to change the inventorship to one which the assignee believes to be correct, even though an inventor might disagree. The protection of the assignee's property rights in the application and patent are statutorily based in 35 U.S.C. 118.

Where the name of an inventor X is to be deleted in a reissue application to correct inventorship in a patent, and inventor X has not assigned his/her rights to the patent, inventor X has an ownership interest in the patent. Inventor X must consent to the reissue (37 CFR 1.172(a)), even though inventor X's name is being deleted as an inventor and need not sign the reissue oath or declaration. If inventor X has assigned his/her rights to the patent, then inventor X's assignee must consent. In addition to providing the consent, even though inventor X does not sign the reissue oath or declaration as an inventor (since the correction of inventorship does not enlarge the scope of the patent claims), the assignee of the entire interest must sign the reissue oath or declaration as assignee (37 CFR 1.172(a)). Thus, if inventor X has not assigned his/her patent rights, inventor X's signature must be included in the reissue oath or declaration as the assignee. If inventor X has assigned his/her patent rights, inventor X's assignee must sign the reissue oath or declaration as the assignee. For example, a patent to inventors X and Y has no assignee. A reissue application is filed by inventor Y to delete the name of inventor X as an inventor. 37 CFR 1.172(a) provides that a reissue oath or declaration may be made by the assignee/owners of the entire interest, rather than by the inventors, where the scope of the claims is not to be enlarged. However, since inventor X has not assigned his/her patent rights, inventor X must sign the reissue oath or declaration as one of the owners, and consent to the filing of the reissue application by inventor Y. See MPEP § 1410.01.

Where a reissue to correct inventorship also changes the claims to enlarge the scope of the patent claims, the signature of all the inventors *is needed.* However, if an inventor refuses to sign the reissue oath or declaration because he or she believes the change in inventorship (to be effected) is not correct, the reissue application can still be filed with a petition under 37 CFR 1.47 without that inventor's signature provided the written consent of all owners/assignees as required by 37 CFR 1.172(a) is also submitted. In the situation where a patent to inventors X and Y has no assignee and a reissue application is filed by inventor Y to delete the name of inventor X as an inventor and to broaden the patent. Inventor X refuses to sign the reissue oath or declaration and refuses to provide the consent as required by 37 CFR 1.172(a). In this instance, a 37 CFR 1.47 petition would not be appropriate to permit the filing of the reissue application since the consent requirement of 37 CFR 1.172(a) for each owner/assignee is not met. Resort to the courts would be required to delete the name of inventor X as an inventor where X will not consent to the filing of a reissue application. As stated in the second paragraph of 35 U.S.C. 256, "[t]he court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly."

The reissue application with its reissue oath or declaration under 37 CFR 1.175 provides a complete mechanism to correct inventorship. See *A.F. Stoddard*

& Co. v. Dann, 564 F.2d at 567, 195 USPQ at 106. A request under 37 CFR 1.48 or a petition under 37 CFR 1.324 cannot be used to correct the inventorship of a reissue application. If a request under 37 CFR 1.48 or a petition under 37 CFR 1.324 is filed in a reissue application, the request or petition should be dismissed and the processing or petition fee refunded. The material submitted with the request or petition should then be considered to determine if it complies with 37 CFR 1.175. If the material submitted with the request or petition does comply with the requirements of 37 CFR 1.175 (and the reissue application is otherwise in order), the correction of inventorship will be permitted as a correction of an error in the patent under 35 U.S.C. 251.

Where a reissue application seeks to correct inventorship in the patent and the inventors are required to sign the reissue oath or declaration (rather than an assignee of the entire interest under 37 CFR 1.172) due to a broadening of any claims of the original patent, the correct inventive entity must sign the reissue oath or declaration. Where an inventor **is being added** in a reissue application to correct inventorship in a patent, the inventor being added must sign the reissue oath or declaration together with the inventors previously designated on the patent. For example, a reissue application is filed to correct the inventorship from inventors A and B (listed as inventors on the patent) to inventors A, B, and C. Inventor C is the inventor being added. In such a case, A, B, and C are the correct inventors, and accordingly, each of A, B, and C must sign the reissue oath or declaration. Where an inventor **is being deleted** in a reissue application to correct inventorship in a patent and the inventors are required to sign the oath or declaration due to a broadening of any claims of the original patent, the inventor being deleted need not sign the reissue oath or declaration. The reissue oath or declaration must be signed by the correct inventive entity. For example, a reissue application is filed to correct inventorship from inventors A, B, and C (listed as inventors on the patent) to inventors A and B. Inventor C is being deleted as a named inventor. In such a case, A and B are the correct inventors, and accordingly, inventors A and B must sign the reissue oath or declaration but inventor C need not sign the reissue oath or declaration.

1413 Drawings [R-2]

37 CFR 1.173. Reissue specification, drawings, and amendments.

*****

(a)(2) Drawings. Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

*****

A clean copy (e.g., good quality photocopies free of any extraneous markings) of each drawing sheet of the printed patent must be supplied by the applicant at the time of filing of the reissue application. If the copies meet the requirements of 37 CFR 1.84, no further formal drawings will be required. New drawing sheets are not to be submitted, unless some change is made in the original patent drawings. Such changes must be made in accordance with 37 CFR 1.173(b)(3).

The prior reissue practice of transferring drawings from the patent file has been eliminated, since clean photocopies of the printed patent drawings are acceptable for use in the printing of the reissue patent.

AMENDMENT OF DRAWINGS

37 CFR 1.173. Reissue specification, drawings, and amendments.

*****

**>

(b)(3) *Drawings*. One or more patent drawings shall be amended in the following manner: Any changes to a patent drawing must be submitted as a replacement sheet of drawings which shall be an attachment to the amendment document. Any replacement sheet of drawings must be in compliance with § 1.84 and shall include all of the figures appearing on the original version of the sheet, even if only one figure is amended. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled." All changes to the drawing(s) shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawings.<

*****

The provisions of 37 CFR 1.173(b)(3) govern the manner of making amendments (changes) to the drawings in a reissue application. The following guidance is provided as to the procedure for amending drawings:

(A) Amending the original or printed patent drawing sheets by physically changing or altering them is not permitted. Any request to do so should be denied.

(B) Where a change to the drawings is desired, ** >applicant must submit a replacement sheet for each sheet of drawings containing a Figure to be revised. Any replacement sheet must comply with 37 CFR 1.84 and include all of the figures appearing on the original version of the sheet, even if only one figure is being amended. Each figure that is amended must be identified by placing the word "Amended" at the bottom of that figure. Any added figure must be identified as "New." In the event that a figure is canceled, the figure must be identified as "Canceled" and also surrounded by brackets. All changes to the figure(s) must be explained, in detail, beginning on a separate sheet which accompanies the papers including the amendment to the drawings.

(C) If desired, applicant may include a marked-up copy of any amended drawing figure, including annotations indicating the changes made. Such a marked-up copy must be clearly labeled as "Annotated Marked-up Drawings", and it must be presented in the amendment or remarks section that explains the change to the drawings.

In addition, the examiner may desire a marked-up copy of any amended drawing figure, and so state in an Office action. A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.<

(D) For each proper new drawing sheet being added, the new sheet should be inserted after the existing drawing sheets. For each proper * drawing sheet >being added< which replaces an existing drawing sheet, the existing sheet should be canceled by placing the sheet face down in the file and placing a large "X" on the back of the sheet. The new sheet should be inserted in place of the turned over existing sheet.

(E) If any drawing change * is not * >approved,< or if any submitted sheet of formal drawings is not entered, the examiner will so inform the reissue applicant in the next Office action, and the examiner will set forth the reasons for same.

1414 Content of Reissue Oath/Declaration [R-5]

37 CFR 1.175. Reissue oath or declaration.

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

(b)(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

(i) With any amendment prior to allowance; or

(ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

(2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.

(c) Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.

(d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f).

(e) The filing of any continuing reissue application which does not replace its parent reissue application must include an oath or declaration which, pursuant to paragraph (a)(1) of this section, identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application. All other requirements relating to oaths or declarations must also be met.

The reissue oath/declaration is an essential part of a reissue application and must be filed with the application, or within the time period set under 37 CFR 1.53(f) along with the required surcharge as set forth in 37 CFR 1.16(f) in order to avoid abandonment.

The question of the sufficiency of the reissue oath/declaration filed under 37 CFR 1.175 must in each case be reviewed and decided personally by the primary examiner.

Reissue oaths or declarations must contain the following:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid—

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

(B) A statement of at least one error which is relied upon to support the reissue application, *i.e.*, as the basis for the reissue;

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.

These elements will now be discussed:

I. A STATEMENT THAT THE APPLICANT BELIEVES THE ORIGINAL PATENT TO BE WHOLLY OR PARTLY INOPERATIVE OR INVALID BY REASON OF A DEFECTIVE SPECIFICATION OR DRAWING, OR BY REASON OF THE PATENTEE CLAIMING MORE OR LESS THAN PATENTEE HAD THE RIGHT TO CLAIM IN THE PATENT.

In order to satisfy this requirement, a declaration can state as for example:

>

1. <"Applicant believes the original patent to be partly inoperative or invalid by reason of a defective specification or drawing."

>

2. <"Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more than patentee had a right to claim in the patent."

>

3. <"Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming less than patentee had a right to claim in the patent."

Where the specification or drawing is defective and patentee claimed both more and less than patentee had the right to claim in the patent, then *all three* statements should be included in the reissue oath/declaration. >A statement that the original patent is "**wholly or partly** inoperative or invalid" (emphasis added) by reason of the patentee "claiming **more or less** than the patentee had the right to claim in the patent" (emphasis added) is improper since a claim cannot claim "more **or** less" at the same time. Where, however, a given independent claim is considered to be overly broad, and another independent claim is considered to be overly narrow, patentee has claimed both more **and** less than he or she had a right to claim. In such an instance, both the second and third above-quoted statements would be used.< See MPEP § 1412.04 for an exemplary declaration statement when the error being corrected is an error in inventorship.

The above examples will be sufficient to satisfy this requirement without any further statement.

>It should be noted that the reissue oath/declaration must also satisfy the requirement for a statement of at least one error being relied upon as the basis for reissue, in the manner set forth in subsection II. below.<

Form paragraph 14.01 may be used where the reissue oath/declaration does not provide the required statement as to applicant's belief that the original patent is wholly or partly inoperative or invalid.

¶ *14.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - No Statement of Defect in the Patent*

The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414. **[1]**

Examiner Note:

1. Use this form paragraph when applicant: (a) fails to allege that the original patent is inoperative or invalid and/or (b) fails to state the reason of a defective specification or drawing, or of patentee claiming more or less than patentee had the right to claim in the patent. In bracket 1, point out the specific defect to applicant by using the language of (a) and/or (b), as it is appropriate.
2. Form paragraph 14.14 must follow this form paragraph.

II. A STATEMENT OF AT LEAST ONE ERROR WHICH IS RELIED UPON TO SUPPORT THE REISSUE APPLICATION (I.E., THE BASIS FOR THE REISSUE).

(A) A reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective. *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). A change or departure from the original specification or claims represents an "error" in the original patent under 35 U.S.C. 251. See MPEP § 1402 for a discussion of grounds for filing a reissue that may constitute the "error" required by 35 U.S.C. 251. Not all changes with respect to the patent constitute the "error" required by 35 U.S.C. 251.

(B) Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based. Where applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied. Applicant may specify more than one error.

Where more than one error is specified in the oath/declaration and some of the designated "errors" are found to not be "errors" under 35 U.S.C. 251, any remaining error which is an error under 35 U.S.C. 251 will still support the reissue.

The "at least one error" which is relied upon to support the reissue application must be set forth in the oath/declaration. It is not necessary, however, to point out how (or when) the error arose or occurred. Further, it is not necessary to point out how (or when) the error was discovered. If an applicant chooses to point out these matters, the statements directed to these matters will not be reviewed by the examiner, and the applicant should be so informed in the next Office action. All that is needed for the oath/declaration statement as to error is the identification of "at least one error" relied upon.

In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid. The corresponding corrective action which has been taken to correct the original patent need not be identified in the oath/declaration. If the initial reissue oath/declaration "states at least one error" in the original patent, and, *in addition*, recites the specific corrective action taken in the reissue application, the oath/declaration would be considered acceptable, even though the corrective action statement is not required.

(C) It is not sufficient for an oath/declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure." Rather, the oath/declaration must specifically identify an error. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), *cert. denied*, 484 U.S. 894 (1987). Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.

A statement of "...failure to include a claim directed to..." and then presenting a newly added claim, would not be considered a sufficient "error" statement since applicant has not pointed out what the other claims lacked that the newly added claim has, or vice versa. Such a statement would be no better than saying in the reissue oath or declaration that "this application is being filed to correct errors in the patent which may be noted from the change made by adding new claim 10." In both cases, the error has not been identified.

(D) Where a continuation reissue application is filed with a copy of the reissue oath/declaration from the parent reissue application, and the parent reissue application is not to be abandoned, the reissue oath/declaration should be accepted by the Office of Initial Patent Examination without further evaluation, since it is an oath/declaration, albeit improper under 35 U.S.C. 251. The examiner should, however, reject the claims of the continuation reissue application under 35 U.S.C. 251 as being based on an oath/declaration that does not identify an error being corrected by the continuation reissue application, and should require a new oath/declaration. 37 CFR 1.175(e) states that "the filing of any continuing reissue application which does not replace its parent reissue application must include an oath or declaration, which pursuant to [37 CFR 1.175(a)(1)], identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application." One of form paragraphs 14.01.01 through 14.01.03 may be used.

Where a continuation reissue application is filed with a copy of the reissue oath/declaration from the parent reissue application, and the parent reissue application is, or will be abandoned, the copy of the reissue oath/declaration should be accepted by OIPE, and the examiner should check to ensure that the oath/declaration identifies an error which is still being corrected in the continuation application. If a preliminary amendment was filed with the continuation reissue application, the examiner should check for the need of a supplemental reissue oath/declaration. Pursuant to 37 CFR 1.175 (b)(1), for any error corrected via the preliminary amendment which is not covered by the oath or declaration submitted in the parent reissue application, applicant must submit a supplemental oath/declaration stating that such error arose without any deceptive intention on the part of the applicant. See MPEP § 1414.01.

Where a divisional reissue application is filed with a copy of the reissue oath/declaration from the parent reissue application, the reissue oath/declaration should be accepted by OIPE, since it is an oath/declaration, though it may be improper under 35 U.S.C. 251. The examiner should check the copy of the oath/declaration to ensure that it identifies an error being corrected by the divisional reissue application. The copy of the oath/declaration from the parent reissue application may or may not cover an error being corrected by the divisional reissue application since the divisional reissue application is (by definition) directed to a new invention. If it does not, the examiner should reject the claims of the divisional reissue application under 35 U.S.C. 251 as being based on an oath/declaration that does not identify an error being corrected by the divisional reissue application, and require a new oath/declaration. If the copy of the reissue oath/declaration from the parent reissue application does in fact cover an error being corrected in the divisional reissue application, no such rejection should be made. However, since a new invention is being added by the filing of the divisional reissue application, a supplemental reissue oath/declaration pursuant to 37 CFR 1.175 (b)(1) will be required. See MPEP § 1414.01.

Form paragraph 14.01.01 may be used where the reissue oath/declaration does not identify an error.

¶ 14.01.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - No Statement of a Specific Error

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Examiner Note:

1. Use this form paragraph when the reissue oath or declaration does not contain any statement of an error which is relied upon to support the reissue application.

2. This form paragraph can be used where the reissue oath or declaration does not even mention error. It can also can be used where the reissue oath or declaration contains some discussion of the concept of error but never in fact identifies a specific error to be relied upon. For example, it is not sufficient for an oath or declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure."

3. Form paragraph 14.14 must follow this form paragraph.

Where the reissue oath/declaration does identify an error or errors, the oath/declaration must be checked carefully to ensure that at least one of the errors identified is indeed an "error" which will support the filing of a reissue, i.e., an "error" that will provide grounds for reissue of the patent. See MPEP § 1402. If the error identified in the oath/declaration is not an appropriate error upon which a reissue can be based, then the oath/declaration must be indicated to be defective in the examiner's Office action.

Form paragraphs 14.01.02 and 14.01.03 may be used where the reissue oath/declaration fails to provide at least one error upon which a reissue can be based.

¶ 14.01.02 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1)-The Identified "Error" Is Not Appropriate Error

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration identifies only one error which is relied upon to support the reissue application, and that one error is not an appropriate error upon which a reissue can be based.

2. Form paragraph 14.14 must follow this form paragraph.

¶ 14.01.03 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - Multiple Identified "Errors" Not Appropriate Errors

The reissue oath/declaration filed with this application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration identifies more than one error relied upon to support the reissue application, and none of the errors are appropriate errors upon which a reissue can be based.

2. Note that if the reissue oath/declaration identifies more than one error relied upon, and at least one of the errors is an error upon which reissue can be based, this form paragraph should not be used, despite the additional reliance by applicant on "errors"

which do not support the reissue. Only one appropriate error is needed to support a reissue.

3. Form paragraph 14.14 must follow this form paragraph.

III. A STATEMENT THAT ALL ERRORS WHICH ARE BEING CORRECTED IN THE REISSUE APPLICATION UP TO THE TIME OF SIGNING OF THE OATH/DECLARATION AROSE WITHOUT ANY DECEPTIVE INTENTION ON THE PART OF THE APPLICANT.

In order to satisfy this requirement, the following statement may be included in an oath or declaration:

> "All errors in the present reissue application up to the time of signing of this oath/declaration, or errors which are being corrected by a paper filed concurrently with this oath/declaration which correction of errors I/we have reviewed, arose without any deceptive intention on the part of the applicant."

Nothing more is required. The examiner will determine only whether the reissue oath/declaration contains the required averment; the examiner will not make any comment as to whether it appears that there was in fact deceptive intention (see MPEP § 2022.05). It is noted that a reissue oath/declaration will not be effective for any errors which are corrected by a filing made after the execution of the reissue oath/declaration, unless it is clear from the record that the parties executing the document were aware of the nature of the correction when they executed the document. Further, a reissue oath/declaration with an early date of execution cannot be filed after a correction made later in time, to cover the correction made after the execution date. This is so, even if the reissue oath/declaration states that *all errors up to the filing of the oath/declaration* arose without any deceptive intention on the part of the applicant.

Form paragraph 14.01.04 may be used where the reissue oath/declaration does not provide the required statement as to "without any deceptive intention on the part of the applicant."

¶ *14.01.04 Defective Reissue Oath/Declaration, 37 CFR 1.175- Lack of Statement of "Without Any Deceptive Intention"*

The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration does not contain the statement required by 37 CFR 1.175 that all errors being corrected in the reissue application arose without any deceptive intention on the part of the applicant.
2. This form paragraph is appropriate to use for a failure by applicant to comply with the requirement, as to any of 37 CFR 1.175(a)(2), 37 CFR 1.175(b)(1), or 37 CFR 1.175(b)(2).
3. Form paragraph 14.14 must follow.

IV. THE REISSUE OATH/DECLARATION MUST COMPLY WITH 37 CFR 1.63.

The reissue oath/declaration must include the averments required by 37 CFR 1.63(a) and (b), *e.g.*, that applicants for reissue

(A) have reviewed and understand the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath/declaration;

(B) believe the named inventor or inventors to be the original and the first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and

(C) acknowledge the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56. See also the discussion regarding the requirements of an oath/declaration beginning at MPEP § 602.

The examiner should check carefully to ensure that all the requirements of 37 CFR 1.63 are met. Form paragraph 14.01.05 should be used in conjunction with the content of form paragraphs 6.05 through 6.05.20 as appropriate, where the reissue oath/declaration fails to comply with the requirements of 37 CFR 1.63.

¶ *14.01.05 Defective Reissue Oath/Declaration, 37 CFR 1.175 - General*

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration does not comply with 37 CFR 1.175, and none of form paragraphs 14.01 - 14.01.04 or 14.05.02 apply.
2. This form paragraph must be followed by an explanation of why the reissue oath/declaration is defective.

3. Form paragraph 14.14 must follow the explanation of the defect.

See MPEP § 1414.01 for a discussion of the requirements for a supplemental reissue oath/declaration.

Depending on the circumstances, either form PTO/SB/51, Reissue Application Declaration By The Inventor, or form PTO/SB/52, Reissue Application Declaration By The Assignee may be used to prepare a declaration in a reissue application.

**>

PTO/SB/51 (10-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REISSUE APPLICATION DECLARATION BY THE INVENTOR	Docket Number (Optional)

I hereby declare that:
Each inventor's residence, mailing address and citizenship are stated below next to their name.
I believe the inventors named below to be the original and first inventor(s) of the subject matter which is described and claimed in patent number ____________________, granted ____________________ and for which a reissue patent is sought on the invention entitled ______________________________
______________________________,
the specification of which ______________________________,

☐ is attached hereto.

☐ was filed on ____________________ as reissue application number ____________________

and was amended on ____________________ .
(If applicable)

I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.
I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

☐ I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b). Attached is form PTO/SB/02B (or equivalent) listing the foreign applications.

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

☐ by reason of a defective specification or drawing.

☐ by reason of the patentee claiming more or less than he had the right to claim in the patent.

☐ by reason of other errors.

At least one error upon which reissue is based is described below. If the reissue is a broadening reissue, such must be stated with an explanation as to the nature of the broadening:

[Page 1 of 2]

This collection of information is required by 37 CFR 1.175. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/51 (10-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

(REISSUE APPLICATION DECLARATION BY THE INVENTOR, page 2)	Docket Number (Optional)

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.

Note: To appoint a power of attorney, use form PTO/SB/81.

Correspondence Address: Direct all communications about the application to:

☐ The address associated with Customer Number: ______

OR

☐ Firm or Individual Name					
Address					
City		State		Zip	
Country					
Telephone		Email			

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

Full name of sole or first inventor (given name, family name)	
Inventor's signature	Date
Residence	Citizenship
Mailing Address	
Full name of second joint inventor (given name, family name)	
Inventor's signature	Date
Residence	Citizenship
Mailing Address	

☐ Additional joint inventors or legal representative(s) are named on separately numbered sheets forms PTO/SB/02A or 02LR attached hereto.

[Page 2 of 2]

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

PTO/SB/52 (10-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REISSUE APPLICATION DECLARATION BY THE ASSIGNEE	Docket Number (optional)

I hereby declare that:

The residence, mailing address and citizenship of the inventors are stated below.

I am authorized to act on behalf of the following assignee: ____________________

and the title of my position with said assignee is: ____________________

The entire title to the patent identified below is vested in said assignee.

Inventor	Citizenship
Residence/Mailing Address	
Inventor	Citizenship
Residence/Mailing Address	

☐ Additional Inventors are named on separately numbered sheets attached hereto.

Patent Number	Date of Patent Issued

I believe said inventor(s) to be the original and first inventor(s) of the subject matter which is described and claimed in said patent, for which a reissue patent is sought on the invention entitled:

the specification of which

☐ is attached hereto.

☐ was filed on ____________ as reissue application number ________ / ____________

and was amended on ____________
(if applicable)

I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

☐ I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b). Attached is form PTO/SB/02B (or equivalent) listing the foreign applications.

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

☐ by reason of a defective specification or drawing.

☐ by reason of the patentee claiming more or less than he had the right to claim in the patent.

☐ by reason of other errors.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.175. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/52 (10-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REISSUE APPLICATION DECLARATION BY THE ASSIGNEE	Docket Number (Optional)

At least one error upon which reissue is based is described as follows:

[Attach additional sheets, if needed.]

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.

I hereby appoint:

☐ Practitioners associated with Customer Number: ______

OR

☐ Practitioner(s) named below:

Name	Registration Number

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

Correspondence Address: Direct all communications about the application to:

☐ The address associated with Customer Number: ______

OR

☐ Firm or Individual Name					
Address					
City		State		Zip	
Country					
Telephone		Email			

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

Signature	Date
Full name of person signing (given name, family name)	
Address of Assignee	

[Page 2 of 2]

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

<

1414.01 Supplemental Reissue Oath/ Declaration [R-5]

If additional defects or errors are corrected in the reissue after the filing of the application and the original reissue oath or declaration, a supplemental reissue oath/declaration must be filed, unless all additional errors corrected are spelling, grammar, typographical, editorial or clerical errors which are not errors under 35 U.S.C. 251 (see MPEP § 1402). In other words, a supplemental oath/declaration is required where any "error" under 35 U.S.C. 251 has been corrected and the error was not identified in the original reissue oath/declaration.

The supplemental reissue oath/declaration must state that every error which was corrected in the reissue application not covered by the prior oath(s)/declaration(s) submitted in the application arose without any deceptive intention on the part of the applicant.

An example of acceptable language is as follows:

> "Every error in the patent which was corrected in the present reissue application, and is not covered by the prior declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

A supplemental reissue oath/declaration will not be effective for any errors which are corrected by a filing made after the execution of the supplemental reissue oath/declaration, unless it is clear from the record that the parties executing the document were aware of the nature of the correction when they executed the document. Further, a supplemental reissue oath/declaration with an early date of execution cannot be filed after a correction made later in time, to cover the correction made after the execution date. This is so, even if the supplemental reissue oath/declaration states that *all errors up to the filing of the supplemental reissue oath/declaration oath or declaration* arose without any deceptive intention on the part of the applicant.

>

Form PTO/SB/51S, "Supplemental Declaration For Reissue Patent Application To Correct 'Errors' Statement (37 CFR 1.175)," may be used to prepare a supplemental reissue declaration. Form PTO/SB/51S serves to indicate that every error in the patent that was corrected in the reissue application, but was not covered by a prior reissue oath/declaration submitted in the reissue application, arose without any deceptive intention on the part of the applicant.

In the event that the applicant for a reissue applicant is required to file a supplemental reissue oath/declaration that also includes a specific statement of the error being corrected by reissue in accordance with 37 CFR 1.175(c), as discussed in subsection I. below, applicant must also include in the supplemental declaration language equivalent to the "Every error ..." language in the example of acceptable language set forth above. Therefore, if either form PTO/SB/51, "Reissue Application Declaration By The Inventor," or form PTO/SB/52, "Declaration By The Assignee" (see MPEP § 1414) is used for the purpose of filing such supplemental reissue oath/declaration, the form must be completed so that it is clear that the supplemental reissue oath/declaration addresses all errors corrected subsequent to the date upon which the last previously reissue oath/declaration (whether original or supplemental) was filed. For example, the form could be completed by specifying the date upon which the reissue application was originally filed, the reissue application number, and the date(s) of every amendment filed subsequent to the date upon which the last reissue oath/declaration (whether original or supplemental) was filed. Any manner of completing the form so that affiant/declarant unambiguously states that every error corrected subsequent to the filing of the last filed reissue oath/declaration (whether original or supplemental) arose without deceptive intent will be acceptable. It will not be acceptable for the new ("catch-up") oath/declaration to simply refer to the reissue application as filed, even though the new oath/declaration may be submitted after an amendment.<

I. WHEN AN ERROR MUST BE STATED IN THE SUPPLEMENTAL OATH/ DECLARATION

In the supplemental reissue oath/declaration, there is **no need to state an error** which is relied upon to support the reissue application **if**:

(A) an error to support a reissue has been previously and properly stated in a reissue oath/declaration in the application; and

(B) that error is still being corrected in the reissue application.

If applicant chooses to state any further error at this point (even though such is not needed), the examiner should not review the statement of the further error.

The supplemental reissue oath/declaration must state an error which is relied upon to support the reissue application only where one of the following is true:

(A) the prior reissue oath/declaration failed to state an error;

(B) the prior reissue oath/declaration attempted to state an error but did not do so properly; or

(C) all errors under 35 U.S.C. 251 stated in the prior reissue oath(s)/declaration(s) are no longer being corrected in the reissue application.

II. WHEN A SUPPLEMENTAL OATH/DECLARATION MUST BE SUBMITTED

The supplemental oath/declaration in accordance with 37 CFR 1.175(b)(1) must be submitted before allowance. See MPEP § 1444 for a discussion of the action to be taken by the examiner to obtain the supplemental oath/declaration in accordance with 37 CFR 1.175(b)(1), where such is needed.

Where applicant seeks to correct an error after allowance of the reissue application, a supplemental reissue oath/declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant. The supplemental reissue oath/declaration submitted after allowance will be directed to the error applicant seeks to correct after allowance. This supplemental oath/declaration need not cover any earlier errors, since all earlier errors should have been covered by a reissue oath/declaration submitted prior to allowance.

III. SUPPLEMENTAL OATH/DECLARATION IN BROADENING REISSUE

A broadening reissue application must be applied for by all of the inventors (patentees), that is, the original reissue oath/declaration must be signed by all of the inventors. See MPEP § 1414. If a supplemental oath/declaration in a broadening reissue application is subsequently needed in the application in order to fulfill the requirements of 37 CFR 1.175, the supplemental reissue oath/declaration must be signed by all of the inventors. *In re Hayes*, 53 USPQ2d 1222, 1224 (Comm'r Pat. 1999) ("37 CFR 1.175(b)(1), taken in conjunction with Section 1.172, requires a supplemental declaration be signed by all of the inventors. This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and declaration must bear the appropriate signatures of all the inventors.").

If a joint inventor refuses or cannot be found or reached to sign a supplemental oath/declaration, a supplemental oath/declaration listing all the inventors, and signed by all the available inventors may be filed provided it is accompanied by a petition under 37 CFR 1.183 along with the petition fee, requesting waiver of the signature requirement of the nonsigning inventor.

**

**>

PTO/SB/51S (09-04)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

SUPPLEMENTAL DECLARATION FOR REISSUE PATENT APPLICATION TO CORRECT "ERRORS" STATEMENT (37 CFR 1.175)		
	Attorney Docket Number	
	First Named Inventor	
	COMPLETE if known	
	Application Number	
	Filing Date	
	Art Unit	
	Examiner Name	

I/We hereby declare that:

Every error in the patent which was corrected in the present reissue application, and which is not covered by the prior oath(s) and/or declaration(s) submitted in this application, arose without any deceptive intention on the part of the applicant.

I/We hereby declare that all statements made herein of my/our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name of Sole or First Inventor:	☐ A petition has been filed for this unsigned inventor		
Given Name (first and middle [if any])	Family Name or Surname		
Inventor's Signature		Date	
Name of Second Inventor:	☐ A petition has been filed for this unsigned inventor		
Given Name (first and middle [if any])	Family Name or Surname		
Inventor's Signature		Date	
Name of Third Inventor:	☐ A petition has been filed for this unsigned inventor		
Given Name (first and middle [if any])	Family Name or Surname		
Inventor's Signature		Date	
Name of Fourth Inventor:	☐ A petition has been filed for this unsigned inventor		
Given Name (first and middle [if any])	Family Name or Surname		
Inventor's Signature		Date	

☐ Additional inventors or legal representatives(s) are being named on the ________ supplemental sheets PTO/SB/02A or 02LR attached hereto.

This collection of information is required by 37 CFR 1.175. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

<

1415 Reissue Application and Issue Fees [R-5]

I. BASIC REISSUE APPLICATION FILING, SEARCH, AND EXAMINATION FEES

The Consolidated Appropriations Act, 2005 (Consolidated Appropriations Act), effective December 8, 2004, provides for a separate reissue application filing fee, search fee, and examination fee during fiscal years 2005 and 2006. For reissue applications filed on or after December 8, 2004, the following fees are required: basic filing fee as set forth in 37 CFR 1.16(e)(1); search fee as set forth in 37 CFR 1.16(n); examination fee as set forth in 37 CFR 1.16(r); application size fee, if applicable (see subsection II. below); and excess claims fees, if applicable (see subsection III. below).

For reissue applications filed prior to December 8, 2004, the following fees are required: basic filing fee as set forth in 37 CFR 1.16(e)(2); and excess claims fees, if applicable (see subsection III below). No search and examination fees are required for reissue applications filed before December 8, 2004.

The basic filing, search and examination fees are due on filing of the reissue application. These fees may be paid on a date later than the filing date of the reissue application provided they are paid within the time period set forth in 37 CFR 1.53(f) and include the surcharge set forth in 37 CFR 1.16(f). For reissue applications filed on or after December 8, 2004 but prior to July 1, 2005, which have been accorded a filing date under 37 CFR 1.53(b), if the search and/or examination fees are paid on a date later than the filing date of the reissue application, the surcharge under 37 CFR 1.16(f) is not required. For reissue applications filed on or after July 1, 2005, which have been accorded a filing date under 37 CFR 1.53(b), if any of the basic filing fee, the search fee, or the examination fee are paid on a date later than the filing date of the reissue application, the surcharge under 37 CFR 1.16(f) is required.

>For reissue applications filed on or after December 8, 2004, in which a petition under 37 CFR 1.138(d) to expressly abandon the application was filed on or after March 10, 2006, applicant may file a request for refund of the search fee and excess claims fee paid in the application. See MPEP § 711.01.<

II. APPLICATION SIZE FEE

The Consolidated Appropriations Act also provides for an application size fee. 37 CFR 1.16(s) sets forth the application size fee for reissue applications filed on or after December 8, 2004, the specification and drawings of which, excluding a sequence listing or computer program listing filed in an electronic medium in compliance with the rules (see 37 CFR 1.52(f)), exceed 100 sheets of paper. The application size fee does not apply to reissue applications filed before December 8, 2004. The application size fee applies for each additional 50 sheets or fraction thereof over 100 sheets of paper. Any sequence listing in an electronic medium in compliance with 37 CFR 1.52(e) and 37 CFR 1.821(c) or (e), and any computer program listing filed in an electronic medium in compliance with 37 CFR 1.52(e) and 1.96, will be excluded when determining the application size fee required by 37 CFR 1.16(s). See also MPEP § 607.

III. EXCESS CLAIMS FEES

37 CFR 1.16(h) sets forth the excess claims fee for each independent claim in excess of three. 37 CFR 1.16(i) sets forth the excess claims fee for each claim (whether independent or dependent) in excess of twenty. The access claims fees specified in 37 CFR 1.16(h) and (i) apply to all reissue applications pending on or after December 8, 2004. The excess claims fees specified in 37 CFR 1.16(h) and (i) apply to any excess claims fee paid on or after December 8, 2004, regardless of the filing date of the reissue application and regardless of the date on which the claim necessitating the excess claims fee payment was added to the reissue application.

>For reissue applications filed on or after December 8, 2004, in which a petition under 37 CFR 1.138(d) to expressly abandon the application was filed on or after March 10, 2006, applicant may file a request for refund of the search fee and excess claims fee paid in the application. See MPEP § 711.01.<

Under 35 U.S.C. 41(a)(2) as amended by the Consolidated Appropriations Act, the claims in the original patent are not taken into account in determining the excess claims fee for a reissue application.

Example 1:

Applicant filed a reissue application before December 8, 2004, with the same number of claims as in the patent. The patent has more than 3 independent claims and more than 20 total claims. If applicant added one more independent claim in the reissue application by filing an amendment before December 8, 2004, but did not pay for the excess claims fees prior to December 8, 2004, on or after December 8, 2004, applicant will have to pay for one additional independent claim per the fee set forth in 37 CFR 1.16(h) and one additional total claim per the fee set forth in 37 CFR 1.16(i).

Example 2:

Applicant filed a reissue application on or after December 8, 2004, with the same number of claims as in the patent. The patent has 4 independent claims and 21 total claims. Excess claims fees for the 4th independent claim (one additional independent claim per the fee set forth in 37 CFR 1.16(h)) and the 21st claim (one additional total claim per the fee set forth in 37 CFR 1.16(i)) are required. Under 35 U.S.C. 41(a)(2) as amended by the Consolidated Appropriations Act, the claims in the original patent are not taken into account in determining the excess claims fees for a reissue application.

The excess claims fees, if any, due with an amendment are required prior to any consideration of the amendment by the examiner. Upon submission of an amendment (whether entered or not) affecting the claims, payment of fees for those claims in excess of the number previously paid for is required. The additional fees, if any, due with an amendment are calculated on the basis of the claims (total and independent) which would be present, if the amendment were entered. If an amendment is limited to revising the existing claims and it does not result in the addition of any new claim, there is no excess claim fee. Excess claims fees apply only to the addition of claims. It is to be noted that where excess claims fees have been previously paid, a later amendment affecting the claims cannot serve as the basis for granting any refund. See 37 CFR 1.26(a).

Amendments filed before a first Office action, or otherwise not filed in reply to an Office action, presenting additional claims in excess of the number already paid for, not accompanied by the full additional claims fee due, will not be entered in whole or in part and applicant will be so notified. Such amendments filed in reply to an Office action will be regarded as being non-responsive to the Office action and the practice set forth in MPEP § 714.03 will be followed.

An amendment canceling claims accompanying the papers constituting the reissue application will be effective to diminish the number of claims to be considered in calculating the filing fees to be paid. A preliminary amendment filed concurrently with a reply to a Notice To File Missing Parts of Application that required the filing fees, which preliminary amendment cancels or adds claims, will be taken into account in determining the appropriate filing fees due in response to the Notice To File Missing Parts of Application. However, no refund will be made for claims being canceled in the reply that have already been paid for.

After a requirement for restriction, non-elected claims will be included in determining the fees due in connection with a subsequent amendment unless such claims are canceled.

IV. ISSUE FEE

The issue fee for issuing each reissue patent is set forth in 37 CFR 1.18(a).

V. REISSUE APPLICATION FEE TRANSMITTAL FORM

The Office has prepared Form PTO/SB/56, Reissue Application Fee Transmittal Form which is designed to assist in the correct calculation of reissue filing fees.

PTO/SB/56 (6-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REISSUE APPLICATION FEE TRANSMITTAL FORM

Docket Number (Optional)

Application as Filed – Part 1

	(1) Claims Filed in Reissue Application	(2) Minus claims included in the basic filing fee	(3) Number Extra	Small Entity Rate ($)	Small Entity Fee ($)		Other than a Small Entity Rate ($)	Other than a Small Entity Fee ($)
Total Claims (37 CFR 1.16(i))		- 20 =		x =			x =	
Independent Claims (37 CFR 1.16(h))		- 3 =		x =			x =	
Application Size Fee (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).					or		
			Filing Fee (37 CFR 1.16(a))					
			Search Fee (37 CFR 1.16(n))					
			Examination Fee (37 CFR 1.16(r))					
			Total Filing Fee					

Application as Amended – Part 2

	(1) Claims After Amendment including cancellation of claims		(2) Highest Number Previously Paid For	(3) Extra Claims Present	Small Entity Rate ($)	Small Entity Fee ($)		Other than a Small Entity Rate ($)	Other than a Small Entity Fee ($)
Total Claims (37 CFR 1.16(i))		MINUS	*	=	x =			x =	
Independent Claims (37 CFR 1.16(h))		MINUS	**	=	x =		or	x =	
Application Size Fee (37 CFR 1.16(s))									
				Total Additional Fee					

* Enter the greater of (a) 20 or (b) the highest number of total claims previously paid for in this reissue application.
** Enter the greater of (a) 3 or (b) the highest number of independent claims previously paid for in this reissue application.

☐ Applicant claims small entity status. See 37 CFR 1.27.

☐ Please charge Deposit Account No. ____________________ in the amount of ____________________.
A duplicate copy of this sheet is enclosed.

☐ The Director is hereby authorized to charge any additional fees under 37 CFR 1.16 or 1.17 which may be required, or credit any overpayment to Deposit Account No. ____________________. A duplicate copy of this sheet is enclosed.

☐ A check in the amount of $ ____________________ to cover the filing/additional fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached. WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

______________________________ Signature ______________ Date

______________________________ Typed or printed name ______________ Registration Number, if applicable

______________________________ E-mail Address ______________ Telephone Number

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

1415.01 Maintenance Fees on the Original Patent [R-5]

The filing of a reissue application does not alter the schedule of payments of maintenance fees on the original patent. If maintenance fees have not been paid on the original patent as required by 35 U.S.C. 41(b) and 37 CFR 1.20, and the patent has expired, no reissue patent can be granted. 35 U.S.C. 251, first paragraph, only authorizes the granting of a reissue patent for the unexpired term of the original patent. Once a patent has expired, the Director of the USPTO no longer has the authority under 35 U.S.C. 251 to reissue the patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993).

The examiner should determine whether all required maintenance fees have been paid *prior to conducting an examination* of a reissue application. In addition, during the process of preparing the reissue application for issue, the examiner should again determine whether all required maintenance fees have been paid up to date.

The history of maintenance fees is determined by the following, all of which should be used (to provide a check on the search made):

(A) Go to the USPTO Intranet (http://ptoweb/pto-intranet/index.htm) and select the PALM screen, then the "General Information" screen, type in the patent number and then select the "Fees" screen.

(B) Go to the USPTO Intranet and then the "Revenue Accounting and Management" screen, then the "File History" screen. Then type in the patent number.

(C) Go to the USPTO Internet Site (http://www.uspto.gov) and select "eBusiness", then the "Patent Electronic Business Center" screen, then the "Patent Application Information Retrieval (PAIR)" screen (http://pair.uspto.gov/cgi-bin/final/home.pl), and type in the patent number and select the "view Maint. Statement" screen.

If the window for the maintenance fee due has closed (maintenance fees are due by the day of the 4th, 8th and 12th year anniversary of the grant of the patent), but the maintenance fee has not been paid, ** the Office of Patent Legal Administration (OPLA) **>should be contacted by the Technology Center (TC) Special Program Examiner (SPRE) for instructions as to what appropriate action to take.<

PAYMENT OF MAINTENANCE FEES WHERE THE PATENT HAS BEEN REISSUED

Pursuant to 37 CFR 1.362(b), maintenance fees are not required for a reissue patent if the original patent that was reissued did not require maintenance fees.

Where the original patent that was reissued did require maintenance fees, the schedule of payments of maintenance fees on the original patent will continue for the reissue patent. 37 CFR 1.362(h). Once an original patent reissues, maintenance fees are no longer due in the original patent, but rather the maintenance fees are due in the reissue patent. This is because upon the issuance of the reissue patent, the original patent is surrendered and ceases to exist.

In some instances, more than one reissue patents will be granted to replace a single original patent. The issuance of more than one reissue patent does not alter the schedule of payments of maintenance fees on the original patent. The existence of multiple reissue patents for one original patent can arise where multiple divisional reissue applications are filed for the same patent, and the multiple applications issue as reissue patents (all to replace the same original patent). In addition, a divisional application or continuation application of an existing reissue application may be filed, and both may then issue as reissue patents. In such instances, 35 U.S.C. 41 does not provide for the charging of more than one maintenance fee for the multiple reissues. Thus, no payment of additional maintenance fees is required for the second or subsequent reissue patents, i.e., continuation or divisional reissues, which are derived from a first reissue patent which has issued. The maintenance fee must be directed to the first reissue patent that has issued. This is unlike the instance where there is a reissue of a reissue patent, and the maintenance fee must be directed to the reissue of the reissue patent.

See MPEP Chapter 2500 for additional information pertaining to maintenance fees.

1416 **>No Physical Surrender of Original Patent< [R-3]

37 CFR 1.178. Original patent; continuing duty of applicant.

(a) **>The application for reissue of a patent shall constitute an offer to surrender that patent, and the surrender shall take effect upon reissue of the patent. Until a reissue application is granted, the original patent shall remain in effect.<

*****

**>37 CFR 1.178(a) was amended, effective October 21, 2004, to eliminate the requirement for physical surrender of the original letters patent (i.e., the "ribbon copy" of the original patent) in a reissue application, and to make surrender of the original patent automatic upon the grant of the reissue patent.

Amended 37 CFR 1.178(a) applies retroactively to all pending applications. For those applications with an outstanding requirement for the physical surrender of the original letters patent, a reissue applicant must timely reply that the requirement is moot in view of the implementation of the amended rule. Such a reply will be considered a complete reply to any requirement directed toward the surrender of the original letters patent. It is to be noted that the Office will not conduct a search to withdraw Office actions where the only outstanding requirement is compliance with the physical surrender of the original letters patent.

Example 1:

An Office action issues prior to the effective date of the amendment to 37 CFR 1.178 with only a requirement for a return of the original letters patent to the Office. A two-month period for reply is set in the Office action. Applicant fails to timely reply to the Office action, relying on the amendment to 37 CFR 1.178 as mooting the requirement for physical surrender of the original letters patent. The six-month full statutory period for reply expires. In this instance, the reissue application would be abandoned (as of the day after the last day of the two-month period set in the Office action) for failure to timely reply to the Office action, because no reply was timely filed.

Example 2:

An Office action issues prior to the effective date of the amendment to 37 CFR 1.178 with the only requirement for a return of the original letters patent to the Office. Applicant fails to reply to the Office action within the two-month period set in the Office action, relying on the amendment to 37 CFR 1.178 as mooting the requirement for physical surrender of the original letters patent. In reviewing the reissue application in connection with a related application, the examiner notes the omission prior to the expiration of the six-month full statutory period for reply. In this instance, the examiner may telephone the applicant, and remind the applicant of the need to file a timely reply.

Example 3:

An Office action issues prior to the effective date of the amendment to 37 CFR 1.178 with the only requirement being a return of the original letters patent to the Office. Applicant timely replies to the Office that it should vacate/withdraw the requirement, or otherwise indicates that return of the original letters patent is now unnecessary. In this instance, a complete reply would have been filed, and the requirement would be withdrawn and the application passed to issue.

Example 4:

An Office action issues prior to the effective date of the amendment to 37 CFR 1.178 with both (a) a requirement to return the original letters patent to the Office, and (b) a rejection of the claims under 35 U.S.C. 103. Applicant timely replies to the Office action addressing only the rejection under 35 U.S.C. 103 (but not the need for physical surrender of the original letters patent). In this instance, the reply would be accepted as complete, and the Office would withdraw the requirement for physical surrender of the original letters patent. (The requirement was proper when made, so the Office would not vacate the action in regard to submission of the original letters patent.).

Where the patentee has submitted the original letters patent in a reissue application subject to 37 CFR 1.178 as it is now amended, the Office may, in response to a timely request, return the original letters patent, <u>when it can be readily retrieved from where it is stored</u>, namely, the paper application file, or the artifact storage area for an Image File Wrapper (IFW) file. Any request for return of the letters patent which is submitted after the issue fee has been paid will require a petition pursuant to 37 CFR 1.59(b) to expunge from the file and return the original letters patent. Where the original letters patent cannot be readily retrieved, or in the rare instance that it has been subsequently misplaced, the Office will not be able to return the original letters patent and will not create a new one.

Example 5:

In an application filed after the effective date of the amendment to 37 CFR 1.178, applicant has mistakenly submitted the original letters patent and later seeks its return. In this instance, provided applicant timely requests the return of the original letters patent, the Office would return the patent, *provided it can be readily retrieved.*

Example 6:

A reissue application was pending at the time of the effective date of the amendment to 37 CFR 1.178, and an original letters patent was submitted. Applicant requests return of the original letters patent, although the application is abandoned at the time the request for return is made. In this instance, the Office would return the original letters patent if *it is readily retrievable*. Even where the reissue application was already abandoned at the time of the effective date of the amendment to 37 CFR 1.178, the Office would also return the original letters patent.

Example 7:

A reissue application is pending at the time of the effective date of the amendment to 37 CFR 1.178. An original letters patent was submitted, and the issue fee has been paid for the reissue application at the time the request for return of the original letters patent is made. In this instance, the Office may similarly return the original letters patent, but only if the request is accompanied by a grantable petition under 37 CFR 1.59(b).

Example 8:

A reissue application was pending at the time of the effective date of the amendment to 37 CFR 1.178. An original letters patent was submitted, and the reissue application then issued as a reissue patent. After the reissue patent issues, the request for return of the original letters patent is made. Once again, the Office may return the original letters patent, but only if the request is accompanied by a grantable petition under 37 CFR 1.59(b).

Example 9:

A reissue application issued as a reissue patent prior to the effective date of the amendment to 37 CFR 1.178. The reissue applicant, now the patentee, requests return of the original letters patent that was submitted in the reissue application. In this instance, the Office will not return the original letters patent. The original letters patent was submitted in reply to a requirement that was in effect throughout the pendency of the reissue application.<

**

1417 Claim for Benefit Under 35 U.S.C. 119(a)-(d) [R-5]

PRIORITY UNDER 35 U.S.C. 119(a)-(d) WAS PERFECTED IN THE ORIGINAL PATENT

A “claim” for the benefit of an earlier filing date in a foreign country under 35 U.S.C. 119(a)-(d) must be made in a reissue application, even though such a claim was previously made in the application for the original patent to be reissued. However, no additional certified copy of the foreign application is necessary. The procedure is similar to that for “Continuing Applications” in MPEP § 201.14(b).

In addition, 37 CFR 1.63 requires that in *any* application in which a claim for foreign priority is made pursuant to 37 CFR 1.55, the oath or declaration must identify the foreign application for patent or inventors’ certificate on which priority is claimed unless supplied on an application data sheet (37 CFR 1.76), and any foreign applications having a filing date before that of the application on which priority is claimed, by specifying:

(A) the application number of the foreign application;

(B) the foreign country or intellectual property authority; and

(C) the day, month, and year of the filing of the foreign application.

The examiner should note that the heading on printed copies of the patent will not be carried forward to the reissue from the original patent. Therefore, it is important that the bibliographic data sheet (or the front face of the reissue file wrapper for series 08/ and earlier paper applications) be endorsed by the examiner under "FOREIGN APPLICATIONS." For an IFW reissue file, a copy of the bibliographic data sheet should be printed from the IFW file history. The printed copy should be annotated by the examiner and then the annotated copy should be scanned into the IFW.

PRIORITY UNDER 35 U.S.C. 119(a)-(d) IS NEWLY PERFECTED IN THE REISSUE APPLICATION

A reissue was granted in *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968), where the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under 35 U.S.C. 119(a)-(d) before the patent was granted. In *Brenner*, the claim for priority had been made in the prosecution of the original patent, and it was only necessary to submit a certified copy of the priority document in the reissue application to perfect priority (the claim for priority must be repeated in the reissue application). Reissue is also available to correct the "error" in failing to take any steps to obtain the right of foreign priority under 35 U.S.C. 119(a)-(d) before the original patent was granted. >See *Fontijn v. Okamoto*, 518 F.2d 610, 622, 186 USPQ 97, 106 (CCPA 1975) ("a patent may be reissued for the purpose of establishing a claim to priority which was not asserted, or which was not perfected during the prosecution of the original application")< In a situation where it is necessary to submit for the first time both the claim for priority and the certified copy of the priority document in the reissue application and the patent to be reissued resulted from a utility or plant application filed on or after November 29, 2000, the reissue applicant will have to file a petition for an unintentionally delayed priority claim under 37 CFR 1.55(c) in addition to filing a reissue application. See MPEP § 201.14(a).

1418 Notification of Prior/Concurrent Proceedings and Decisions Thereon, and of Information Known to be Material to Patentability [R-3]

37 CFR 1.178. Original patent; continuing duty of applicant.

*****

(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigations and the results of such proceedings (see also § 1.173(a)(1)).

37 CFR 1.178(b) requires reissue applicants to call to the attention of the Office any prior or concurrent proceeding in which the patent (for which reissue is requested) is or was involved and the results of such proceedings. These proceedings would include interferences, reissues, reexaminations, and litigations. Litigation would encompass any papers filed in the court or issued by the court, which may include, for example, motions, pleadings, and court decisions. This duty to submit information is continuing, and runs from the time the reissue application is filed until the reissue application is abandoned or issues as a reissue patent.

In addition, a reissue application is subject to the same duty of disclosure requirements as is any other nonprovisional application. The provisions of 37 CFR 1.63 require acknowledgment in the reissue oath or declaration of the "duty to disclose to the Office all information known to the [applicants] to be material to patentability as defined in § 1.56." Note that the Office imposes no responsibility on a reissue applicant to resubmit, in a reissue application, all the "References Cited" in the patent for which reissue is sought. Rather, applicant has a continuing duty under 37 CFR 1.56 to timely apprise the Office of any information which is material to the patentability of the claims under consideration in the reissue application.

37 CFR 1.97 and 37 CFR 1.98 provide a mechanism to submit information known to applicants to be material to patentability. Information submitted in compliance with 37 CFR 1.97 and 37 CFR 1.98 will be considered by the Office. See MPEP § 609. Although a reissue applicant may utilize 37 CFR 1.97 and 37 CFR 1.98 to comply with the duty of disclo-

sure required by 37 CFR 1.56, this does not relieve applicant of the duties under 37 CFR 1.175 of, for example, stating "at least one error being relied upon."

While 37 CFR 1.97(b) provides for the filing of an information disclosure statement within 3 months of the filing of an application or before the mailing date of a first Office action, reissue applicants are encouraged to file information disclosure statements at the time of filing of the reissue application so that such statements will be available to the public during the 2-month period provided in MPEP § 1441. Form paragraph 14.11.01 may be used to remind applicant of the **>duties to timely make the Office aware of (A) any prior or concurrent proceeding (e.g., litigation or Office proceedings) in which the patent to be reissued is or was involved, and (B) any information which is material to patentability of the claims in the reissue application<.

¶ *14.11.01 Reminder of Duties Imposed by 37 CFR 1.178(b) and 37 CFR 1.56*

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. [1] is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Examiner Note:

1. This form paragraph is to be used in the first action in a reissue application.
2. In bracket [1], insert the patent number of the original patent for which reissue is requested.

1430 Reissue Files Open to the Public and, Notice of Filing Reissue Announced in, *Official Gazette* [R-3]

37 CFR 1.11. Files open to the public.

*****

(b) All reissue applications, all applications in which the Office has accepted a request to open the complete application to inspection by the public, and related papers in the application file, are open to inspection by the public, and copies may be furnished upon paying the fee therefor. The filing of reissue applications, other than continued prosecution applications under § 1.53(d) of reissue applications, will be announced in the *Official Gazette*. The announcement shall include at least the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and examining group to which the reissue application is assigned.

*****

Under 37 CFR 1.11(b) all reissue applications filed after March 1, 1977, are open to inspection by the general public, and copies may be furnished upon paying the fee therefor. The filing of reissue applications (except for continued prosecution applications (CPA's) filed under 37 CFR 1.53(d)) will be announced in the *Official Gazette*. The announcement gives interested members of the public an opportunity to submit to the examiner information pertinent to the patentability of the reissue application. The announcement includes the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and the Technology Center (TC) to which the reissue application is initially assigned. A TC Director or other appropriate Office official may, under appropriate circumstances, postpone access to or the making of copies of a >paper< reissue application >file<, such as, for example, to avoid interruption of the examination or other review of the application by an examiner. **

>IFW reissue application files are open to inspection by the general public by way of Public PAIR via the USPTO Internet site. In viewing the images of the files, members of the public will be able to view the entire content of the reissue application file history. To access Public PAIR, a member of the public would (A) go to the USPTO web site at http://www.uspto.gov, (B) click on "Patents", (C) under "Check Status, View Papers..." click on "Status & IFW," and (D) under "Patent Application Information Retrieval" enter the reissue application number.<

A notice of a reissue application in the *Official Gazette* should be published prior to any examination of the application. If an inadvertent failure to publish notice of the filing of the reissue application in the *Official Gazette* is recognized later in the examination, action should be taken to have the notice published as quickly as possible, and action on the application may be delayed until two months after the publication, allowing for any protests to be filed. For a discussion of protests, see MPEP Chapter 1900.

The filing of a continued prosecution application (CPA) under 37 CFR 1.53(d) of a reissue application will not be announced in the *Official Gazette*. Although the filing of a CPA of a reissue application constitutes the filing of a reissue application, the announcement of the filing of such CPA would be redundant in view of the announcement of the filing of the prior reissue application in the *Official Gazette* and the fact that the same application number and file will continue to be used for the CPA.

If applicant files a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114 (which can be filed on or after May 29, 2000 for a reissue application filed on or after June 8, 1995), such filing will not be announced in the *Official Gazette*. An RCE continues prosecution of the existing reissue application and is not a filing of a new application.

**

The filing of all reissue applications, except for CPAs filed under 37 CFR 1.53(d), (note that effective July 14, 2003, CPA practice has been eliminated as to utility and plant application) will be announced in the *Official Gazette* and will include certain identifying data as specified in 37 CFR 1.11(b). >Access to a reissue application that is maintained in paper must be obtained from the area of the Office having jurisdiction over the reissue application file.

For reissue application files that are maintained in paper, the following access procedure will be observed:

(A)< Any member of the general public may request access to a particular reissue application filed after March 1, 1977. ** Since no record of such request is intended to be kept, an oral request will suffice. >Reissue applications already on file prior to March 1, 1977 are not automatically open to inspection, but a liberal policy is followed by the Office of Patent Legal Administration and by the Board of Patent Appeals and Interferences (see MPEP § 1002.02(b)) in granting petitions for access to such applications.<

(B) *>Paper< reissue application files will be maintained in the TCs and inspection thereof will be supervised by TC personnel. Although no general limit is placed on the amount of time spent reviewing the files, the Office may impose limitations, if necessary, e.g., where the application is actively being processed. **

(C) Where the reissue application >file< has left the TC for administrative processing, requests for access should be directed to the appropriate supervisory personnel where the application is currently located. **

(D) Requests for copies of papers in the reissue application file must be in writing and addressed to the Mail Stop Document Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. Such requests may be either mailed or delivered to the Office Customer Service Window (See MPEP § 502). The price for copies made by the Office is set forth in 37 CFR 1.19.

1440 Examination of Reissue Application [R-3]

37 CFR 1.176. Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

37 CFR 1.176 provides that an original claim, if represented in a reissue application, will be fully examined in the same manner, and subject to the same rules as if being presented for the first time in an original non-reissue, nonprovisional application, except that division will not be required by the examiner. See MPEP § 1450 and § 1451. Reissue applications are normally examined by the same examiner who issued the patent for which reissue is requested. In addition, the application will be examined with respect to compliance with 37 CFR 1.171-*>1.178< relating specifically to reissue applications, for example, the reissue oath or declaration will be carefully reviewed for compliance with 37 CFR 1.175. See MPEP § 1444 for handling applications in which the oath or declaration

lacks compliance with 37 CFR 1.175. Reissue applications with related litigation will be acted on by the examiner before any other special applications, and will be acted on immediately by the examiner, subject only to a 2-month delay after publication for examining reissue applications; see MPEP § 1441.

The original patent file wrapper /file history should always be obtained and reviewed when examining a reissue application thereof.

1441 Two-Month Delay Period [R-3]

37 CFR 1.176 provides that reissue applications will be acted on by the examiner in advance of other applications, i.e., "special." Generally, a reissue application will not be acted on sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action. The pertinent information is submitted in the form of a protest under 37 CFR 1.291(a). For a discussion as to protests under 37 CFR 1.291(a) in reissue applications, see MPEP § 1441.01. As set forth in MPEP § 1901.04, the public should be aware that such submissions should be made as early as possible, since, under certain circumstances, the 2-month delay period will not be employed. For example, the Office may act on a continuation or a divisional reissue application prior to the expiration of the 2-month period after announcement. Additionally, the Office will entertain a petition under 37 CFR 1.182 which is accompanied by the required petition fee (37 CFR 1.17(*>f<)) to act on a reissue application without delaying for 2 months. Accordingly, protestors to reissue applications (see MPEP § 1441.01) cannot automatically assume that a full 2-month delay period will always be available. Appropriate reasons for requesting that the 2-month delay period not be employed include that litigation >involving a patent< has been stayed to permit the filing of >an application for< the reissue *>of the patent. Where the basis for the petition is ongoing litigation, the petition must clearly identify the litigation, and detail the specifics of the litigation that call for prompt action on the reissue application prior to the expiration of the 2-month delay period.< Such petitions are decided by the Office of Patent Legal Administration.

1441.01 Protest in Reissue Applications [R-3]

**>A protest pursuant to 37 CFR 1.291 may be filed throughout the pendency of a reissue application, prior to the date of mailing of a notice of allowance, subject to the timing constraints of the examination, as set forth in MPEP § 1901.04. While a reissue application is not published under 37 CFR 1.211, the reissue application is published pursuant to 35 U.S.C. 122(b)(1)(A) via an announcement in the *Official Gazette* (and public availability of the file content) per 37 CFR 1.11(b). Such a publication does not preclude the filing of a protest. 35 U.S.C. 122(c) states:

> "(c) PROTEST AND PRE-ISSUANCE OPPOSITION- The Director shall establish appropriate procedures to ensure that **no protest or other form of pre-issuance opposition** to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant." [Emphasis added.]

A protest is precluded after publication for an application for an original patent, as a "form of pre-issuance opposition." A reissue application is a post-issuance proceeding. A protest filed in a reissue application is not a "form of pre-issuance opposition to the grant of a patent" since the patent to be reissued has already been granted. Thus, the prohibition against the filing of a protest after publication of an application under 35 U.S.C. 122(c) is not applicable to a reissue application and a protest is permitted after publication of the reissue application.<

A protest with regard to a reissue application should be filed within the 2-month period following the announcement of the filing of the reissue application in the *Official Gazette*. If the protest of a reissue application cannot be filed within the 2-month delay period, the protest can be submitted at a later time. Where the protest is submitted after the 2-month period, no petition for entry of the protest under 37 CFR 1.182 is needed with respect to the protest being submitted after the 2 months, unless a final rejection has been issued or prosecution on the merits has been >otherwise< closed for the reissue application.

**>A potential protestor should be aware that reissue applications are taken up "special" and a protest filed outside the 2-month delay period may be received after action by the examiner.< Once the first Office action is mailed (after the 2-month period), a member of the public may still submit pertinent information in the form of a protest under 37 CFR 1.291*, and the examiner will consider the information submitted in the next Office action, to the extent that such consideration is appropriate. **>Where a final rejection has been issued or the prosecution on the merits has been otherwise closed, a petition under 37 CFR 1.182 along with the required petition fee (37 CFR 1.17(f)) for entry of the protest are required. The petition must include an explanation as to why the additional time was necessary and the nature of the protest intended. A copy of the petition must be served upon the applicant in accordance with 37 CFR 1.248. The petition should be directed to the Office of Petitions.

If the protest of a reissue application cannot be filed within the 2-month delay period, the protestor may petition to request (A) an extension of the 2-month period following the announcement in the *Official Gazette*, and (B) a delay of the examination until the extended period expires. Such a request will be considered only if filed in the form of a petition under 37 CFR 1.182 and accompanied by the petition fee set forth in 37 CFR 1.17(f). The petition under 37 CFR 1.182 and the petition fee must be filed prior to the expiration of the 2-month period following the announcement of the filing of the reissue application in the *Official Gazette*. The petition must explain why the additional time is necessary and the nature of the protest intended. A copy of the petition must be served upon applicant in accordance with 37 CFR 1.248. The petition should be directed to the appropriate Technology Center (TC) which will forward the petition to the Office of Patent Legal Administration.

If the protest is a "REISSUE LITIGATION" protest, it is particularly important that it be filed early if protestor wishes it considered at the time the Office first acts on the reissue application. Protestors should be aware that the Office will entertain petitions from the reissue applicants under 37 CFR 1.182 to waive the 2-month delay period in appropriate circumstances. Accordingly, protestors to reissue applications cannot automatically assume that the full 2-month delay period will always be available.<

The Technology Center (TC) to which the reissue application is assigned is listed in the *Official Gazette* notice of filing of the reissue application. Accordingly, the indicated TC should retain >jurisdiction over< the reissue application file for 2 months after the date of the *Official Gazette* notice before transferring the reissue application under the procedure set forth in MPEP § 903.08(d). **

The publication of a notice of a reissue application in the *Official Gazette* should be done prior to any examination of the reissue application. If an inadvertent failure to publish notice of the filing of the reissue application in the *Official Gazette* is recognized later in the examination, action should be taken to have the notice published as quickly as possible, and action on the reissue application may be delayed until 2 months after the publication, allowing for any protests to be filed.

See MPEP § 1901.06 for general procedures on examiner treatment of protests in reissue applications.

1442 Special Status

All reissue applications are taken up "special," and remain "special" even though applicant does not respond promptly.

All reissue applications, except those under suspension because of litigation, will be taken up for action ahead of other "special" applications; this means that all issues not deferred will be treated and responded to immediately. Furthermore, reissue applications involved in litigation will be taken up for action in advance of other reissue applications.

1442.01 Litigation-Related Reissues [R-5]

During initial review, the examiner should determine whether the patent for which the reissue has been filed is involved in litigation, and if so, the status of that litigation. If the examiner becomes aware of litigation involving the patent sought to be reissued during examination of the reissue application, and applicant has not made the details regarding that litigation of record in the reissue application, the examiner, in the next Office action, will inquire regarding the specific details of the litigation.

Form paragraph 14.06 may be used for such an inquiry.

¶ *14.06 Litigation-Related Reissue*

The patent sought to be reissued by this application [1] involved in litigation. Any documents and/or materials which would be material to patentability of this reissue application are required to be made of record in response to this action.

Due to the related litigation status of this application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED DURING THE PROSECUTION OF THIS APPLICATION.

Examiner Note:

In bracket 1, insert either —is— or —has been—.

If additional details of the litigation appear to be material to examination of the reissue application, the examiner may make such additional inquiries as necessary and appropriate.

>For reissue application files that are maintained in paper, if< the existence of litigation has not already been noted, the examiner should place a prominent notation on the application file to indicate the litigation (1) at the bottom of the face of the file in the box just to the right of the box for the retention label, and (2) on the pink Reissue Notice Card form. >For reissue application files that are maintained in the Image File Wrapper (IFW) system, if the existence of litigation has not already been noted, the examiner should print out a copy of the bibliographic data sheet from the IFW file history and annotate the printed bibliographic data sheet such that adequate notice is provided of the existence of the litigation. The examiner should place the annotation in a prominent place. The annotated sheet should be scanned into IFW.<

Applicants will normally be given 1 month to reply to Office actions in all reissue applications which are being examined during litigation, or after litigation had been stayed, dismissed, etc., to allow for consideration of the reissue by the Office. This 1-month period may be extended only upon a showing of *clear justification* pursuant to 37 CFR 1.136(b). The Office action will inform applicant that the provisions of 37 CFR 1.136(a) are not available. Of course, up to 3 months may be set for reply if the examiner determines such a period is clearly justified.

1442.02 Concurrent Litigation [R-5]

In order to avoid duplication of effort, action in reissue applications in which there is an indication of concurrent litigation will be suspended automatically unless and until it is evident to the examiner, or the applicant indicates, that any one of the following applies:

(A) a stay of the litigation is in effect;

(B) the litigation has been terminated;

(C) there are no significant overlapping issues between the application and the litigation; or

(D) it is applicant's desire that the application be examined at that time.

Where any of (A) - (D) above apply, form paragraphs 14.08-14.10 may be used to deny a suspension of action in the reissue, i.e., to deny a stay of the reissue proceeding.

¶ *14.08 Action in Reissue Not Stayed — Related Litigation Terminated*

Since the litigation related to this reissue application is terminated and final, action in this reissue application will NOT be stayed. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

¶ *14.09 Action in Reissue Not Stayed — Related Litigation Not Overlapping*

While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because there are no significant overlapping issues between the application and that litigation. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

¶ *14.10 Action in Reissue Not Stayed — Applicant's Request*

While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because of applicant's request that the application be examined at this time. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

Where none of (A) through (D) above apply, action in the reissue application in which there is an indication of concurrent litigation will be suspended by the examiner. The examiner should consult with the *>Technology Center< Special Program Examiner prior to suspending action in the reissue. Form paragraph 14.11 may be used to suspend action, i.e., stay action, in a reissue application with concurrent litigation.

¶ *14.11 Action in Reissue Stayed - Related Litigation*

In view of concurrent litigation, and in order to avoid duplication of effort between the two proceedings, action in this reissue application is STAYED until such time as it is evident to the examiner that (1) a stay of the litigation is in effect, (2) the litigation has been terminated, (3) there are no significant overlapping issues between the application and the litigation, or (4) applicant requests that the application be examined.

An *ex parte* reexamination proceeding will **not** be stayed where there is litigation. See *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). Thus, where a reissue application has been merged with an *ex parte* reexamination proceeding, the merged proceeding will **not** be stayed where there is litigation. In a merged *ex parte* reexamination/reissue proceeding, the *ex parte* reexamination will control because of the *statutory* (35 U.S.C. 305) requirement that *ex parte* reexamination proceedings be conducted with special dispatch. See MPEP § 2285 and § 2286. As to a stay or suspension where reissue proceedings are merged with *inter partes* reexamination proceedings, see 37 CFR 1.937 and MPEP § 2686.

1442.03 Litigation Stayed [R-3]

All reissue applications, except those under suspension because of litigation, will be taken up for action ahead of other "special" applications; this means that all issues not deferred will be treated and responded to *immediately*. Furthermore, reissue applications involved in "stayed litigation" will be taken up for action in advance of other reissue applications. Great emphasis is placed on the expedited processing of such reissue applications. The courts are especially interested in expedited processing in the Office where litigation is stayed.

In reissue applications with "stayed litigation," the Office will entertain petitions under 37 CFR 1.182, which are accompanied by the fee under 37 CFR 1.17(*>f<), to not apply the 2-month delay period stated in MPEP § 1441. Such petitions are decided by the Office of Patent Legal Administration.

Time-monitoring systems have been put into effect which will closely monitor the time used by applicants, protestors, and examiners in processing reissue applications of patents involved in litigation in which the court has stayed further action. Monthly reports on the status of reissue applications with related litigation are required from each Technology Center (TC). Delays in reissue processing are to be followed up. The TC Special Program Examiner is responsible for oversight of reissue applications with related litigation.

The purpose of these procedures and those deferring consideration of certain issues, until all other issues are resolved or the application is otherwise ready for consideration by the Board of Patent Appeals and Interferences (note MPEP § 1448), is to reduce the time between filing of the reissue application and final action thereon, while still giving all parties sufficient time to be heard.

Requests for stays or suspension of action in reissues where litigation has been stayed may be answered with form paragraph 14.07.

¶ *14.07 Action in Reissue Not Stayed or Suspended — Related Litigation Stayed*

While there is a stay of the concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed or suspended because a stay of that litigation is in effect for the purpose of awaiting the outcome of these reissue proceedings. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

1442.04 Litigation Involving Patent [R-3]

37 CFR 1.178. Original patent; continuing duty of applicant.

*****

(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigations and the results of such proceedings (see also § 1.173(a)(1)).

Where the patent for which reissue is being sought is, or has been, involved in litigation, the applicant should bring the existence of such litigation to the attention of the Office. 37 CFR 1.178(b). This should be done at the time of, or shortly after, the applicant files the application, either in the reissue oath or declaration, or in a separate paper, preferably accompanying the application as filed. Litigation begun after filing of the reissue application also should be promptly brought to the attention of the Office.

Litigation encompasses any papers filed in the court or issued by the court. This may include, for example, motions, pleadings, and court decisions, as well as the results of such proceedings. When applicant notifies the Office of the existence of the litigation, enough information should be submitted so that the Office can reasonably evaluate the need for asking for further materials in the litigation. Note that the existence of supporting materials which may substantiate allegations of invalidity should, at least, be fully described, and preferably submitted. The Office is not interested in receiving voluminous litigation materials which are not relevant to the Office's consideration of the reissue application. The status of the litigation should be updated in the reissue application as soon as significant events happen in the litigation.

When a reissue application is filed, the examiner should determine whether the original patent has been adjudicated by a court. The decision(s) of the court, and also other papers in the suit, may provide information essential to the examination of the reissue. Examiners should inform the applicant of the duty to supply information as to litigation involving the patent. Form paragraph 14.11.01 may be used for this purpose. See MPEP § 1418.

Additionally, the patented file will contain notices of the filing and termination of infringement suits on the patent. Such notices are required by law to be filed by the clerks of the Federal District Courts. These notices do not indicate if there was an opinion by the court, nor whether a decision was published. *Shepard's Federal Citations* and the cumulative digests of the *United States Patents Quarterly*, both of which are in the Lutrelle F. Parker, Sr., Memorial Law Library, contain tables of patent numbers giving the citation of published decisions concerning the patent.

A litigation computer search by the Scientific and Technical Information Center (STIC) should be requested by the examiner to determine whether the patent has been, or is, involved in litigation. *>For reissue application files that are maintained in paper, the< "Search Notes" box on the application file wrapper *>is< then * completed to indicate that the review was conducted. A copy of the STIC search should be hole-punched and placed in the reissue file. **>For IFW reissue application files, the "Search Notes" box on the OACS "Search Notes" page is annotated to indicate that the review was conducted, and the OACS "Search Notes" page is then scanned into the reissue application file history.<

Additional information or guidance as to making a litigation search may be obtained from the library of the Office of the Solicitor. Where papers are not otherwise conveniently obtainable, the applicant may be requested to supply copies of papers and records in suits, or the Office of the Solicitor may be requested to obtain them from the court. The information thus obtained should be carefully considered for its bearing on the proposed claims of the reissue, particularly when the reissue application was filed in view of the holding of a court.

If the examiner becomes aware of litigation involving the patent sought to be reissued during examination of the reissue application, and applicant has not made the details regarding that litigation of record in the reissue application, the examiner, in the next Office action, should inquire regarding the same. Form paragraph 14.06 may be used for such an inquiry. See MPEP § 1442.01.

If the additional details of the litigation appear to be material to patentability of the reissue application, the examiner may make such additional inquiries as necessary and appropriate.

1442.05 Court Ordered Filing of Reissue Application [R-3]

In most instances, the reissue-examination procedure is instituted by a patent owner who voluntarily files a reissue application as a consequence of related patent litigation. Some >Federal< district courts in earlier decisions have required a patentee-litigant to file a reissue application as a consequence of the patent litigation. However, the Court of Appeals for the Federal Circuit held in *Green v. The Rich Iron Co.*, 944 F.2d 852, 853, 20 USPQ2d 1075, 1076 (Fed. Cir. 1991) that a >Federal< district court in an infringement case could not compel a patentee to seek reissue by the USPTO.

It is to be noted that only a patentee or his or her assignee may file a reissue patent application. An order by a court for a different party to file a reissue will not be binding on the Office.

1443 Initial Examiner Review [R-3]

As part of an examiner's preparation for the examination of a reissue application, the Examiner Reissue Guide and Checklist should be consulted for basic guidance and suggestions for handling the prosecution. The Technology Center (TC) Special Program Examiners (SPREs) should make the Guide and Checklist available at the time a reissue application is docketed to an examiner.

On initial receipt of a reissue application, the examiner should inspect the submission under 37 CFR 1.172 as to documentary evidence of a chain of title from the original owner to the assignee to determine whether the consent requirement of 37 CFR 1.172 has been met. The examiner will compare the consent and documentary evidence of ownership; the assignee indicated by the documentary evidence must be the same assignee which signed the consent. Also, the person who signs the consent for the assignee and the person who signs the submission of evidence of ownership for the assignee must both be persons having authority to do so. See also MPEP § 324.

Where the application is assigned, and there is no submission under 37 CFR 1.172 as to documentary evidence in the application, the examiner should require the submission using form paragraph 14.16. Once the submission under 37 CFR 1.172 as to documentary evidence is received, it must be compared with the consent to determine whether the assignee indicated by the documentary evidence is the same assignee which signed the consent. See MPEP § 1410.01 for further discussion as to the required consent and documentary evidence.

Where there is a statement of record that the application is **not** assigned, there should be no submission under 37 CFR 1.172 as to documentary evidence of ownership in the application, and none should be required by the examiner.

The filing of all reissue applications, except for continued prosecution applications (CPAs) filed under 37 CFR 1.53(d), must be announced in the *Official Gazette*. Accordingly, for any reissue application other than a CPA, the examiner should determine if the filing of the reissue application has been announced in the *Official Gazette* as provided in 37 CFR 1.11(b)**>. The contents entry on the PALM Intranet Contents screen should be checked for the presence of "NRE" and "NOTICE OF REISSUE PUBLISHED IN *OFFICIAL GAZETTE*" entries in the contents, and the date of publication. Where the reissue application is maintained in a paper file, the< date of the *Official Gazette* notice can usually be found on the pink "REISSUE" tag which protrudes from the top of the application file of 08/ or earlier series. ** For 09/ and later series reissue applications, the *Official Gazette* publication date appears on the face of the file wrapper. ** If the filing of the reissue application has not been announced in the *Official Gazette*, the reissue application should be returned to the Office of Initial Patent Examination (Special Processing) to handle the announcement. The examiner should not further act on the reissue until 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. See MPEP § 1440.

The examiner should determine if there is concurrent litigation, and if so, the status thereof (MPEP § 1442.01), and whether the reissue file **>wrapper (for reissue application files maintained in paper) or file history (for IFW reissue applications)< has been appropriately marked. Note MPEP § 1404. **

The examiner should determine if a protest has been filed, and if so, it should be handled as set forth in MPEP § 1901.06. For a discussion of protests under 37 CFR 1.291* in reissue applications, see MPEP § 1441.01.

The examiner should determine whether the patent is involved in an interference, and if so, should refer to MPEP § 1449.01 before taking any action on the reissue application.

**

The examiner should verify that all Certificate of Correction changes have been properly incorporated into the reissue application. See MPEP § 1411.01.

The examiner should verify that the patent on which the reissue application is based has not expired, either because its term has run or because required maintenance fees have not been paid. Once a patent has expired, the Director of the USPTO no longer has the authority under 35 U.S.C. 251 to reissue the patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1992). See also MPEP § 1415.01.

1444 Review of Reissue Oath/Declaration [R-5]

In accordance with 37 CFR 1.175, the following is required in the reissue oath/declaration:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid-

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

(B) A statement of at least one error which is relied upon to support the reissue application, i.e., which provides a basis for the reissue;

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.

MPEP § 1414 contains a discussion of each of the above elements (i.e., requirements of a reissue oath/declaration). The examiner should carefully review the reissue oath/declaration in conjunction with that discussion, in order to ensure that each element is provided in the oath/declaration. If the examiner's review of the oath/declaration reveals a lack of compliance with any of the requirements of 37 CFR 1.175, a rejection of all the claims under 35 U.S.C. 251 should be made on the basis that the reissue oath/declaration is insufficient.

In preparing an Office action, the examiner should use form paragraphs 14.01 through 14.01.04 to state the objection(s) to the oath/declaration, i.e., the defects in the oath/declaration. These form paragraphs are reproduced in MPEP § 1414. The examiner should then use form paragraph 14.14 to reject the claims under 35 U.S.C. 251, based upon the improper oath/declaration.

¶ *14.14 Rejection, Defective Reissue Oath or Declaration*

Claim [1] rejected as being based upon a defective reissue [2] under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the [3] is set forth in the discussion above in this Office action.

Examiner Note:

1. In bracket 1, list all claims in the reissue application. See MPEP § 706.03(x).
2. This paragraph should be preceded by at least one of the paragraphs 14.01 to 14.01.04.
3. In brackets 2 and 3, insert either --oath-- or --declaration--.

A lack of signature on a reissue oath/declaration (except as otherwise provided in 37 CFR 1.42, 1.43, and 1.47 and in 37 CFR 1.172) would be considered a lack of compliance with 37 CFR 1.175(a) and result in a rejection, including final rejection, of all the claims on the basis that the reissue oath/declaration is insufficient. If the unsigned reissue oath/declaration is submitted as part of a reply which is otherwise properly signed and responsive to the outstanding Office action, the reply should be accepted by the examiner as proper and responsive, and the oath/declaration considered fully in the next Office action. The reply should not be treated as an unsigned or improperly signed amendment (see MPEP § 714.01(a)), nor do the holdings of *Ex parte Quayle* apply in this situation. The lack of signature, along with any other oath/declaration deficiencies, should be noted in the next Office action *rejecting* the claims as being based upon an insufficient reissue oath/declaration.

I. HANDLING OF THE REISSUE OATH/DECLARATION DURING THE REISSUE PROCEEDING

An initial reissue oath/declaration is submitted with the reissue application (or within the time period set for filing the oath/declaration in a Notice To File Missing Parts under 37 CFR 1.53(f)). Where the reissue oath/declaration fails to comply with 37 CFR 1.175(a), the examiner will so notify the applicant in an Office action, rejecting the claims under 35 U.S.C. 251 as discussed above. In reply to the Office action, a supplemental reissue oath/declaration should be submitted dealing with the noted defects in the reissue oath/declaration.

Where the initial reissue oath/declaration (1) failed to provide *any* error statement, or (2) attempted to provide an error statement, but failed to identify any error under 35 U.S.C. 251 upon which reissue can be based (see MPEP § 1402), the examiner should reject all the claims as being based upon a defective reissue oath/declaration under 35 U.S.C. 251. To support the rejection, the examiner should specifically point out the failure of the initial oath/declaration to comply with 37 CFR 1.175 because an "error" under 35 U.S.C. 251 upon which reissue can be based was not identified therein. In reply to the rejection under 35 U.S.C. 251, a supplemental reissue oath/declaration must be submitted stating an error under 35 U.S.C. 251 which can be relied upon to support the reissue application. Submission of this supplemental reissue oath/declaration to obviate the rejection cannot be deferred by applicant until the application is otherwise in condition for allowance. In this instance, a proper statement of error *was never provided in the initial reissue oath/declaration,* thus a supplemental oath/declaration is required *in reply to the Office action* in order to properly establish grounds for reissue.

A different situation may arise where the initial reissue oath/declaration does properly identify one or more errors under 35 U.S.C. 251 as being the basis for reissue, however, because of changes or amendments made during prosecution, none of the identified errors are relied upon any more. A supplemental oath/declaration will be needed to identify at least one error *now* being relied upon as the basis for reissue, even though the prior oath/declaration was earlier found proper by the examiner. The supplemental oath/declaration need *not* also indicate that the error(s) identified in the prior oath(s)/declaration(s) is/are no longer being corrected. In this instance, applicant's submission of the supplemental reissue oath/declaration to obviate the rejection under 35 U.S.C. 251 can, at applicant's option, be deferred until the application is otherwise in condition for allowance. The submission can be deferred because a proper statement of error was provided in the initial reissue oath/declaration. Applicant need only request that submission of the supplemental reissue oath/declaration be deferred until allowance, and such a request will be considered a complete reply to the rejection.

II. SUPPLEMENTAL REISSUE OATH/DECLARATION UNDER 37 CFR 1.175(b)(1):

Once the reissue oath/declaration is found to comply with 37 CFR 1.175(a), it is not required, nor is it suggested, that a new reissue oath/declaration be submitted together with each new amendment and correction of error in the patent. During the prosecution of a reissue application, amendments are often made and additional errors in the patent are corrected. A supplemental oath/declaration need not be submitted with each amendment and additional correction. Rather, it is suggested that the reissue applicant wait until the case is in condition for allowance, and then submit a cumulative supplemental reissue oath/declaration pursuant to 37 CFR 1.175(b)(1).

See MPEP § 1414.01 for a discussion of the required content of a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1).

A supplemental oath/declaration under 37 CFR 1.175(b)(1) must be submitted before allowance. It may be submitted with any reply prior to allowance. It may be submitted to overcome a rejection under 35 U.S.C. 251 made by the examiner, where it is indicated that the submission of the supplemental oath/declaration will overcome the rejection.

A supplemental oath/declaration under 37 CFR 1.175(b)(1) will be required where:

(A) the application is otherwise (other than the need for this supplemental oath/declaration) in condition for allowance;

(B) amendments or other corrections of errors in the patent have been made subsequent to the last oath/declaration filed in the application; and

(C) at least one of the amendments or other corrections corrects an error under 35 U.S.C. 251.

When a supplemental oath/declaration under 37 CFR 1.175(b)(1) directed to the amendments or other corrections of error is required, the examiner is encouraged to telephone the applicant and request the submission of the supplemental oath/declaration by fax. If the circumstances do not permit making a telephone call, or if applicant declines or is unable to promptly submit the oath/declaration, the examiner should issue a final Office action (final rejection) and use form paragraph 14.05.02 where the action issued is a second or subsequent action on the merits.
**>

¶ *14.05.02 Supplemental Oath or Declaration Required Prior to Allowance*

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claim [1] rejected as being based upon a defective reissue [2] under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

> "Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

See MPEP § 1414.01.

Examiner Note:

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, insert either --oath-- or --declaration--.
3. This form paragraph is used in an Office action to: (a) remind applicant of the requirement for submission of the supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) before allowance and (b) at the same time, reject all the claims since the reissue application is defective until the supplemental oath/declaration is submitted.
4. Do not use this form paragraph if no amendments (or other corrections of the patent) have been made subsequent to the last oath/declaration filed in the case; instead allow the case.

5. This form paragraph cannot be used in an *Ex parte Quayle* action to require the supplemental oath/declaration, because the rejection under 35 U.S.C. 251 is more than a matter of form.

6. Do not use this form paragraph in an examiner's amendment. The supplemental oath/declaration must be filed prior to mailing of the Notice of Allowability.

<

As noted above, the examiner will issue a final Office action where the application is otherwise in condition for allowance, and amendments or other corrections of error in the patent have been made subsequent to the last oath/declaration filed in the application. The examiner will be introducing (via form paragraph 14.05.02) a rejection into the case for the first time in the prosecution, when the claims have been determined to be otherwise allowable. This introduction of a new ground of rejection under 35 U.S.C. 251 will not prevent the action from being made final on a second or subsequent action because of the following factors:

(A) The finding of the case in condition for allowance is the first opportunity that the examiner has to make the rejection;

(B) The rejection is being made in reply to, i.e., was caused by, an amendment of the application (to correct errors in the patent);

(C) All applicants are on notice that this rejection will be made upon finding of the case otherwise in condition for allowance where errors have been corrected subsequent to the last oath/declaration filed in the case, so that the rejection should have been expected by applicant; and

(D) The rejection will not prevent applicant from exercising any rights to cure the rejection, since applicant need only submit a supplemental oath/declaration with the above-described language, and it will be entered to cure the rejection.

Where the application is in condition for allowance and **no amendments or other corrections of error in the patent have been made subsequent to the last oath/declaration** filed in the application, a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) **should not be required by the examiner.** Instead, the examiner should issue a Notice of Allowability indicating allowance of the claims.

III. AFTER ALLOWANCE

Where applicant seeks to correct an error after allowance of the application, any amendment of the patent correcting the error must be submitted in accordance with 37 CFR 1.312. As set forth in 37 CFR 1.312, no amendment may be made as a matter of right in an application after the mailing of the notice of allowance. An amendment filed under 37 CFR 1.312 must be filed before or with the payment of the issue fee and may be entered on the recommendation of the primary examiner, and approved by the supervisory patent examiner, without withdrawing the case from issue.

Because the amendment seeks to correct an error in the patent, the amendment will affect the disclosure, the scope of a claim, or add a claim. Thus, in accordance with MPEP § 714.16, the remarks accompanying the amendment must fully and clearly state:

(A) why the amendment is needed;

(B) why the proposed amended or new claims require no additional search or examination;

(C) why the claims are patentable; and

(D) why they were not presented earlier.

A supplemental reissue oath/declaration must accompany the amendment. The supplemental reissue oath/declaration must state that the error(s) to be corrected arose without any deceptive intention on the part of the applicant. The supplemental reissue oath/declaration submitted after allowance must be directed to the error(s) applicant seeks to correct after allowance. This oath/declaration need not cover any earlier errors, since all earlier errors should have been covered by a reissue oath/declaration submitted prior to allowance.

Occasionally correcting an error after allowance does not include an amendment of the specification or claims of the patent. For example, the correction of the error could be the filing of a certified copy of the original foreign application (prior to the payment of the issue fee - see 37 CFR 1.55(a)(2)) to obtain the right of foreign priority under 35 U.S.C. 119 (see *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968)) where the claim for foreign priority had been timely made in the application for the original patent. In such a case, the requirements of 37 CFR 1.312 must still be met. This is so, because the correction of the patent is an amendment of the patent, even though no amendment is physically entered into the case. Thus, for a reissue oath/declaration submitted after allowance to correct an additional error (or errors), the reissue applicant must comply with 37 CFR 1.312 in the manner discussed above.

1445 Reissue Application Examined in Same Manner as Original Application

As stated in 37 CFR 1.176, a reissue application, including all the claims therein, is subject to "be examined in the same manner as a non-reissue, non-provisional application." Accordingly, the claims in a reissue application are subject to any and all rejections which the examiner deems appropriate. It does not matter whether the claims are identical to those of the patent or changed from those in the patent. It also does not matter that a rejection was not made in the prosecution of the patent, or could have been made, or was in fact made and dropped during prosecution of the patent; the prior action in the prosecution of the patent does not prevent that rejection from being made in the reissue application. Claims in a reissue application enjoy no "presumption of validity." *In re Doyle*, 482 F.2d 1385, 1392, 179 USPQ 227, 232-233 (CCPA 1973); *In re Sneed*, 710 F.2d 1544, 1550 n.4, 218 USPQ 385, 389 n.4 (Fed. Cir. 1983). Likewise, the fact that during prosecution of the patent the examiner considered, may have considered, or should have considered information such as, for example, a specific prior art document, does not have any bearing on, or prevent, its use as prior art during prosecution of the reissue application.

1448 Fraud, Inequitable Conduct, or Duty of Disclosure Issues [R-2]

The Office no longer investigates and rejects reissue applications under 37 CFR 1.56. The Office will not comment upon duty of disclosure issues which are brought to the attention of the Office in reissue applications except to note in the application, in appropriate circumstances, that such issues are no longer considered by the Office during its examination of patent applications. Examination as to the lack of deceptive intent requirement in reissue applications will continue but without any investigation of fraud, inequitable conduct, or duty of disclosure issues. Applicant's statement in the reissue oath or declaration of lack of deceptive intent will be accepted as dispositive except in special circumstances such as an admission or judicial determination of fraud, inequitable conduct, or violation of the duty of disclosure.

ADMISSION OR JUDICIAL DETERMINATION

An admission or judicial determination of fraud, inequitable conduct, or violation of the duty of disclosure is a special circumstance, because no investigation need be made. Accordingly, after consulting with the Technology Center (TC) Special Program Examiner (SPRE), a rejection should be made using the appropriate one of form paragraphs 14.21.09 or 14.22 as reproduced below.

Any admission of fraud, inequitable conduct or violation of the duty of disclosure must be explicit, unequivocal, and not subject to other interpretation. Where a rejection is made based upon such an admission (see form paragraph 14.22 below) and applicant responds with any reasonable interpretation of the facts that would not lead to a conclusion of fraud, inequitable conduct or violation of the duty of disclosure, the rejection should be withdrawn. Alternatively, if applicant argues that the admission noted by the examiner was not in fact an admission, the rejection should also be withdrawn.

Form paragraph 14.21.09 should be used where the examiner becomes aware of a judicial determination of fraud, inequitable conduct or violation of the duty of disclosure on the part of the applicant **independently of the record of the case**, i.e., the examiner has external knowledge of the judicial determination.

Form paragraph 14.22 should be used where, **in the application record**, there is (a) an explicit, unequivocal admission by applicant of fraud, inequitable conduct or violation of the duty of disclosure which is not subject to other interpretation, or (b) information as to a judicial determination of fraud, inequitable conduct or violation of the duty of disclosure on the part of the applicant. External information which the examiner believes to be an *admission* by applicant should never be used by the examiner, and such external information should never be made of record in the reissue application.

¶ *14.21.09 Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention - External Knowledge*

Claims [1] rejected under 35 U.S.C. 251 since error "without any deceptive intention" has not been established. In view of the judicial determination in [2] of [3] on the part of applicant, a conclusion that any error was "without deceptive intention" cannot be supported. [4]

Examiner Note:

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, list the Court or administrative body which made the determination of fraud or inequitable conduct on the part of applicant.
3. In bracket 3, insert --fraud--, --inequitable conduct-- and/or --violation of duty of disclosure--.
4. In bracket 4, point out where in the opinion (or holding) of the Court or administrative body the determination of fraud, inequitable conduct or violation of duty of disclosure is set forth. Page number, column number, and paragraph information should be given as to the opinion (or holding) of the Court or administrative body. The examiner may add explanatory comments.

**>

¶ *14.22 Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention-Evidence in the Application*

Claims [1] rejected under 35 U.S.C. 251 since error "without any deceptive intention" has not been established. In view of the reply filed on [2], a conclusion that any error was "without deceptive intention" cannot be supported.

[3]

Examiner Note:

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, insert the filing date of the reply which provides an admission of fraud, inequitable conduct or violation of duty of disclosure, or that there was a judicial determination of same.
3. In bracket 3, insert a statement that there has been an admission or a judicial determination of fraud, inequitable conduct or violation of duty of disclosure which provide circumstances why applicant's statement in the oath or declaration of lack of deceptive intent should not be taken as dispositive. Any admission of fraud, inequitable conduct or violation of duty of disclosure must be explicit, unequivocal, and not subject to other interpretation.

<

See MPEP § 2012 for additional discussion as to fraud, inequitable conduct or violation of duty of disclosure in a reissue application.

1449 Protest Filed in Reissue Where Patent Is in Interference [R-3]

If a protest (see MPEP Chapter 1900) is filed in a reissue application related to a patent involved in a pending interference proceeding, the reissue application should be referred to the Office of Patent Legal Administration (OPLA) before considering the protest and acting on the reissue application.

The OPLA will check to see that:

(A) all parties to the interference are aware of the filing of the reissue; and

(B) the Office does not allow claims in the reissue which are unpatentable over the pending interference count(s), or found unpatentable in the interference proceeding. After the reissue application has been reviewed by the OPLA, the reissue application with the protest will be returned to the examiner. See MPEP § 1441.01 for a discussion as to protests under 37 CFR 1.291* in reissue applications.

1449.01 Concurrent Office Proceedings [R-5]

I. CONCURRENT REEXAMINATION PROCEEDINGS:

37 CFR 1.565(d) provides that if "a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to 37 CFR 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings." 37 CFR 1.991 provides that if "a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to 37 CFR 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings". If an examiner becomes aware that a reissue application and an *ex parte* or *inter partes* reexamination proceeding are both pending for the same patent, he or she should >immediately< inform the Technology Center (TC) >or Central Reexamination Unit (CRU)< Special Program Examiner (SPRE)*.

Pursuant to 37 CFR 1.177, a patent owner may file more than one reissue application for the same patent. If an examiner becomes aware that multiple reissue applications are pending for the same patent, and an *ex parte* or *inter partes* reexamination proceeding is pending for the same patent, he or she should >immediately< inform the TC SPRE*.

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, *and an order granting reexamination has been issued* for the reexamination proceeding, the Office of Patent

Legal Administration (OPLA) must be notified that the proceedings are ready for a decision as to whether to merge the reissue and the reexamination, or stay one of the two. See MPEP § 2285 for the procedure of notifying OPLA and general guidance, if a reissue application and an *ex parte* reexamination proceeding are both pending for the same patent, and an *inter partes* reexamination proceeding is not involved. See MPEP § 2686.03 where a reissue application and an *inter partes* reexamination proceeding are both pending for the same patent, regardless of whether an *ex parte* reexamination proceeding is also pending.

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, the patent owner, i.e., the reissue applicant, has a responsibility to notify the Office of the concurrent proceeding. 37 CFR § 1.178(b), 37 CFR 1.565(a), and 37 CFR 1.985(a). The patent owner should file in the reissue application, as early as possible, a Notification of Concurrent Proceedings pursuant to 37 CFR 1.178(b) in order to alert the Office of the existence of the reexamination proceeding on the same patent. See MPEP § 1418. In addition, the patent owner should file in the reexamination proceeding, as early as possible, a Notification of Concurrent Proceedings pursuant to 37 CFR 1.565(a) or 1.985(a) (depending on whether the reexamination proceeding is an *ex parte* reexamination proceeding or an *inter partes* reexamination proceeding) to provide a notification to the Office in the reexamination proceeding of the existence of the two concurrent proceedings.

The patent owner may file a petition under 37 CFR 1.182 in a reissue application to merge the reissue application with the reexamination proceeding, or to stay one of the proceedings because of the other. This petition must be filed after the issuance of the order to reexamine (37 CFR 1.525, 37 CFR 1.931) in the reexamination proceeding. If the petition is filed prior to the reexamination order, it will not be considered, and will be returned to the patent owner by the TC >or CRU< Director. If the petition is filed after the issuance of the order to reexamine, the petition and the files for the reissue application and the reexamination proceeding will be forwarded to OPLA for decision.

II. CONCURRENT INTERFERENCE PROCEEDINGS

If the original patent is involved in an interference, the examiner must consult the administrative patent judge in charge of the interference before taking any action on the reissue application. It is particularly important that the reissue application not be granted without the administrative patent judge's approval. See MPEP Chapter 2300.

III. CONCURRENT REISSUE PROCEEDINGS

Where more than one reissue applications are pending concurrently on the same patent, see MPEP §§ 1450 and 1451.

1449.02 Interference in Reissue [R-5]

37 CFR 41.8. Mandatory notices.

(a) In an appeal brief (§§ 41.37, 41.67, or 41.68) or at the initiation of a contested case (§ 41.101), and within 20 days of any change during the proceeding, a party must identify:

(1) Its real party-in-interest, and

(2) Each judicial or administrative proceeding that could affect, or be affected by, the Board proceeding.

(b) For contested cases, a party seeking judicial review of a Board proceeding must file a notice with the Board of the judicial review within 20 days of the filing of the complaint or the notice of appeal. The notice to the Board must include a copy of the complaint or notice of appeal. See also §§ 1.301 to 1.304 of this title.

37 CFR 41.202. Suggesting an interference.

(a) *Applicant.* An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

(1) Provide sufficient information to identify the application or patent with which the applicant seeks an interference,

(2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to one or more counts,

(3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of § 41.203(a),

(4) Explain in detail why the applicant will prevail on priority,

(5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification, and

(6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter.

*****

(c) *Examiner*. An examiner may require an applicant to add a claim to provoke an interference. Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim. If the interference would be with a patent, the applicant must also comply with paragraphs (a)(2) through (a)(6) of this section. The claim the examiner proposes to have added must, apart from the question of priority under 35 U.S.C. 102 (g):

(1) Be patentable to the applicant, and

(2) Be drawn to patentable subject matter claimed by another applicant or patentee.

*****

In appropriate circumstances, a reissue application may be placed into interference with a patent or pending application. A patentee may provoke an interference with a patent or pending application by filing a reissue application, if the reissue application includes an appropriate reissue error as required by 35 U.S.C. 251. Reissue error must be based upon applicant error; a reissue cannot be based solely on the error of the Office for failing to declare an interference or to suggest copying claims for the purpose of establishing an interference. See *In re Keil*, 808 F.2d 830, 1 USPQ2d 1427 (Fed. Cir. 1987); *In re Dien*, 680 F.2d 151, 214 USPQ 10 (CCPA 1982); *In re Bostwick*, 102 F.2d 886, 888, 41 USPQ 279, 281 (CCPA 1939); and *In re Guastavino*, 83 F.2d 913, 916, 29 USPQ 532, 535 (CCPA 1936). See also *Slip Track Systems, Inc. v. Metal Lite, Inc.*, 159 F.3d 1337, 48 USPQ2d 1055 (Fed. Cir. 1998) (Two patents issued claiming the same patentable subject matter, and the patentee with the earlier filing date requested reexamination of the patent with the later filing date (Slip Track's patent). A stay of litigation in a priority of invention suit under 35 U.S.C. 291, pending the outcome of the reexamination, was reversed. The suit under 35 U.S.C. 291 was the only option available to Slip Track to determine priority of invention. Slip Track could not file a reissue application solely to provoke an interference proceeding before the Office because it did not assert that there was any error as required by 35 U.S.C. 251 in the patent.). A reissue application can be employed to provoke an interference if the reissue application:

(A) adds copied claims which are not present in the original patent;

(B) amends claims to correspond to those of the patent or application with which an interference is sought; or

(C) contains at least one error (not directed to provoking an interference) appropriate for the reissue.

In the first two situations, the reissue oath/declaration must assert that applicant erred in failing to include claims of the proper scope to provoke an interference in the original patent application. Note that in *In re Metz*, 173 F.3d 433 (Fed. Cir. 1998) (table), the Federal Circuit permitted a patentee to file a reissue application to copy claims from a patent in order to provoke an interference with that patent. Furthermore, the subject matter of the copied or amended claims in the reissue application must be supported by the disclosure of the original patent under 35 U.S.C. 112, first paragraph. See *In re Molins*, 368 F.2d 258, 261, 151 USPQ 570, 572 (CCPA 1966) and *In re Spencer*, 273 F.2d 181, 124 USPQ 175 (CCPA 1959).

A reissue applicant cannot present added or amended claims to provoke an interference, if the claims were deliberately omitted from the patent. If there is evidence that the claims were not inadvertently omitted from the original patent, e.g., the subject matter was described in the original patent as being undesirable, the reissue application may lack proper basis for the reissue. See *In re Bostwick*, 102 F.2d at 889, 41 USPQ at 282 (CCPA 1939)(reissue lacked a proper basis because the original patent pointed out the disadvantages of the embodiment that provided support for the copied claims).

The issue date of the patent, or the publication date of the application publication (whichever is applicable under 35 U.S.C. 135(b)), with which an interference is sought must be less than 1 year prior to the presentation of the copied or amended claims in the reissue application. See 35 U.S.C. 135(b) and MPEP § 715.05 and MPEP Chapter 2300. If the reissue application includes broadened claims, the reissue application must be filed within two years from the issue date of the original patent. See 35 U.S.C. 251 and MPEP § 1412.03.

An examiner may, pursuant to 37 CFR 41.202(c), require a reissue applicant to add a claim to provoke an interference, unless the reissue applicant cannot present the added claim to provoke an interference based upon the provisions of the reissue statute and rules, e.g., if the claim was deliberately omitted from the patent, or if the claim enlarges the scope of the claims of the original patent and was not "applied for within two years from the grant of the original patent." Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim. If the interference would be with a patent, the reissue applicant must also comply with 37 CFR 41.202(a)(2) through (a)(6). The claim the examiner proposes to have added must, apart from the question of priority under 35 U.S.C. 102(g), be patentable to the reissue applicant, and be drawn to patentable subject matter claimed by another applicant or patentee.

REISSUE APPLICATION FILED WHILE * PATENT IS IN INTERFERENCE

If a reissue application is filed while the original patent is in an interference proceeding, the reissue applicant must promptly notify the Board of Patent Appeals and Interferences of the filing of the reissue application within 20 days from the filing date. See 37 CFR 41.8 and MPEP Chapter 2300.

1450 Restriction and Election of Species >Made in Reissue Application< [R-2]

37 CFR 1.176. Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

37 CFR 1.176(b) permits the examiner to require restriction in a reissue application between claims newly added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent claims. The criteria for making a restriction requirement in a reissue application between the newly added claims and the original claims are the same as that applied in a non-reissue application. See MPEP §§ 806 through 806.05(i). The authority to make a "restriction" requirement under 37 CFR 1.176(b) extends to and includes the authority to make an election of species.

Where a restriction requirement is made by the examiner, the original patent claims will be held to be constructively elected (except for the limited situation where a disclaimer is filed as discussed in the next paragraph). Thus, the examiner will issue an Office action >in the reissue application< (1) providing notification of the restriction requirement, (2) holding the added claims to be constructively non-elected and withdrawn from consideration, * (3) treating the original patent claims on the merits>, and (4) informing applicant that if the original claims are found allowable, and a divisional application has been filed for the non-elected claims, further action in the application will be suspended, pending resolution of the divisional application.<.

If a disclaimer of all the original patent claims is filed in the reissue application containing newly added claims that are separate and distinct from the original patent claims, only the newly added claims will be present for examination. In this situation, the examiner's Office action will treat the newly added claims in the reissue application on the merits. The disclaimer of all the original patent claims must be filed in the reissue application prior to the issuance of the examiner's Office action containing the restriction requirement, in order for the newly added claims to be treated on the merits. Once the examiner has issued the Office action providing notification of the restriction requirement and treating the patent claims on the merits, it is too late to obtain an examination on the added claims in the reissue application by filing a disclaimer of all the original patent claims. If reissue applicant wishes to have the newly added claims be treated on the merits, a divisional reissue application must be filed to obtain examination of the added claims. Reissue applicants should carefully note that once a disclaimer of the patent claims is filed, it cannot be withdrawn. It does not matter whether the reissue application is still pending, or whether the reissue application has been abandoned or issued as a reissue patent. For all these situations, 37 CFR 1.176(b) states that the disclaimer cannot be withdrawn; the disclaimer will be given effect.

Claims elected pursuant to a restriction requirement will receive a complete examination on the merits, while the non-elected claims (to any added invention(s)) will be held in abeyance in a withdrawn status, and will only be examined if filed in a divisional reissue application. If the reissue application containing only original unamended claims becomes allowable first (and no "error" under 35 U.S.C. 251 exists), further action in that reissue application will be suspended to await examination in the divisional reissue application(s) containing the added claims. >Multiple suspensions (usually six-month periods) may be necessary.< The Office will not * >permit< claims >to issue< in a reissue application which >application< does not correct any error in the original patent. Once a divisional reissue application containing the added claims is examined and becomes allowable, ** >the examiner will issue a requirement under 37 CFR 1.177(c) for applicant to merge the claims of the suspended first reissue application with the allowable claims of the divisional reissue application into a single application, by placing all of the claims in one of the applications and expressly abandoning the other. The Office action making this requirement will set a two-month period for compliance with the requirement. If applicant fails to timely respond to the Office action, or otherwise refuses to comply with the requirement made, then the divisional reissue application (claiming the invention which was non-elected in the now-suspended first reissue application) will be passed to issue alone, since the claims of the divisional reissue application, by themselves, do correct an error in the original patent. Prosecution will be reopened in the suspended first reissue application, and a rejection based on a lack of error under 35 U.S.C. 251 will then be made. This rejection may be made final, since applicant is on notice of the consequences of not complying with the merger requirement.

If the divisional reissue application becomes abandoned, prosecution will be reopened in the suspended first reissue application, and a rejection based on a lack of error under 35 U.S.C. 251 will then be made in the first reissue application. Since no error in the original patent is being corrected in the first reissue application, no reissue patent will issue.<

As stated in 37 CFR 1.176(b), **the examiner is not permitted to require restriction among original claims of the patent** (i.e., among claims that were in the patent prior to filing the reissue application). Even where the original patent contains claims to different inventions which the examiner considers independent or distinct, and the reissue application claims the same inventions, a restriction requirement would be improper. If such a restriction requirement is made, it must be withdrawn.

Restriction between multiple inventions recited **in the newly added claims** will be permitted provided the added claims are drawn to several separate and distinct inventions. In such a situation, the original patent claims would be examined in the first reissue application, and applicant is permitted to file a divisional reissue application for each of the several separate and distinct inventions identified in the examiner's restriction requirement.

A situation will sometimes arise where the examiner makes an election of species requirement between the species claimed in the original patent claims and a species of claims added in the reissue application. In such a situation, if (1) the non-elected claims to the added species depend from (or otherwise include all limitations of) a generic claim which embraces all species claims, and (2) the generic claim is found allowable, then the non-elected claims of the added species must be rejoined with the elected claims of the original patent. See MPEP § *>821.04(a)<.

**

1451 Divisional Reissue Applications; Continuation Reissue Applications Where the Parent is Pending [R-3]

35 U.S.C. 251. Reissue of defective patents.

*****

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

*****

37 CFR 1.177. Issuance of multiple reissue patents.

(a) The Office may reissue a patent as multiple reissue patents. If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. The Office may correct by certificate of correction under § 1.322 any reissue patent resulting from an application to which this paragraph applies that does not contain the required notice.

(b) If applicant files more than one application for the reissue of a single patent, each claim of the patent being reissued must be presented in each of the reissue applications as an amended, unamended, or canceled (shown in brackets) claim, with each such claim bearing the same number as in the patent being reissued. The same claim of the patent being reissued may not be presented in its original unamended form for examination in more than one of such multiple reissue applications. The numbering of any added claims in any of the multiple reissue applications must follow the number of the highest numbered original patent claim.

(c) If any one of the several reissue applications by itself fails to correct an error in the original patent as required by 35 U.S.C. 251 but is otherwise in condition for allowance, the Office may suspend action in the allowable application until all issues are resolved as to at least one of the remaining reissue applications. The Office may also merge two or more of the multiple reissue applications into a single reissue application. No reissue application containing only unamended patent claims and not correcting an error in the original patent will be passed to issue by itself.

The court in *In re Graff*, 111 F.3d 874, 876-77, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997) stated that "[t]he statute does not prohibit divisional or continuation reissue applications, and does not place stricter limitations on such applications when they are presented by reissue, provided of course that the statutory requirements specific to reissue applications are met." Following the decision in *Graff*, the Office has adopted a policy of treating continuations and divisionals of reissue applications, to the extent possible, in the same manner as continuations and divisionals of non-reissue applications.

Questions relating to the propriety of divisional reissue applications and continuation reissue applications should be referred via the Technology Center (TC) Special Program Examiner to the Office of Patent Legal Administration.

>

I. < DIVISIONAL REISSUE APPLICATIONS

37 CFR 1.176(b) permits the examiner to require restriction in a reissue application between the original claims of the patent and any newly added claims which are directed to a separate and distinct invention(s). See also MPEP § 1450. As a result of such a restriction requirement, divisional applications may be filed for each of the inventions identified in the restriction requirement.

In addition, applicant may initiate a division of the claims by filing more than one reissue application in accordance with 37 CFR 1.177. The multiple reissue applications which are filed may contain different groups of claims from among the original patent claims, or some of the reissue applications may contain newly added groups (not present in the original patent). There is no requirement that the claims of the multiple reissue applications be independent and distinct from one another; if they are not independent and distinct from one another, the examiner must apply the appropriate double patenting rejections.

There is no requirement that a family of divisional reissue applications issue at the same time; however, it is required that they contain a cross reference to each other in the specification. 37 CFR 1.177(a) requires that all multiple reissue applications resulting from a single patent must include as the first sentence of their respective specifications a cross reference to the other reissue application(s). Accordingly, the first sentence of each reissue specification must provide notice stating that more than one reissue application has been filed, and it must identify each of the reissue applications and their relationship within the family of reissue applications, and to the original patent. An example of the suggested language to be inserted is as follows:

Notice: More than one reissue application has been filed for the reissue of Patent No. 9,999,999. The reissue applications are application numbers 09/999,994 (the present application), 09/999,995, and 09/999,998, all of which are divisional reissues of Patent No. 9,999,999.

The examiner should object to the specification and require an appropriate amendment if applicant fails to include such a cross reference to the other reissue applications in the first sentence of the specification of each of the reissue applications.

Where one of the divisional applications of the family has issued without the required cross reference to the other reissue application(s), the examiner will refer the matter to his/her Supervisory Patent Examiner (SPE). The SPE will initiate a certificate of correction under 37 CFR 1.322 to include the appropriate cross reference in the already issued first reissue patent before passing the pending reissue application to issue. Form paragraph 10.19 may be used for such purpose. After the SPE prepares the memorandum as per form paragraph 10.19, the patent file with the memorandum should be forwarded to the Certificates of Correction Branch for issuance of a certificate. The examiner should make a reference in the pending divisional reissue application to the fact that an actual request for a Certificate of Correction has been initiated in the first reissue patent pursuant to 37 CFR 1.177(a), e.g., by an entry in the search notes or in an examiner's amendment.

¶ *10.19 Memorandum - Certificate of Correction (Cross-Reference to Other Reissues in Family)*

DATE: [1]

TO: Certificates of Correction Branch

FROM: [2], SPE, Art Unit [3]

SUBJECT: Request for Certificate of Correction

Please issue a Certificate of Correction in U. S. Letters Patent No. [4] as specified on the attached Certificate.

____

[5], SPE

Art Unit [6]

UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE

Patent No. [7]

Patented: [8]

The present reissue patent issued from an application that is one of a family of divisional reissue applications resulting from Patent No. [9]. The present reissue patent has issued without the cross reference to the other reissue application(s) of the family which is required pursuant to 37 CFR 1.177(a). Accordingly, insert in the first sentence of the specification as follows:

Notice: More than one reissue application has been filed for the reissue of patent [9]. The reissue applications are [10].

____

[11], Supervisory Patent Examiner

Art Unit [12]

Examiner Note:

1 In bracket 9, insert the patent number of the patent for which multiple reissue divisional applications have been filed.

2 This is an internal memo and must not be mailed to the applicant. This memo should accompany the patented file to the Certificates of Correction Branch as noted in form paragraphs 10.13 and 10.14.

3. In brackets 5 and 11, insert the name of SPE and provide the signature of the SPE above each line.

4. In brackets 6 and 12, insert the Art Unit number.

5. Two separate pages of USPTO letterhead will be printed when using this form paragraph.

6. In bracket 10, identify each of the reissue applications (including the present application) and their relationship within the family of reissue applications, and to the original patent.

In addition to the amendment to the first sentence of the specification, the reissue application cross references will also be reflected in the file**>. For an IFW reissue application file, a copy of the bibliographic data sheet from the IFW file history should be printed and the examiner should annotate the printed sheet such that adequate notice is provided that more than one reissue application has been filed for a single original patent. The annotated sheet should be scanned into IFW. For reissue application files that are maintained in paper,< the bibliographic data sheet *>should be< reprinted (for 09/ and later series), or the front face of the reissue file wrapper >should be marked< (for 08/ and earlier series), for all the multiple reissue applications, so that adequate notice is provided that more than one reissue application has been filed for a single original patent. **

Pursuant to 37 CFR 1.177(b) all of the claims of the patent to be reissued must be presented in each reissue application in some form, i.e., as amended, as unamended or as canceled. Further, ** any added claims must be numbered beginning with the next highest number following the last patent claim. >It is noted that the same claim of the patent cannot be presented for examination in more than one of the divisional reissue applications, as a pending claim, in either its original or amended versions. Once a claim in the patent has been reissued, it does not exist in the original patent; thus, it cannot be reissued from the original patent in another reissue application. If the same claim of the patent, e.g., patent claim 1 is presented for examination in more than one of the reissue applications, in different amended versions, the following rejections should be made in the reissue applications with that patent claim:

A rejection under 35 U.S.C. 251, in that the reissue application is not correcting an error in the original patent, because original claim 1 would be superseded by the reissuance of claim 1 in the other reissue application.

A rejection under 35 U.S.C. 112, in that claim 1 is indefinite because the invention of claim 1 is not particularly pointed out and distinctly claimed. Claim 1 presents one coverage in divisional reissue application X and another in the present reissue application. This is inconsistent.

The reissue applicant should then be advised to follow a procedure similar to the following example:

If there are patent claims 1 – 10 in two divisional reissue applications and an applicant wishes to revise claim 1, which is directed to AB (for example) to ABC in one divisional reissue application, and to ABD in a second divisional reissue application, applicant should do the following: Claim 1 in the first divisional reissue application can be revised to recite ABC. Claim 1 in the second divisional reissue application would be canceled, and new claim 11 would be added to recite ABD. The physical cancellation of claim 1 in the second divisional reissue application will not prejudice applicant's rights in the amended version of claim 1 since those rights are retained via the first reissue application. Claim 1 continues to exist in the first reissue application, and both the first and second reissue applications taken together make up the totality of the correction of the original patent.<

If the same or similar claims are presented in more than one of the multiple reissue applications, the possibility of statutory double patenting (35 U.S.C. 101) or non-statutory (judicially created doctrine) double patenting should be considered by the examiner during examination, and the appropriate rejections made. A terminal disclaimer may be filed to overcome an obviousness type double patenting rejection. The terminal disclaimer is necessary in order to ensure common ownership of the reissue patents throughout the remainder of the unexpired term of the original patent. Whenever a divisional reissue application is filed with a copy of the oath/declaration and assignee consent from the parent reissue application, the copy of the assignee consent from the parent reissue application should not be accepted. *The copy of the consent from the parent reissue application does not indicate that the assignee has consented to the addition of the new invention of the divisional reissue application to the original patent.* The Office of Initial Patent Examination (OIPE) should accord a filing date and send out a notice of missing parts stating that there is no proper consent and setting a period of time for filing the missing part and for payment of any surcharge required under 37 CFR 1.53(f) and 1.16(*>f<). See MPEP § 1410.01. The copy of the reissue oath/declaration should be accepted by OIPE, since it is an oath/declaration, even though it may be improper under 35 U.S.C. 251. The examiner should check the copy of the oath/declaration to ensure that it identifies an error being corrected by the divisional reissue application. The copy of the oath/declaration from the parent reissue application may or may not cover the error being corrected by the divisional reissue application since the divisional reissue application is (by definition) directed to a new invention. If it does not, the examiner should reject the claims of the divisional reissue application under 35 U.S.C. 251 as being based on an oath/declaration that does not identify an error being corrected by the divisional reissue application, and require a new oath/declaration. See MPEP § 1414. If the copy of the reissue oath/declaration from the parent reissue application does in fact cover an error being corrected in the divisional reissue application, no such rejection should be made. However, since a new invention is being added by the filing of the divisional reissue application, a supplemental reissue oath/declaration pursuant to 37 CFR 1.175 (b)(1) will be required. See MPEP § 1414.01.

Situations yielding divisional reissues occur infrequently and usually involve only two such files. It should be noted, however, that in rare instances in the past, there have been more than two (and as many as five) divisional reissues of a patent. For treatment of a plurality of divisional reissue applications resulting from a requirement to restrict to distinct inventions or a requirement to elect species, see MPEP § 1450.
>

II. < CONTINUATION REISSUE APPLICATIONS

A continuation of a reissue is not ordinarily filed "for distinct and separate parts of the thing patented" as called for in the second paragraph of 35 U.S.C. 251. The decision of *In re Graff*, 111 F.3d 874, 42 USPQ2d 1471 (Fed. Cir. 1997) interprets 35 U.S.C. 251 to permit multiple reissue patents to issue even where the multiple reissue patents are not for "distinct and separate parts of the thing patented." The court stated:

> Section 251[2] is plainly intended as enabling, not as limiting. Section 251[2] has the effect of assuring that a different burden is not placed on divisional or continuation reissue applications, compared with divisions and continuations of original applications, by codifying the Supreme Court decision which recognized that more than one patent can result from a reissue proceeding. Thus § 251[2] places no greater burden on Mr. Graff's continuation reissue application than upon a continuation of an original application; § 251[2] neither overrides, enlarges, nor lim-

its the statement in § 251[3] that the provisions of Title 5 apply to reissues.

111 F.3d at 877, 42 USPQ2d at 1473. Accordingly, prosecution of a continuation of a reissue application will be permitted (despite the existence of the pending parent reissue application) where the continuation complies with the rules for reissue.

The parent and the continuation reissue applications should be examined together if possible. >In order that the parent-continuation relationship of the reissue applications be specifically identified and notice be provided of both reissue applications for *both the parent and the continuation reissue applications*, the following is done:

(A) < An appropriate amendment to the continuing data entries must be made to the first sentence of the specification, (see the discussion above under the heading "Divisional Reissue Applications")**>.

(B) For an IFW reissue application file, a copy of the bibliographic data sheet from the IFW file history should be printed and the examiner should annotate the printed sheet such that adequate notice is provided that more than one reissue application has been filed for a single original patent. The annotated sheet should be scanned into IFW. For reissue application files that are maintained in paper, the bibliographic data sheet should be reprinted (for 09/ and later series), or the front face of the reissue file wrapper should be marked (for 08/ and earlier series), for all the multiple reissue applications, so that adequate notice is provided that more than one reissue application has been filed for a single original patent.

As is true for the case of multiple divisional reissue applications, all of the claims of the patent to be reissued must be presented in both the parent reissue application and the continuation reissue application in some form, i.e., as amended, as unamended, or as canceled. The same claim of the patent cannot, however be presented for examination in both the parent reissue application and the continuation reissue application, as a pending claim, in either its original or amended versions. See the discussion in subsection I. above for treatment of this situation. Further, any added claims must be numbered beginning with the next highest number following the past patent claims.<

Where the parent reissue application issues prior to the examination of the continuation, the claims of the continuation should be carefully reviewed for double patenting over the claims of the parent. Where the parent and the continuation reissue applications are examined together, a provisional double patenting rejection should be made in both cases as to any overlapping claims. See MPEP § 804 - § 804.04 as to double patenting rejections. Any terminal disclaimer filed to obviate an obviousness-type double patenting rejection ensures common ownership of the reissue patents throughout the remainder of the unexpired term of the original patent.

If the parent reissue application issues without any cross reference to the continuation, amendment of the parent reissue patent to include a cross-reference to the continuation must be effected at the time of allowance of the continuation application by Certificate of Correction. See the discussion above under the heading "Divisional Reissue Applications" as to how the Certificate of Correction is to be provided.

Again, the examiner should make reference in the pending divisional reissue application to the fact that an actual request for a Certificate of Correction has been generated in the first reissue patent pursuant to 37 CFR 1.177(a), e.g., by an entry in the search notes or in an examiner's amendment.

Where a continuation reissue application is filed with a copy of the oath/declaration and assignee consent from the parent reissue application, and the parent reissue application is not to be abandoned, the copy of the consent of the parent reissue application should not be accepted. *The copy of the consent of the parent reissue application does not indicate that the assignee has consented to the addition of the new error correction of the continuation reissue application to the original patent. Presumably, a new correction has been added, since the parent reissue application is still pending.* OIPE should accord a filing date and send out a notice of missing parts stating that there is no proper consent and setting a period of time for filing the missing part and for payment of any surcharge required under 37 CFR 1.53(f) and 1.16(*>f<). See MPEP § 1410.01. The copy of the reissue oath/declaration should be accepted by OIPE, since it is a oath/declaration, albeit improper under 35 U.S.C. 251. The examiner should reject the claims of the continuation reissue application under

35 U.S.C. 251 as being based on an oath/declaration that does not identify an error being corrected by the continuation reissue application, and should require a new oath/declaration. >See 37 CFR 1.175(e). One of form paragraphs 14.01.01 through 14.01.03 may be used.< See MPEP § 1414.

Where a continuation reissue application is filed with a copy of the oath/declaration and assignee consent from the parent reissue application, and the parent reissue application is, or will be abandoned, the copy of the consent should be accepted by both OIPE and the examiner. The reissue oath/declaration should be accepted by OIPE, and the examiner should check to ensure that the oath/declaration identifies an error that is being corrected in the continuation reissue application. See MPEP § 1414. If a preliminary amendment was filed with the continuation reissue application, the examiner should check for the need of a supplemental reissue oath/declaration. Pursuant to 37 CFR 1.175 (b)(1), for any error corrected via the preliminary amendment which is not covered by the oath or declaration submitted in the parent reissue application, applicant must submit a supplemental oath/declaration stating that every such error arose without any deceptive intention on the part of the applicant. See MPEP § 1414 and § 1414.01.

1452 Request for Continued Examination of Reissue Application

A request for continued examination (RCE) under 37 CFR 1.114 is available for a reissue application. Effective May 29, 2000, an applicant in a reissue application may file a request for continued examination of the reissue application, if the reissue application was filed on or after June 8, 1995. This applies even where the application, which resulted in the original patent, was filed prior to June 8, 1995.

An RCE continues the prosecution of the existing reissue application and is not a filing of a new reissue application. Thus, the filing of an RCE will not be announced in the *Official Gazette*. Additionally, if a reissue application is merged with a reexamination proceeding (see MPEP § 1449.01), the filing of an RCE will not dissolve the merger, since the reissue application does not become abandoned.

1453 Amendments to Reissue Applications [R-5]

37 CFR 1.121. Manner of making amendments in application.

*****

(i) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

*****

37 CFR 1.173. Reissue specification, drawings, and amendments.

*****

(b) *Making amendments in a reissue application.* An amendment in a reissue application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used. If amendment is made by an amendment paper, the paper must direct that specified changes be made, as follows:

(1) Specification other than the claims. Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (d) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (see §§ 1.52(e)(1) and 1.821(c), but not for discs submitted under § 1.821(e)).

(2) *Claims.* An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(3) *Drawings.* One or more patent drawings shall be amended in the following manner: Any changes to a patent drawing must be submitted as a replacement sheet of drawings which shall be an attachment to the amendment document. Any replacement sheet of drawings must be in compliance with § 1.84 and shall include all of the figures appearing on the original version of the sheet, even if only one figure is amended. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled." All changes to the drawing(s) shall be explained, in detail, begin-

ning on a separate sheet accompanying the papers including the amendment to the drawings.

(i) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change to the drawings.

(ii) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(c) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(d) *Changes shown by markings.* Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (§§ 1.96 and 1.821(c)). Matter added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

(e) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claim added in the reissue application must follow the number of the highest numbered patent claim.

(f) *Amendment of disclosure may be required.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(g) *Amendments made relative to the patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

The provisions of 37 CFR 1.173(b)-(g) and those of 37 CFR 1.121(i) apply to amendments in reissue applications. Any amendments submitted in a reissue application **must** comply with 37 CFR 1.173(b).

Amendments submitted in a reissue application, including preliminary amendments (i.e., amendments filed as a separate paper to accompany the filing of a reissue application), must comply with the practice outlined below in this section; however, for examiner's amendments to the specification and claims, 37 CFR 1.121(g) provides certain exceptions to that practice in the interest of expediting prosecution. The exceptions set forth in 37 CFR 1.121(g) also apply in reissue applications.

Pursuant to 37 CFR 1.173(a), no amendment in a reissue application may enlarge the scope of the claims, unless "applied for within two years from the grant of the original patent." Further, the amendment may not introduce new matter. See MPEP § 1412.03 for further discussion as to the time limitation on enlarging the scope of the patent claims in a reissue application.

All amendment changes must be made relative to the patent to be reissued. Pursuant to 37 CFR 1.173(d), any such changes which are made to the specification, including the claims, must be shown by employing the following "**markings**:"

(A) The matter to be omitted by reissue must be enclosed in brackets; and

(B) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (pursuant to 37 CFR 1.96 for computer printouts or programs, and 37 CFR 1.825 for sequence listings). Matter added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

I. THE SPECIFICATION

37 CFR 1.173(b)(1) relates to the manner of making amendments to the specification other than the claims. It is not to be used for making amendments to the claims or the drawings.

All amendments which include any deletions or additions must be made by submission of the entire text of each added or rewritten paragraph with markings (as defined above), except that an entire paragraph of specification text may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. Applicant must indicate the precise point where each amendment is made. All bracketing and underlining is made in comparison to the original patent, not in comparison to any prior amendment in the reissue application. Thus, all paragraphs which are newly *added* to the specification of the original patent must be submitted as completely underlined each time they are re-submitted in the reissue application.

II. THE CLAIMS

37 CFR 1.173(b)(2) relates to the manner of making amendments to the claims in reissue applications. It is not to be used for making amendments to the remainder of the specification or to the drawings. 37 CFR 1.173(b)(2) requires that:

(A) For each claim that is being amended *by the amendment being submitted* (the current amendment), the entire text of the claim must be presented with markings as defined above;

(B) For each new claim added to the reissue *by the amendment being submitted* (the current amendment), the entire text of the added claim must be presented completely underlined;

(C) A patent claim should be canceled by a direction to cancel that claim, there is no need to present the patent claim surrounded by brackets; and

(D) A new claim (previously added in the reissue) should be canceled by a direction to cancel that claim.

Original patent claims are never to be renumbered; see 37 CFR 1.173(e). A patent claim retains its number even if it is canceled in the reissue proceeding, and the numbering of any added claims must begin after the last original patent claim.

Pursuant to 37 CFR 1.173(c), each amendment submitted must set forth the status of all patent claims and all added claims as of the date of the submission. The status to be set forth is whether the claim is pending or canceled. The failure to submit the claim status will generally result in a notification to applicant that the amendment *prior to final rejection* is not completely responsive (see 37 CFR 1.135(c)). Such an amendment *after final rejection* will not be entered.

Also pursuant to 37 CFR 1.173(c), each claim amendment must be accompanied by an explanation of the support in the disclosure of the patent for the amendment (i.e., support for all changes made in the claim(s), whether insertions or deletions). The failure to submit an explanation will generally result in a notification to applicant that the amendment *prior to final rejection* is not completely responsive (see 37 CFR 1.135(c)). Such an amendment *after final rejection* will not be entered.

III. THE DRAWINGS

37 CFR 1.173(a)(2) states that amendments to the original patent drawings are not permitted, and that any change to the drawings must be by way of 37 CFR 1.173(b)(3). See MPEP § 1413 for the manner of making amendments to the drawings in a reissue application.

Form paragraph 14.20.01 may be used to advise applicant of the proper manner of making amendments in a reissue application.

**>

¶ *14.20.01 Amendments To Reissue-37 CFR 1.173(b)*

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b). In addition, when any substantive amendment is filed in the reissue application, which amendment otherwise places the reissue application in condition for allowance, a supplemental oath/declaration will be required. See MPEP § 1414.01.

Examiner Note:

This form paragraph may be used in the first Office action to advise applicant of the proper manner of making amendments, and to notify applicant of the need to file a supplemental oath/declaration before the application can be allowed.

<

Form paragraph 14.21.01 may be used to notify applicant that proposed amendments **filed prior to final rejection** in the reissue application do not comply with 37 CFR 1.173(b).

¶ *14.21.01 Improper Amendment To Reissue - 37 CFR 1.173(b)*

The amendment filed [1] proposes amendments to [2] that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

A shortened statutory period for reply to this letter is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter.

Examiner Note:

1. This form paragraph may be used for any 37 CFR 1.173(b) informality as to an amendment submitted in a reissue application prior to final rejection. After final rejection, applicant should be informed that the amendment will not be entered by way of an Advisory Office action.

2. In bracket 2, specify the proposed amendments that are not in compliance.

Note that if an informal amendment is submitted **after final rejection,** form paragraph 14.21.01 should not be used. Rather, an advisory Office action should be issued using Form PTO-303 indicating that the amendment was not entered because it does not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications.

IV. ALL CHANGES ARE MADE *VIS-À-VIS* THE PATENT TO BE REISSUED

When a reissue patent is printed, all underlined matter is printed in *italics* and all brackets are printed as inserted in the application, in order to show exactly which additions and deletions have been made to the patent being reissued. Therefore, all underlining and bracketing in the reissue application should be made relative to the text of the patent, as follows. In accordance with 37 CFR 1.173(g), all amendments in the reissue application must be made relative to (i.e., *vis-à-vis*) the patent specification in effect as of the date of the filing of the reissue application. The patent specification includes the claims and drawings. If there was a prior change to the patent (made via a prior concluded reexamination certificate, reissue of the patent, certificate of correction, etc.), the first amendment of the subject reissue application must be made relative to the patent specification as changed by the prior proceeding or other mechanism for changing the patent. All amendments subsequent to the first amendment must also be made relative to the patent specification in effect as of the date of the filing of the reissue application, and **not** relative to the prior amendment.

The Subject Patent Already Has Underlining or Bracketing

If the original (or previously changed) patent includes a formula or equation already having underlining or bracketing therein as part of the formula or equation, any amendment of such formula or equation should be made by bracketing the entire formula and rewriting and totally underlining the amended formula in the re-presented paragraph of the specification or rewritten claim in which the changed formula or equation appears. Amendments of segments of a formula or equation should not be made. If the original patent includes bracketing and underlining from an earlier reexamination or reissue, double brackets and double underlining should be used in the subject reissue application to identify and distinguish the present changes being made. The subject reissue, when printed, would include double brackets (indicating deletions made in the subject reissue) and boldface type (indicating material added in the subject reissue).

V. EXAMPLES OF PROPER AMENDMENTS

A substantial number of problems arise in the Office because of improper submission of amendments in reissue applications. The following examples are provided to assist in preparation of proper amendments to reissue applications.

A. Original Patent Description or Patent Claim Amended

Example (1)

If it is desired to change the specification at column 4 line 23, to replace “is” with --are--, submit a copy of the entire paragraph of specification of the patent being amended with underlining and bracketing, and point out where the paragraph is located, e.g.,

Replace the paragraph beginning at column 4, line 23 with the following:

Scanning [is] are controlled by clocks which are, in turn, controlled from the display tube line synchronization. The signals resulting from scanning the scope of the character are delivered in parallel, then converted into serial mode through a shift register wherein the shift signal frequency is controlled by a clock that is, in turn, controlled from the display tube line synchronization.

Example (2)

For changes to the claims, one must submit a copy of the entire patent claim with the amendments shown by underlining and bracketing, e.g.,

Amend claim 6 as follows:

Claim 6 (Amended). The apparatus of claim [5] 1 wherein the [first] second piezoelectric element is parallel to the [second] third piezoelectric element.

If the dependency of any original patent claim is to be changed by amendment, it is proper to make that original patent claim dependent upon a later filed higher numbered claim.

B. Cancellation of Claim(s)

Example (3)

To cancel an original patent claim, in writing, direct cancellation of the patent claim, e.g.,

Cancel claim 6.

Example (4)

To cancel a new claim (previously added in the reissue), in writing, direct cancellation of the new claim, e.g.,

Cancel claim 15.

C. *Presentation of New Claims*

Example (5)

Each new claim (i.e., a claim not found in the patent, that is newly presented in the reissue application) should be presented with underlining throughout the claim, e.g.,

Add claim 7 as follows:

Claim 7. The apparatus of claim 5 further comprising electrodes attaching to said opposite faces of the first and second piezoelectric elements.

Even though original claims may have been canceled, the numbering of the original claims does not change. Accordingly, any added claims are numbered beginning with the number next higher than the number of claims in the original patent. If new claims have been added to the reissue application which are later canceled prior to issuance of the reissue patent, the examiner will renumber any remaining new claims in numerical order to follow the number of claims in the original patent.

D. *Amendment of New Claims*

An amendment of a "new claim" (i.e., a claim not found in the patent, that was previously presented in the reissue application) must be done by presenting the amended "new claim" containing the amendatory material, and completely underlining the claim. The presentation cannot contain any bracketing or other indication of what was in the previous version of the claim. This is because all changes in the reissue are made *vis-à-vis* the original patent, and not in comparison to the prior amendment. Although the presentation of the amended claim does not contain any indication of what is changed from the previous version of the claim, applicant must point out what is changed in the "Remarks" portion of the amendment. Also, per 37 CFR 1.173(c), each change made in the claim must be accompanied by an explanation of the support in the disclosure of the patent for the change.

E. *Amendment of Original Patent Claims More Than Once*

The following illustrates proper claim amendment of original patent claims in reissue applications:

A. Patent claim.

Claim 1. A cutting means having a handle portion and a blade portion.

B. Proper first amendment format.

Claim 1 (Amended). A [cutting means] knife having a bone handle portion and a notched blade portion.

C. Proper second amendment format.

Claim 1 (Twice Amended). A [cutting means] knife having a handle portion and a serrated blade portion.

Note that the second amendment must include the changes previously presented in the first amendment, i.e., [cutting means] knife, as well as the new changes presented in the second amendment, i.e., serrated.

The word bone was presented in the first amendment and is now to be deleted in the second amendment. The word "bone" is NOT to be shown in brackets in the second amendment. Rather, the word "bone" is simply omitted from the claim, since "bone" never appeared in the patent. An explanation of the deletion should appear in the remarks.

The word notched which was presented in the first amendment is replaced by the word serrated in the second amendment. The word notched is being deleted in the second amendment and did not appear in the patent; accordingly, "notched" is not shown in any form in the claim. The word serrated is being added in the second amendment, and accordingly "serrated" is added to the claim and is underlined.

In the second amendment, the deletions of "notched" and "bone" are not changes from the original patent claim text and therefore are not shown in brackets in the second amendment. In both the first and the second amendments, the entire claim is presented only with the changes from the original patent text.

VI. ADDITIONAL EXAMPLES

(A) For a reissue application, where the patent was previously reissued:

As per MPEP § 1411, double underlining and double bracketing are used in the second reissue application to show amendments made relative to the first reissued patent

(B) For a reissue application, where the patent was previously reexamined and a reexamination certificate has issued for the patent:

An amendment in the reissue application must be presented as if the changes made to the original patent text via the reexamination certificate are a part of the original patent. Thus, all italicized text of the reexamination certificate is presented in the amendment (made in the reissue application) without italics. Further, any text found in brackets in the reexamination certificate is omitted in the amendment (made in the reissue application).

(C) For a reissue application, where a certificate of correction has issued for the patent:

An amendment in the reissue application must be presented as if the changes made to the original patent text via the certificate of correction are a part of the original patent. Thus, all text added by certificate of correction is presented in the amendment (made in the reissue application) without italics. Further, any text deleted by certificate of correction is entirely omitted in the amendment (made in the reissue application).

(D) For a reissue application, where a statutory disclaimer has issued for the patent:

Any claim statutorily disclaimed is no longer in the patent, and such a claim cannot be amended. The statutorily disclaimed claim(s) should be lined through, and not surrounded by brackets.

1454 Appeal Brief [R-3]

The requirements for an appeal brief are set forth in 37 CFR *>41.37< and MPEP § 1206, and they apply to a reissue application in the same manner that they apply to a non-reissue application. There is, however, a difference in practice as to presentation of the copy of the claims in the appeal brief for a reissue application. The claims on appeal presented in an appeal brief for a reissue application should include all underlining and bracketing necessary to reflect the changes made to the patent claims during the prosecution of the reissue application. In addition, any new claims added in the reissue application should be completely underlined.

1455 Allowance and Issue [R-3]

**>

I. ISSUE CLASSIFICATION SHEET

For IFW reissue applications:

The examiner completes the Issue Classification sheet in the same manner as for a non-reissue application. In addition, a copy of the "Final SPRE Review" form must also be completed.

For reissue application files that are maintained in paper:<

In all reissue applications prepared for issue where a blue slip is needed (i.e., 08/ and earlier series), the patent number of the original patent which is being reissued should be placed in the box provided therefor below the box for the applicant's name on the blue Issue Classification Slip (form PTO-270) or design Issue Classification Slip (form PTO-328). Otherwise, the Issue Classification Slip is prepared in the same manner as for a non-reissue application. **

For 09/ and later series applications, the patent number of the original patent which is being reissued should be placed on the face of the file wrapper above the box "PREPARED AND APPROVED FOR ISSUE" just after "(Exr. Initials)" in the line reading "SURRENDER OF ORIGINAL PATENT________ (Exr. Initials)." **

>

II. < CHANGES TO THE ORIGINAL PATENT

The specifications of reissue patents will be printed in such a manner as to show the changes over the original patent text by enclosing any material omitted by the reissue in heavy brackets [ ] and printing material added by the reissue in *italics*. 37 CFR 1.173 (see MPEP § 1411) requires the specification of a reissue application to be presented in a specified form, specifically designed to facilitate this different manner of printing, as well as for other reasons.

The printed reissue patent specification will carry the following heading, which will be added by the Publishing Division of the Office of Patent Publication:

> "Matter enclosed in heavy brackets [ ] appears in the original patent but forms no part of this reissue specification; matter printed in italics indicates the additions made by reissue."

The examiners should see that the specification is in proper form for printing. Examiners should carefully check the entry of all amendments to ensure that the changes directed by applicant will be accurately printed in any reissue patent that may ultimately issue. Matter appearing in the original patent which is omitted by reissue should be enclosed in brackets, while matter added by reissue should be underlined.

Any material added by amendment in the reissue application (as underlined text) which is later canceled should be crossed through, *and not bracketed.* Material cancelled from the original patent should be enclosed in brackets, *and not lined through.*

All the claims of the original patent should appear in the reissue patent, with canceled patent claims being enclosed in brackets.

>

III. < CLAIM NUMBERING

No renumbering of the original patent claims is permitted, even if the dependency of a dependent patent claim is changed by reissue so that it is to be dependent on a subsequent higher numbered claim.

When a dependent claim in a reissue application depends upon a claim which has been canceled, and the dependent claim is not thereafter made dependent upon a pending claim, such a dependent claim must be rewritten in independent form.

New claims added during the prosecution of the reissue application should follow the number of the highest numbered patent claim and should be completely underlined to indicate they are to be printed in italics on the printed patent. Often, as a result of the prosecution and examination, some new claims are canceled while other new claims remain. When the reissue application is allowed, any claims remaining which are additional to the patent claims (i.e., claims added via the reissue application) should be renumbered in sequence starting with the number next higher than the number of the last claim in the original patent (the printed patent). Therefore, the number of claims allowed will not necessarily correspond to the number of the last claim in the reissue application, as allowed. The number of claims appearing in the >"Total Claims Allowed" box on the Issue Classification sheet (or for reissue application files that are maintained in paper, the< "CLAIMS ALLOWED - Total Claims" box on the lower right of the file wrapper face>)< at the time of allowance should be consistent with the number of claims indicated as allowable on the Notice of Allowability (Form PTOL-37). **

>

IV. < CLAIM DESIGNATED FOR PRINTING

At least one claim of an allowable reissue application must be designated for printing in the *Official Gazette*. Whenever at least one claim has been amended or added in the reissue, the claim (claims) designated for printing must be (or include) a claim which has been changed or added by the reissue. A canceled claim is not to be designated as the claim for the *Official Gazette.*

If there is no change in the claims of the allowable reissue application (i.e., when they are the same as the claims of the original patent) or, if the only change in the claims is the cancellation of claims, then the most representative pending *allowed* claim is designated for printing in the *Official Gazette.*

>

V. < PROVIDING PROPER FORMAT

Where a reissue application has not been prepared in the above-indicated manner, the examiner may obtain from the applicant a clean copy of the reissue specification prepared in the indicated form, or a proper submission of a previously improperly submitted amendment. However, if the deletions from the original patent are small, the reissue application can be prepared for issue by putting the bracketed inserts at the appropriate places and suitably numbering the added claims.

When applicant submits a clean copy of the reissue specification, or a proper submission of a previous improper amendment, a supplemental reissue declaration should **not** be provided to address this submission, because the correction of format does not correct a 35 U.S.C. 251 error in the patent.

>

VI. < PARENT APPLICATION DATA

All parent application data on the **>bibliographic data sheet of the original patent file (or front face of the original patent file wrapper if the original patent is a paper file) should be present on the bibliographic data sheet of the reissue application.<

It sometimes happens that the reissue is a continuation of another reissue application, and there is also

original-patent parent application data. The examiner should ensure that the parent application data on the original patent is properly combined with the parent application data of the reissue, in the text of the specification and on the bibliographic data sheet **>(<or on the front face of the reissue file wrapper for 08/ and earlier series applications>)<. ** The combined statement as to parent application data should be checked carefully for proper bracketing and underlining.
>

VII. < REFERENCES CITED AND PRINTED

The list of references to be printed in the reissue patent includes all the references cited during the prosecution of the reissue application. It is noted that the Office will not print in the reissue patent "References Cited" section any reference cited in the patent but not again cited in the reissue application. A patent cannot be reissued solely for the purpose of adding citations of additional prior art.
>

VIII. < EXAMINER'S AMENDMENT AND SUPPLEMENTAL DECLARATION

When it is necessary to amend the reissue application in order to place the application in condition for allowance, the examiner may:

(A) request that applicant provide the amendments (e.g., by facsimile transmission or by hand-carry); or

(B) make the amendments, with the applicant's approval, by a formal examiner's amendment.

If the changes are made by a formal examiner's amendment, the *entire* paragraph(s) or claim(s) being amended need not be presented in rewritten form for any deletions or additions. Changes to the specification including the claims of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. 37 CFR 1.121(g).

If it is necessary to amend a claim or the specification in order to correct an "error" under 35 U.S.C. 251 and thereby place the application in condition for allowance, then a supplemental oath or declaration will be required. See MPEP § 1444. The examiner should telephone applicant and request the supplemental oath or declaration, which must be filed before the application can be counted as an allowance.
>

IX. < FINAL REVIEW OF THE REISSUE APPLICATION BY THE EXAMINER

Prior to forwarding a reissue application to the Technology Center (TC) Special Program Examiner (SPRE) for final review, the examiner should complete and initial an Examiner Reissue Checklist. A copy of the checklist should be available from the SPRE or from the Paralegal Specialist of the TC.

1456 Reissue Review [R-3]

All reissue applications are monitored and reviewed in the Technology Centers (TCs) by the Office of TC Special Program Examiners (which includes TC SPREs, paralegals or other technical support who might be assigned as backup) at several stages during the prosecution. The review by the Office of the TC SPREs is made to check that practice and procedure unique to reissue has been carried out for the reissue application. In addition to the SPRE review of the reissue applications, a patentability review is made in a sample of reissue applications by the TC Quality Assurance Specialist (QAS) in the manner previously carried out by the former Office of Patent Quality Review. In order to ensure that SPREs are aware of the reissue applications in their TCs, a pair of terminal-specific PALM flags have been created which must be set by the SPRE before certain PALM transactions can be completed. First, when a new reissue application enters the TC, a SPRE must set a PALM "flag" by entering the reissue application number in an Office-wide computer grouping before a docketing transaction will be accepted. By having to set this first flag, the SPRE is made aware of the assignment of the reissue application to the TC and can take steps, as may be appropriate, to instruct the examiner on reissue-specific procedures before the examination process begins, as well as throughout the period that the examiner is handling the reissue application. Second, the SPRE must remove the above-described PALM "flag" before a Notice of Allowance can be generated or the PALM transaction for an issue revision can be entered, thereby ensuring that the SPRE is made aware of when the reissue application is being allowed so that the SPRE may be able to conduct a final review of the reissue application, if appropriate.

When the reissue application has been reviewed and is ready to be released to issue, the TC SPRE should >do the following:

For IFW reissue applications:

The SPRE should complete the "Final SPRE Review" form. The SPRE will discard any informal papers that were forwarded to the SPRE, such as the informal Reissue Check List that was filled out by the examiner. The SPRE will then forward (message) the reissue file to the Office of Patent Legal Administration (OPLA). The file for any original paper patent should be forwarded to OPLA.

For reissue application files that are maintained in paper:

The SPRE should< initial the face of the file wrapper, and forward the reissue file to >** OPLA.< Along with the reissue file, the file for the original patent should be forwarded to OPLA.**

After leaving the TC, all reissue applications go through a screening process which is currently performed in OPLA. The screening process which includes review of the reissue oath or declaration for compliance with 37 CFR 1.175, review of the presentation and entry of reissue amendments for compliance with 37 CFR 1.173(b), and review of other matters to ensure adherence to current reissue practices. The above identified review processes are appropriate vehicles for correcting errors, identifying problem areas and recognizing trends, providing information on the uniformity of practice, and providing feedback to the TC personnel responsible for processing and examining reissue applications.

1457 Design Reissue Applications and Patents [R-3]

A reissue application can be filed for a design patent in the same manner that a reissue application is filed for a utility patent. There are, however, a few aspects of a design reissue application that are addressed as follows:

I. EXPEDITED EXAMINATION PROCEDURE

Design reissue applications requesting expedited examination and complying with the requirements of 37 CFR 1.155 are examined with priority and undergo expedited processing throughout the entire course of prosecution in the Office, including appeal, if any, to the Board of Patent Appeals and Interferences. All processing is expedited from the date the request is granted.

Design reissue applicants seeking expedited examination may file a design reissue application in the Office together with a corresponding request under 37 CFR 1.155 pursuant to the guidelines set forth in MPEP § 1504.30.

The design reissue application and the request are processed by the Office of Initial Patent Examination (OIPE). OIPE **>enters the appropriate information into PALM< specifying when notice of the design reissue application will be published in the *Official Gazette* (see MPEP § 1441). ** After processing in OIPE, the design reissue application and the request are forwarded to the Design TC Director's Office. Upon a decision by the Design TC Director to grant the request for expedited examination, fees are immediately processed, and the application papers are promptly assigned an application number. The design reissue application file is then forwarded to the Office of Patent Legal Administration (OPLA) for a decision under 37 CFR 1.182 to *sua sponte* waive the requirement for delaying action in the application until 2 months after announcement of the design reissue application filing is published in the *Official Gazette* (see MPEP § 1441). Once the decision under 37 CFR 1.182 is mailed, the design reissue application file will be returned to the Design TC Director's Office. In accordance with the waiver, the Design Group will begin expedited examination of the application under 37 CFR 1.155 promptly after the return of the design reissue application file from OPLA, rather than delay examination until after 2 months from the date the announcement is published in the *Official Gazette* and the applicant will be notified that examination is being expedited. The decision under 37 CFR 1.182 will require that no Notice of Allowance be mailed in the design reissue application until after 2 months from the date the announcement is published in the *Official Gazette*. For example, if the design reissue application is allowed on the first Office action, then *>jurisdiction over the reissue< application will be *>retained< in the TC, and the Notice of Allowance will not be mailed until the expiration of 2 months after publication of the filing of the design reissue application in the *Official Gazette* (plus time for matching any protest filed with the application). (For IFW processing, see IFW Manual.) The examiner will check ** the PALM contents to ascertain when publication actually occurred. The delay in the mailing of the Notice of Allowance is to ensure that any potential protests complying with 37 CFR 1.291 submitted within the 2-month delay period will be considered by the Office. (see MPEP § 1441.01).

The expedited examination procedure under 37 CFR 1.155 occurs through initial examination processing and throughout the entire prosecution in the Office. Once a request for expedited examination is granted, prosecution of the design reissue application will proceed according to the procedure under 37 CFR 1.155, and there is no provision for "withdrawal" from expedited examination procedure.

II. DESIGN REISSUE FEE

The design reissue application fee is set forth for in 37 CFR **>1.16(e). For design reissue applications filed on or after December 8, 2004, a search fee (37 CFR 1.16(n)) and an examination fee (37 CFR 1.16(r)) are also required. The< additional fees in 37 CFR 1.16(*>h<) and 37 CFR 1.16(*>i<) do not apply for a design reissue application since more than one claim in not permitted in a design application pursuant to the last sentence of 37 CFR 1.153(a).

The fee for issuing a design reissue patent is set forth in 37 CFR **1.18(a)**.

III. MULTIPLE DESIGN REISSUE APPLICATIONS

The design reissue application can be filed based on the "error" of failing to include a design for a patentably distinct segregable part of the design claimed in the original patent or a patentably distinct subcombination of the claimed design. A reissue design application claiming both the entire article and the patentably distinct subcombination or segregable part would be proper under 35 U.S.C. 251, if such a reissue application is filed within two years of the issuance of the design patent, since it is considered a broadening of the scope of the patent claim. Restriction will be required under 37 CFR 1.176(b) in such a reissue design application, and the added design to the segregable part or subcombination will be held to be constructively non-elected and withdrawn from consideration. See MPEP § 1450. In the Office action containing the restriction requirement, the examiner should suggest to the applicant that a divisional design reissue application directed to the constructively non-elected segregable part or subcombination subject matter may be filed. The claim to the patented design for the entire article will then be examined and, if found allowable without change from the patent, a rejection will be made under 35 U.S.C. 251 based on the fact that there is no "error" in the non-amended original patent claim. In the Office action making this rejection, applicant should be advised that a proper response to the rejection must include (A) a request to suspend action in this original reissue application pending completion of examination of a divisional reissue application directed to the constructively non-elected segregable part or subcombination subject matter, (B) the filing of the divisional reissue application, or a statement that one has already been filed (identifying it at least by application number), and (C) an argument that a complete response to the rejection has been made based upon the filing of the divisional reissue application and the request for suspension. Action in the original design reissue application will then be suspended, and the divisional will be examined.

If, after examination, the divisional design reissue application is also determined to be allowable, a requirement must be made in the divisional design reissue application to submit a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.153 in order to permit the rejoining of the designs to the entire article (of the original application) and the segregable part or subcombination (of the divisional) under a single claim into a single design reissue application for issuance, the single application being the first design reissue application.

It should be noted that the filing of a design reissue application would not be proper if applicant did in fact include the design for a segregable part or subcombination thereof in the original design patent application, a restriction was thus made, and then applicant failed to file a divisional reissue application for a non-elected invention that was canceled in view of a restriction requirement (prior to issue of the original application. See *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977).

IV. CONVERSION TO UTILITY PATENT

A design patent cannot be converted to a utility patent via reissue.

Converting a design patent to a utility patent will, in most instances, involve the introduction of new matter into the patent. The disclosure of a design patent is not directed to how the invention is made and used, and the introduction of new matter is required to bridge this gap and provide support for the utility patent. Accordingly, the examiner should consider rejections based on the introduction of new matter under 35 U.S.C. 251, first paragraph, and lack of enablement and/or description under 35 U.S.C. 112, first paragraph, when a reissue application is filed to convert a design patent to a utility patent.

Further, the term of a design patent may not be extended by reissue. *Ex parte Lawrence*, 70 USPQ 326 (Comm'r Pat. 1946). Thus, any reissue application filed to convert a design patent to a utility patent, which conversion would thereby extend the term of the patent, should be rejected as failing to comply with 35 U.S.C. 251, first paragraph, which permits reissue only "for the unexpired part of the term of the original patent." The statute requires that the reissued patent shall not extend the term of the original patent.

1460 Effect of Reissue [R-2]

35 U.S.C. 252. Effect of reissue.

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are substantially identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, used, or imported as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made before the grant of the reissue, and the court may also provide for the continued practice of any process patented by the reissue that is practiced, or for the practice of which substantial preparation was made, before the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

The effect of the reissue of a patent is stated in 35 U.S.C. 252. With respect to the Office treatment of the reissued patent, the reissued patent will be viewed as if the original patent had been originally granted in the amended form provided by the reissue. >With respect to intervening rights resulting from the reissue of an original patent, the second paragraph of 35 U.S.C. 252 provides for two separate and distinct defenses to patent infringement under the doctrine of intervening rights:

"Absolute" intervening rights are available for a party that "prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent," and "equitable" intervening rights may be provided where "substantial preparation was made before the grant of the reissue." See *BIC Leisure Prods., Inc., v. Windsurfing Int'l, Inc.*, 1 F.3d 1214, 1220, 27 USPQ2d 1671, 1676 (Fed. Cir. 1993).<

1470 Public Access of Reissue Applications [R-3]

37 CFR 1.11(b) opens all reissue applications filed after March 1, 1977, to inspection by the general public. 37 CFR 1.11(b) also provides for announcement of the filings of reissue applications in the *Official Gazette* (except for continued prosecution applications filed under 37 CFR 1.53(d)). This announcement will give interested members of the public an opportunity to submit to the examiner information pertinent to patentability of the reissue application.

The filing of a continued prosecution application under 37 CFR 1.53(d) of a reissue application will not be announced in the *Official Gazette*. Although the filing of a continued prosecution application of a reissue application constitutes the filing of a reissue application, the announcement of the filing of such continued prosecution application would be redundant in view of the announcement of the filing of the prior reissue application in the *Official Gazette*.

37 CFR 1.11(b) is applicable **>to all< reissue applications filed on or after March 1, 1977. Those reissue applications previously on file will not be automatically open to inspection but a liberal policy will be followed in granting petitions for access to such applications.

**>IFW reissue application files are open to inspection by the general public by way of Public PAIR via the USPTO Internet site. In viewing the images of the files, members of the public will be able to view the entire content of the reissue application file history. To access Public PAIR, a member of the public would (A) go to the USPTO web site at http://www.uspto.gov, (B) click on "Patents," (C) under "Check Status, View Papers…" click on "Status & IFW," and (D) under "Patent Application Information Retrieval" enter the reissue application number.

Access to a reissue application that is maintained in paper must be obtained from the area of the Office having jurisdiction over the file. The following access procedure will be observed for reissue application files that are maintained in paper:

(A) Any member of the general public may request access to a particular reissue application filed after March 1, 1977. Since no record of such request is intended to be kept, an oral request will suffice. (Reissue applications already on file prior to March 1, 1977 are not automatically open to inspection, but a liberal policy is followed by the Office of Patent Legal Administration (OPLA) and by the Board of Patent Appeals and Interferences in granting petitions for access to such applications.);

(B) Paper reissue application files will be maintained in the TCs and inspection thereof will be supervised by TC personnel. A TC Director or other appropriate Office official may, under appropriate circumstances, postpone access to or the making of copies of a paper reissue application file, in order, for example, to avoid interruption of the examination or other review of the application by an examiner. In addition, though no general limit is placed on the amount of time spent reviewing the files, the Office may impose limitations, if necessary, e.g., where the application is actively being processed;

(C) In any instance where the reissue application file has left the TC for administrative processing, requests for access should be directed to the appropriate supervisory personnel where the application is currently located;<

(D) A >paper< reissue application file is not available to the public once the reissue application file has been released and forwarded by the TC for publication of the reissue patent. This would include any reissue application files which have been selected for a post-allowance screening at **>OPLA<. Unless prosecution is reopened pursuant to the screening, the reissue application files are not available to the public until the reissue patent issues. This is because the reissue application file has been put into a special format for printing purposes and public access at this stage would disrupt the publication process;

(E) Requests for copies of papers in the reissue application file must be in writing addressed to Mail Stop Document Services, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. Such requests may be either mailed or delivered to the Customer Service Window. The price for a copy of an application as filed is set forth in 37 CFR 1.19(b)(1). Since no useful purpose is seen for retaining such written requests for copies of papers in reissue applications, the request(s) should be destroyed after the order has been completed.

See also MPEP § 103.

1480 Certificates of Correction — Office Mistake [R-3]

35 U.S.C. 254. Certificate of correction of Patent and Trademark Office mistake.

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Director may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Director may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

37 CFR 1.322. Certificate of correction of Office mistake.

(a)(1) The Director may issue a certificate of correction pursuant to 35 U.S.C. 254 to correct a mistake in a patent, incurred through the fault of the Office, which mistake is clearly disclosed in the records of the Office:

(i) At the request of the patentee or the patentee's assignee;

(ii) Acting *sua sponte* for mistakes that the Office discovers; or

(iii) Acting on information about a mistake supplied by a third party.

(2)(i) There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section.

(ii) Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office.

(3) **>If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.<

(4) The Office will not issue a certificate of correction under this section without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in § 1.33(a) and affording the patentee or an assignee an opportunity to be heard.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Director may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

Mistakes incurred through the fault of the Office may be the subject of Certificates of Correction under 37 CFR 1.322. The Office, however, has discretion under 35 U.S.C. 254 to decline to issue a Certificate of Correction even though an Office mistake exists. If Office mistakes are of such a nature that the meaning intended is obvious from the context, the Office may decline to issue a certificate and merely place the correspondence in the patented file, where it serves to call attention to the matter in case any question as to it subsequently arises. Such is the case, even where a correction is requested by the patentee or patentee's assignee.

In order to expedite all proper requests, a Certificate of Correction should be requested only for errors of consequence. Instead of a request for a Certificate of Correction, letters making errors of record should be utilized whenever possible. Thus, where errors are of a minor typographical nature, or are readily apparent to one skilled in the art, a letter making the error(s) of record can be submitted in lieu of a request for a Certificate of Correction. There is no fee for the submission of such a letter.

It is strongly advised that the text of the correction requested be submitted on a Certificate of Correction form, PTO/SB/44 (also referred to as PTO 1050). Submission of this form in duplicate is not necessary. The location of the error in the printed patent should be identified on form PTO/SB/44 by column and line number or claim and line number. See MPEP § 1485 for a discussion of the preparation and submission of a request for a Certificate of Correction.

A request for a Certificate of Correction should be addressed to:

ATTN: Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

>

I. < THIRD PARTY INFORMATION ON MISTAKES IN PATENT

Third parties do not have standing to demand that the Office issue, or refuse to issue, a Certificate of Correction. *See Hallmark Cards, Inc. v. Lehman*, 959 F. Supp. 539, 543-44, 42 USPQ2d 1134, 1138 (D.D.C. 1997). 37 CFR 1.322(a)(2) makes it clear that third parties do not have standing to demand that the Office act on, respond to, issue, or refuse to issue a Certificate of Correction. The Office is, however, cognizant of the need for the public to have correct information about published patents and may therefore accept information about mistakes in patents from third parties. 37 CFR 1.322(a)(1)(iii). Where appropriate, the Office may issue certificates of correction based on information supplied by third parties, whether or not such information is accompanied by a specific request for issuance of a Certificate of Correction.

While third parties are permitted to submit information about mistakes in patents which information will be reviewed, the Office need not act on that information nor deny any accompanying request for issuance of a Certificate of Correction. Accordingly, a fee for submission of the information by a third party has not been imposed. The Office may, however, choose to issue a Certificate of Correction on its own initiative based on the information supplied by a third party, if it desires to do so. Regardless of whether the third party information is acted upon, the information will not be made of record in the file that it relates to, nor be retained by the Office. 37 CFR 1.322(a)(2)(ii).

When such third party information (about mistakes in patents) is received by the Office, the Office will not correspond with third parties about the information they submitted either (1) to inform the third parties of whether it intends to issue a Certificate of Correction, or (2) to issue a denial of any request for issuance of a Certificate of Correction that may accompany the information. The Office will confirm to the party submitting such information that the Office has in fact received the information if a stamped, self-addressed post card has been submitted. See MPEP § 503.

>

II. < PUBLICATION IN THE *OFFICIAL GAZETTE*

Each issue of the *Official Gazette* (patents section) numerically lists all United States patents having Certificates of Correction. The list appears under the heading "Certificates of Correction for the week of (date)."

>

1480.01 Expedited Issuance of Certificates of Correction - Error Attributable to Office [R-2]

In an effort to reduce the overall time required in processing and granting Certificate of Correction requests, the Office will expedite processing and granting of patentee requests where such requests are accompanied by evidence to show that the error is attributable solely to the Office (i.e., requests filed pursuant to 37 CFR 1.322 only).

The following requirements must be met for consideration of expedited issuance of Certificates of Correction:

The text of the correction requested should be submitted on a Certificate of Correction form, PTO/SB/44 (also referred to as PTO 1050). Submission of this form in duplicate is not necessary. The location of the error in the printed patent should be identified on form PTO/SB/44 by column and line number or claim and line number. See also MPEP § 1485.

Where the correction requested was incurred through the fault of the Office, and the matter is clearly disclosed in the records of the Office, and is accompanied by documentation that unequivocally supports the patentee's assertion(s), a Certificate of Correction will be expeditiously issued. Such supporting documentation can consist of relevant photocopied receipts, manuscript pages, correspondence dated and received by the Office, photocopies of Examiners' responses regarding entry of amendments, or any other validation that supports the patentee's request so that the request can be processed without the patent file.

Where only part of a request can be approved, the appropriate modifications will be made on the form PTO/SB/44 and the patentee then notified by mail. Further consideration will be given to initially rejected requests upon a request for reconsideration. In this instance, however, or in the case where it is determined that the Office was not responsible for the error(s) cited by the patentee, accelerated issuance of Certificates of Correction cannot be anticipated (although the Office will make every effort to process the request expeditiously).

As in the case of a request for a Certificate of Correction, a Request for Expedited Issuance of Certificate of Correction should be addressed to:

ATTN: Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450<

1481 Certificates of Correction - Applicant's Mistake [R-3]

35 U.S.C. 255. Certificate of correction of applicant's mistake.

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

37 CFR 1.323. Certificate of correction of applicant's mistake.

**>The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request of the patentee or the patentee's assignee, upon payment of the fee set forth in § 1.20(a). If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.<

37 CFR 1.323 relates to the issuance of Certificates of Correction for the correction of errors which were not the fault of the Office. Mistakes in a patent which are not correctable by Certificate of Correction may be correctable via filing a reissue application (see MPEP § 1401 - § 1460). See *Novo Industries, L.P. v. Micro Molds Corporation*, 350 F.3d 1348, 69 USPQ2d 1128 (Fed. Cir. 2003) (The Federal Circuit stated that when Congress in 1952 defined USPTO authority to make corrections with prospective effect, it did not deny correction authority to the district courts. A court, however, can correct only if "(1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation...").

In re Arnott, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991) specifies the criteria of 35 U.S.C. 255 (for a Certificate of Correction) as follows:

> Two separate statutory requirements must be met before a Certificate of Correction for an applicant's mistake may issue. The first statutory requirement concerns the nature, i.e., type, of the mistake for which a correction is sought. The mistake must be:
>
> (1) of a clerical nature,
>
> (2) of a typographical nature, or
>
> (3) a mistake of minor character.
>
> The second statutory requirement concerns the nature of the proposed correction. The correction must not involve changes which would:
>
> (1) constitute new matter or
>
> (2) require reexamination.

If the above criteria are not satisfied, then a Certificate of Correction for an applicant's mistake will not issue, and reissue must be employed as the vehicle to "correct" the patent. Usually, any mistake affecting claim scope must be corrected by reissue.

A mistake is not considered to be of the "minor" character required for the issuance of a Certificate of Correction if the requested change would materially affect the scope or meaning of the patent. See also MPEP § 1412.04 as to correction of inventorship via certificate of correction or reissue.

The fee for providing a correction of applicant's mistake, other than inventorship, is set forth in 37 CFR 1.20(a). The fee for correction of inventorship in a patent is set forth in 37 CFR 1.20(b).

**>

1481.01 Correction of Assignees' Names [R-3]

<

The **>Fee(s)< Transmittal Form portion (PTOL-85B) of the Notice of Allowance provides a space (item 3) for assignment data which should be completed in order to comply with 37 CFR 3.81. Unless an assignee's name and address are identified in the appropriate space for specifying the assignee, (i.e., item 3 of the **>Fee(s)< Transmittal Form PTOL-85B), the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

**>Any request for the issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee must:

(A) state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;

(B) include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); and

(C) include the processing fee set forth in 37 CFR 1.17(i).

See 37 CFR 3.81(b).

1481.02 Correction of Inventors' Names [R-3]

<

35 U.S.C. 256. Correction of named inventor.

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

In requesting the Office to effectuate a court order correcting inventorship in a patent pursuant to 35 U.S.C. 256, a copy of the court order and a Certificate of Correction under 37 CFR 1.323 should be submitted to the Certificates of Corrections Branch.

37 CFR 1.324. Correction of inventorship in patent, pursuant to 35 U.S.C. 256.

(a) **>Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director, pursuant to 35 U.S.C. 256, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.<

(b) **>Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:<

(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;

(3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and

(4) The fee set forth in § 1.20(b).

(c) **>For correction of inventorship in an application, see §§ 1.48 and 1.497.

(d) In a contested case before the Board of Patent Appeals and Interferences under part 41, subpart D, of this title, a request for correction of a patent must be in the form of a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.<

The petition to correct inventorship under 37 CFR 1.324 must include the statements and fee required by 37 CFR 1.324(b).

Under 37 CFR 1.324(b)(1), a statement is required from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on their part. In order to satisfy this, a statement such as the following is sufficient:

> "The inventorship error of failing to include John Smith as an inventor of the patent occurred without any deceptive intention on the part of John Smith."

Nothing more is required. The examiner will determine only whether the statement contains the required language; the examiner will not make any comment as to whether or not it appears that there was in fact deceptive intention (see MPEP § 2022.05).

Under 37 CFR 1.324(b)(2), all current inventors who did not submit a statement under 37 CFR 1.324(b)(1) must submit a statement either agreeing to the change of inventorship, or stating that they have no disagreement with regard to the requested change. "Current inventors" include the inventor(s) being retained as such and the inventor(s) to be deleted. These current inventors need not make a statement as to whether the inventorship error occurred without deceptive intention.

If an inventor is not available, or refuses, to submit a statement, the assignee of the patent may wish to consider filing a reissue application to correct inventorship, since the inventor's statement is not required for a non-broadening reissue application to correct inventorship. See MPEP § 1412.04.

Under 37 CFR 1.324(b)(3), a statement is required from the assignee(s) of the patent agreeing to the change of inventorship in the patent. The assignee statement agreeing to the change of inventorship must be accompanied by a proper statement under 37 CFR 3.73(b) establishing ownership, unless a proper 37 CFR 3.73(b) statement is already in the file. See MPEP § 324 as to the requirements of a statement under 37 CFR 3.73(b).

While a request under 37 CFR 1.48 is appropriate to correct inventorship in a nonprovisional *application*, a petition under 37 CFR 1.324 is the appropriate vehicle to correct inventorship in a *patent*. If a request under 37 CFR 1.48(a), (b), or (c) is inadvertently filed in a patent, the request may be treated as a petition under 37 CFR 1.324, and if it is grantable, form paragraph 10.14 set forth below should be used.

Similarly, if a request under 37 CFR 1.48(a), (b), or (c) is filed in a pending application but not acted upon until after the application becomes a patent, the request may be treated as a petition under 37 CFR

1.324, and if it is grantable, form paragraph 10.14 set forth below should be used.

The statutory basis for correction of inventorship in a patent under 37 CFR 1.324 is 35 U.S.C. 256. It is important to recognize that 35 U.S.C. 256 is stricter than 35 U.S.C. 116, the statutory basis for corrections of inventorship in applications under 37 CFR 1.48. 35 U.S.C. 256 requires "on application of all the parties and assignees," while 35 U.S.C. 116 does not have the same requirement. Under 35 U.S.C. 116 and 37 CFR 1.48, waiver requests under 37 CFR 1.183 may be submitted (see, e.g., MPEP § 201.03, under the heading "Statement of Lack of Deceptive Intention"). This is not possible under 35 U.S.C. 256 and 37 CFR 1.324. In correction of inventorship in a nonprovisional application under 37 CFR 1.48(a), the requirement for a statement by each originally named inventor may be waived pursuant to 37 CFR 1.183; however, correction of inventorship in a patent under 37 CFR 1.324 requires petition of all the parties, i.e., originally named inventors and assignees, in accordance with statute (35 U.S.C. 256) and thus the requirement cannot be waived. Correction of inventorship requests under 37 CFR 1.324 should be directed to the Supervisory Patent Examiner whose unit handles the subject matter of the patent. Form paragraphs 10.13 through 10.18 may be used.

¶ *10.13 Petition Under 37 CFR 1.324, Granted*

In re Patent No. [1]	:
Issue Date: [2]	: **DECISION**
Appl. No.: [3]	: **GRANTING**
Filed: [4]	: **PETITION**
For: [5]	: 37 CFR 1.324

This is a decision on the petition filed [6] to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

____

[7]
Supervisory Patent Examiner,
Art Unit [8],
Technology Center [9]
[10]

Examiner Note:

1. Petitions to correct inventorship of an issued patent are decided by the Supervisory Patent Examiner, as set forth in the Commissioner's memorandum dated June 2, 1989.
2. In bracket 10, insert the correspondence address of record.
3. This form paragraph is printed with the USPTO letterhead.
4. Prepare Certificate using form paragraph 10.15.

¶ *10.14 Treatment of Request Under 37 CFR 1.48 Petition Under 37 CFR 1.324, Petition Granted*

In re Patent No. [1]	:
Issue Date: [2]	: **DECISION**
Appl. No.: [3]	: **GRANTING**
Filed: [4]	: **PETITION**
For: [5]	: 37 CFR 1.324

This is a decision on the request under 37 CFR 1.48, filed [6]. In view of the fact that the patent has already issued, the request under 37 CFR 1.48 has been treated as a petition to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

____

[7]
Supervisory Patent Examiner,
Art Unit [8],
Technology Center [9]
[10]

Examiner Note:

1. Petitions to correct inventorship of an issued patent are decided by the Supervisory Patent Examiner, as set forth in the Commissioner's memorandum dated June 2, 1989.
2. This form paragraph is printed with the USPTO letterhead.
3. Prepare Certificate using form paragraph 10.15.
4. In bracket 10, insert the correspondence address of record.

¶ *10.15 Memorandum - Certificate of Correction (Inventorship)*

DATE: [1]
TO: Certificates of Correction Branch
FROM: [2], SPE, Art Unit [3]
SUBJECT: Request for Certificate of Correction

Please issue a Certificate of Correction in U. S. Letters Patent No. [4] as specified on the attached Certificate.

____

[5], SPE
Art Unit [6]

UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE

Patent No. [7]
Patented: [8]

On petition requesting issuance of a certificate for correction of inventorship pursuant to 35 U.S.C. 256, it has been found that the above identified patent, through error and without deceptive intent, improperly sets forth the inventorship. Accordingly, it is hereby certified that the correct inventorship of this patent is:

[9]

____

[10], Supervisory Patent Examiner

Art Unit [11]

Examiner Note:

1. In bracket 9, insert the full name and residence (City, State) of each actual inventor.

2. This is an internal memo, not to be mailed to applicant, which accompanies the patented file to Certificates of Correction Branch as noted in form paragraphs 10.13 and 10.14.

3. In brackets 5 and 10, insert name of SPE; in brackets 6 and 11 the Art Unit and sign above each line.

4. Two separate pages of USPTO letterhead will be printed when using this form paragraph.

¶ *10.16 Petition Under 37 CFR 1.324, Dismissed*

In re Patent No. [1]	:
Issue Date: [2]	: **DECISION**
Appl. No.: [3]	: **DISMISSING**
Filed: [4]	: **PETITION**
For: [5]	: 37 CFR 1.324

This is a decision on the petition filed [6] to correct inventorship under 37 CFR 1.324.

The petition is dismissed.

A petition to correct inventorship as provided by 37 CFR 1.324 requires (1) a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on their part, (2) a statement from the current named inventors (including any "inventor" being deleted) who have not submitted a statement as per "(1)" either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change, (3) a statement from all assignees of the parties submitting a statement under "(1)" and "(2)" agreeing to the change of inventorship in the patent; such statement must comply with the requirements of 37 CFR 3.73(b); and (4) the fee set forth in 37 CFR 1.20(b).This petition lacks item(s) [7].

____

[8]

Supervisory Patent Examiner,

Art Unit [9],

Technology Center [10]

[11]

Examiner Note:

1. If each of the four specified items has been submitted but one or more is insufficient, the petition should be denied. See paragraph 10.17. However, if the above noted deficiency can be cured by the submission of a renewed petition, a dismissal would be appropriate.

2. If the petition includes a request for suspension of the rules (37 CFR 1.183) of one or more provisions of 37 CFR 1.324 that are required by the statute (35 U.S.C. 256), form paragraph 10.18 should follow this form paragraph.

3. In bracket 7, pluralize as necessary and insert the item number(s) which are missing.

4. In bracket 11, insert correspondence address of record.

5. This form paragraph is printed with the USPTO letterhead.

¶ *10.17 Petition Under 37 CFR 1.324, Denied*

In re Patent No. [1]	:
Issue Date: [2]	:**DECISION DENYING PETITION**
Appl. No.: [3]	:*37 CFR 1.324*
Filed: [4]	:
For: [5]	:

This is a decision on the petition filed [6] to correct inventorship under 37 CFR 1.324.

The petition is denied.

[7]

____

[8]

Supervisory Patent Examiner,

Art Unit [9],

Technology Center [10]

[11]

Examiner Note:

1. In bracket 7, a full explanation of the deficiency must be provided.

2. If the petition lacks one or more of the required parts set forth in 37 CFR 1.324, it should be dismissed using form paragraph 10.14 or 10.20, rather than being denied.

3. In bracket 11, insert correspondence address of record.

4. This form paragraph is printed with the USPTO letterhead.

¶ *10.18 Waiver of Requirements of 37 CFR 1.324 Under 37 CFR 1.183, Dismissed*

Suspension of the rules under 37 CFR 1.183 may be granted for any requirement of the regulations which is not a requirement of the statutes. In this instance, 35 U.S.C. 256 requires [1]. Accordingly, the petition under 37 CFR 1.183 is dismissed as moot.

Examiner Note:

1. This form paragraph should follow form paragraph 10.16 whenever the petition requests waiver of one or more of the provisions of 37 CFR 1.324 that are also requirements of 35 U.S.C. 256.

2. If the petition requests waiver of requirements of 37 CFR 1.324 that are not specific requirements of the statute (i.e., the fee or the oath or declaration by all inventors), the application must be forwarded to a petitions attorney in the Office of the Deputy Commissioner for Patent Examination Policy for decision.

1481.03 Correction of 35 U.S.C. 119 and 35 U.S.C. 120 Benefits [R-5]

I. CORRECTION TO PERFECT CLAIM FOR 35 U.S.C. 119 (a)-(d) AND (f) BENEFITS

See MPEP § 201.16 for a discussion of when 35 U.S.C. 119 (a)-(d) and (f) benefits can be perfected by certificate of correction.

II. CORRECTION AS TO 35 U.S.C. 120 AND 35 U.S.C. 119(e) BENEFITS

A. For Applications Filed Prior to November 29, 2000

For applications filed prior to November 29, 2000, it is the version of 37 CFR 1.78, which was in effect as of November 29, 2000, that applies. The pre-November 29, 2000 version reads as follows:

37 CFR 1.78. Claiming benefit of earlier filing date and cross-references to other applications.

(a)(1) A nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or copending international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or copending international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior application must be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or

(ii) Complete as set forth in § 1.51(b); or

(iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or

(iv) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(f).

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following any title. The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior application. The identification of an application by application number under this section is the specific reference required by 35 U.S.C. 120 to every application assigned that application number. Cross-references to other related applications may be made when appropriate (see § 1.14(a)).

(3) A nonprovisional application other than for a design patent may claim an invention disclosed in one or more prior filed copending provisional applications. In order for a nonprovisional application to claim the benefit of one or more prior filed copending provisional applications, each prior provisional application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior provisional application must be entitled to a filing date as set forth in § 1.53(c), have any required English-language translation filed therein within the time period set forth in § 1.52(d), and have paid therein the basic filing fee set forth in § 1.16(k) within the time period set forth in § 1.53(g).

(4) Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number). Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following any title.

*****

Under certain conditions specified below, a Certificate of Correction can be used, with respect to 35 U.S.C. 120 and 119(e) priority, to correct:

(A) the failure to make reference to a prior copending application pursuant to 37 CFR 1.78(a)(2) and (a)(4); or

(B) an incorrect reference to a prior copending application pursuant to 37 CFR 1.78(a)(2) and (a)(4).

For all situations other than where priority is based upon 35 U.S.C. 365(c), the conditions are as follows:

(A) for 35 U.S.C. 120 priority, all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;

(B) for 35 U.S.C. 119(e) priority, all requirements set forth in 37 CFR 1.78(a)(3) must have been met in the application which became the patent to be corrected; and

(C) it must be clear from the record of the patent and the parent application(s) that priority is appropriate. See MPEP § 201.11 for requirements under 35 U.S.C. 119(e) and 120.

Where 35 U.S.C. 120 and 365(c) priority based on an international application is to be asserted or corrected in a patent via a Certificate of Correction, the following conditions must be satisfied:

(A) all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;

(B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see MPEP § 201.11); and

(C) the patentee must submit with the request for the certificate copies of documentation showing designation of states and any other information needed to make it clear from the record that the 35 U.S.C. 120 priority is appropriate. See MPEP § 201.13(b) as to the requirements for 35 U.S.C. 120 priority based on an international application.

If all the above-stated conditions are satisfied, a Certificate of Correction can be used to amend the patent to make reference to a prior copending application, or to correct an incorrect reference to the prior copending application. Note *In re Schuurs*, 218 USPQ 443 (Comm'r Pat. 1983) which suggests that a Certificate of Correction is an appropriate remedy for correcting, in a patent, reference to a prior copending application. Also, note *In re Lambrech*, 202 USPQ 620 (Comm'r Pat. 1976), citing *In re Van Esdonk*, 187 USPQ 671 (Comm'r Pat. 1975).

If any of the above-stated conditions is not satisfied, the filing of a reissue application (see MPEP § 1401 - § 1460) would be appropriate to pursue the desired correction of the patent.

B. For Applications Filed on or After November 29, 2000

For applications filed on or after November 29, 2000, the version of 37 CFR 1.78 reproduced below applies (note that amendments to 37 CFR 1.78 took effect on November 29, 2000, December 28, 2001, May 1, 2003, January 21, 2004, September 21, 2004, December 8, 2004, * July 1, 2005>, and November 25, 2005<).

37 CFR 1.78. Claiming benefit of earlier filing date and cross-references to other applications.

(a)(1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonprovisional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed application must be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or

(ii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and have paid therein the basic filing fee set forth in § 1.16 within the pendency of the application.

(2)(i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;

(B) An application filed under 35 U.S.C. 111 (a) before November 29, 2000; or

(C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

(iv) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

(i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(4) A nonprovisional application, other than for a design patent, or an international application designating the United States of America may claim an invention disclosed in one or more prior-filed provisional applications. In order for an application to claim the benefit of one or more prior-filed provisional applications, each prior-filed provisional application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(d) must be paid within the time period set forth in § 1.53(g).

(5)(i) Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed provisional application. These time periods are not extendable. Except as provided in paragraph(a)(6) of this section, the failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) to such prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(B) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

**>

(iv) If the prior-filed provisional application was filed in a language other than English and both an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application, applicant will be notified and given a period of time within which to file, in the prior-filed provisional application, the translation and the statement. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing in the nonprovisional application of either a confirmation that the translation and statement were filed in the provisional application, or an amendment or Supplemental Application Data Sheet withdrawing the benefit claim, or the nonprovisional application will be abandoned. The translation and statement may be filed in the provisional application, even if the provisional application has become abandoned.<

(6) If the reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(5)(ii) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application may be accepted during the pendency of the later-filed application if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application must be accompanied by:

(i) The reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section to the prior-filed provisional application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(5)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(b) Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

(c) If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same person and contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, the Office may require the assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and if not, indicate which named inventor is the prior inventor. Even if the claimed inventions were commonly owned, or subject to an obligation of assignment to the same person, at the time the later invention was made, the conflicting claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.

Under no circumstances can a Certificate of Correction be employed to correct an applicant's mistake by adding or correcting a priority claim under 35 U.S.C. 119(e) for an application filed on or after November 29, 2000.

Section 4503 of the American Inventors Protection Act of 1999 (AIPA) amended 35 U.S.C. 119(e)(1) to state that:

> No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section ***during the pendency of the application***. (emphasis added)

**>A< Certificate of Correction is **>NOT< a valid mechanism for adding or correcting a priority claim under 35 U.S.C. 119(e) after a patent has been granted on an application filed on or after November 29, 2000.

Under certain conditions as specified below, however, a Certificate of Correction can still be used, with respect to 35 U.S.C. 120 priority, to correct:

(A) the failure to make reference to a prior copending application pursuant to 37 CFR 1.78(a)(2); or

(B) an incorrect reference to a prior copending application pursuant to 37 CFR 1.78(a)(2).

Where priority is based upon 35 U.S.C. 120 to a **national application**, the following conditions must be satisfied:

(A) all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;

(B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see MPEP § 201.11); and

(C) a grantable petition to accept an unintentionally delayed claim for the benefit of a prior application must be filed, including a surcharge as set forth in 37 CFR 1.17(t), as required by 37 CFR 1.78(a)(3).

Where 35 U.S.C. 120 and 365(c) priority based on **an international application** is to be asserted or corrected in a patent via a Certificate of Correction, the following conditions must be satisfied:

(A) all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;

(B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see MPEP § 201.11);

(C) the patentee must submit together with the request for the certificate, copies of documentation showing designation of states and any other information needed to make it clear from the record that the 35 U.S.C. 120 priority is appropriate (see MPEP § 201.13(b) as to the requirements for 35 U.S.C. 120 priority based on an international application; and

(D) a grantable petition to accept an unintentionally delayed claim for the benefit of a prior application must be filed, including a surcharge as set forth in 37 CFR 1.17(t), as required by 37 CFR 1.78(a)(3).

(C) Starting the correction to each separate column as a sentence, and using semicolons to separate corrections within the same column, where possible.

(D) Leaving a two-inch space blank at bottom of the last sheet for the signature of the attesting officer.

(E) Using quotation marks to enclose the exact subject matter to be deleted or corrected; using double hyphens (-- --) to enclose subject matter to be added, except for formulas.

(F) Where a formula is involved, setting out only that portion thereof which is to be corrected or, if necessary, pasting a photocopy onto form PTO/SB/44.

UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

**>

Patent No. :9,999,999
Application No. :10/999,999
Issue Date :May 1, 2002
Inventor(s) :Eli Y. Rosenthal

<

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In the drawings, Sheet 3, Fig. 3, the reference numeral 225 should be applied to the plate element attached to the support member 207:

Column 2, line 68 and column 3, lines 3, 8 and 13, for the claim reference numeral '2', each occurrence, should read -1-.

Column 7, lines 45 to 49, the left-hand formula should appear as follows:

$-R_3$ -CHF

Column 8, Formula XVII, that portion of the formula reading "-CHClCH-" should read --CHFCH$_2$ --; line 5, "chlorine" should be changed to --fluorine--.

Column 10, line 29, cancel the text beginning with "12. A sensor device" to and ending "active strips." in column 11, line 10, and insert the following claim:

12. A control circuit of the character set forth in claim 4 and for an automobile having a convertible top, and including; means for moving the top between a raised and lowered retracted position; and control means responsive to a sensor relay for energizing the top moving means for moving said top from a retracted position to a raised position.

ELECTRONIC PUBLICATION OF CERTIFICATES OF CORRECTION WITH LATER LISTING IN THE *OFFICIAL GAZETTE*

Effective August 2001, the U.S. Patent and Trademark Office (USPTO) publishes on the USPTO web site at http://www.uspto.gov/web/patents/certofcorrect a listing by patent number of the patents for which certificates of correction are being issued.

The USPTO is now automating the publication process for certificates of correction. This new process will result in certificates of correction being published quicker electronically on the USPTO's web site as compared to their paper publication and the listing of the certificates of correction in the *Official Gazette*. Under the newly automated process, each issue of certificates of correction will be electronically published on the USPTO web site at http://www.uspto.gov/web/patents/certofcorrect, and will also subsequently be listed in the *Official Gazette* (and in the *Official Gazette Notices* posted at http://www.uspto.gov/web/offices/com/sol/og) approximately three weeks thereafter. The listing of certificates of correction in the *Official Gazette* will include the certificate's date of issuance.

On the date on which the listing of certificates of correction is electronically published on the USPTO web site: (A) the certificate of correction will be entered into the file wrapper of a paper-file patent, or entered into the file history of an IFW-file patent and will be available to the public; (B) a printed copy of the certificate of correction will be mailed to the patentee or the patent's assignee; and (C) an image of the printed certificate of correction will be added to the image of the patent on the patent database at http://www.uspto.gov.patft. Dissemination of all other paper copies of the certificate of correction will occur shortly thereafter.

The date on which the USPTO makes the certificate of correction available to the public (e.g., by adding the certificate of correction to the file wrapper/file history) will be regarded as the date of issuance of the certificate of correction, not the date of the certificate of correction appearing in the *Official Gazette*. (For IFW processing, see IFW Manual.) Certificates of correction published in the above-described manner will provide the public with prompt notice and access, and this is consistent with the legislative intent behind the American Inventors Protection Act of 1999. See

35 U.S.C. 10(a) (authorizing the USPTO to publish in electronic form).

The listing of certificates of correction can be electronically accessed on the day of issuance at http://www.uspto.gov/web/patents/certofcorrect. The electronic image of the printed certificate of correction can be accessed on the patent database at http://www.uspto.gov/patft and the listing of the certificates of correction, as published in the *Official Gazette* three weeks later, will be electronically accessible at http://www.uspto.gov/web/offices/com/sol/og.

PTO/SB/44 (04-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

Page _____ of _____

PATENT NO. :

APPLICATION NO.:

ISSUE DATE :

INVENTOR(S) :

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

MAILING ADDRESS OF SENDER (Please do not use customer number below):

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

1490 Disclaimers [R-5]

35 U.S.C. 253. Disclaimer.

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

37 CFR 1.321. Statutory disclaimers, including terminal disclaimers.

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the *Official Gazette* and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) be signed by the patentee, or an attorney or agent of record;

(2) identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term, will be refused recordation;

(3) state the present extent of patentee's ownership interest in the patent; and

(4) be accompanied by the fee set forth in § 1.20(d).

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) be signed:

(i) by the applicant, or

(ii) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or

(iii) if there is an assignee of record of the entire interest, by such assignee, or

(iv) by an attorney or agent of record;

(2) specify the portion of the term of the patent being disclaimed;

(3) state the present extent of applicant's or assignee's ownership interest in the patent to be granted; and

(4) be accompanied by the fee set forth in § 1.20(d).

(c) A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as provided for in paragraph (d) of this section, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.

>

(d) A terminal disclaimer, when filed in a patent application or in a reexamination proceeding to obviate double patenting based upon a patent or application that is not commonly owned but was disqualified under 35 U.S.C. 103(c) as resulting from activities undertaken within the scope of a joint research agreement, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or be signed in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding;

(3) Include a provision waiving the right to separately enforce any patent granted on that application or any patent subject to the reexamination proceeding and the patent or any patent granted on the application which formed the basis for the double patenting, and that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent and the patent, or any patent granted on the application, which formed the basis for the double patenting are not separately enforced.

A disclaimer is a statement filed by an owner (in part or in entirety) of a patent or of a patent to be granted (i.e., an application), in which said owner relinquishes certain legal rights to the patent. There are two types of disclaimers: a statutory disclaimer and a terminal disclaimer. The owner of a patent or an application is the original inventor(s) or the assignee of the original inventor(s). The patent or application is assigned by one assignment or by multiple assignments which establish a chain of title from the inventor(s) to the assignee(s). The owner of the patent or application can sign a disclaimer, and a person empowered by the owner to sign the disclaimer can also sign it. Per 37 CFR 1.321(b)(1)(iv), an attorney or agent of record is permitted to sign the disclaimer. A registered practitioner acting in a representative capacity under 37 CFR 1.34 is not permitted to sign the disclaimer. For a disclaimer to be accepted, it must be signed by the proper party as follows:

(A) A disclaimer filed in an application must be signed by

(1) the applicant where the application has not been assigned,

(2) the applicant and the assignee where each owns a part interest in the application,

(3) the assignee where assignee owns the entire interest in the application, or

(4) an attorney or agent of record.

(B) A disclaimer filed in a patent or a reexamination proceeding must be signed by either

(1) the patentee (the assignee, the inventor(s) if the patent is not assigned, or the assignee and the inventors if the patent is assigned-in-part), or

(2) an attorney or agent of record.

(C) Where the assignee (of an application or of a patent being reexamined or to be reissued) signs the disclaimer, there is a requirement to comply with 37 CFR 3.73(b) in order to satisfy 37 CFR 1.321, unless an attorney or agent of record signs the disclaimer. In order to comply with 37 CFR 3.73(b), the assignee's ownership interest must be established by:

(1) filing in the application or patent evidence of a chain of title from the original owner to the assignee >and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11<, or

(2) specifying in the record of the application or patent where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to 37 CFR 3.73(b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See also MPEP § 324 as to compliance with 37 CFR 3.73(b). A copy of the "Statement Under 37 CFR 3.73 (b)," which is reproduced in MPEP § 324, may be sent by the examiner to applicant to provide an acceptable way to comply with the requirements of 37 CFR 3.73 (b).

(D) Where the attorney or agent of record signs the disclaimer, **there is no need** to comply with 37 CFR 3.73(b).

(E) The signature on the disclaimer need not be an original signature. Pursuant to 37 CFR 1.4(d)(1)(ii), the submitted disclaimer can be a copy, such as a photocopy or facsimile transmission of an original disclaimer.

I. STATUTORY DISCLAIMERS

Under 37 CFR 1.321(a) the owner of a patent may disclaim a complete claim or claims of his or her patent. This may result from a lawsuit or because he or she has reason to believe that the claim or claims are too broad or otherwise invalid. If the patent is involved in an interference, see 37 CFR 41.121(a).

As noted above, a statutory disclaimer is a statement in which a patent owner relinquishes legal rights to one or more claims of a patent. A statutory disclaimer is not, however, a vehicle for adding or amending claims, since there is no provision for such in the statute (35 U.S.C. 253) nor the rules (37 CFR 1.321). Thus, claims of a patent cannot be disclaimed in favor of new claims to be added to the patent or an amendment to existing claims.

II. TERMINAL DISCLAIMERS

37 CFR 1.321(a) also provides for the filing by an applicant or patentee of a terminal disclaimer which disclaims or dedicates to the public the entire term or any portion of the term of a patent or patent to be granted.

37 CFR 1.321(c) specifically provides for the filing of a terminal disclaimer in an application or a reexamination proceeding for the purpose of overcoming a nonstatutory double patenting rejection. See MPEP § 804.02.

37 CFR 1.321(d) specifically provides for the filing of a terminal disclaimer in an application or a reexamination proceeding for the purpose of overcoming a nonstatutory double patenting rejection based on a U.S. patent or application that is not commonly owned but was disqualified under 35 U.S.C. 103(c).

III. PROCESSING

Certificate of Correction Branch

The Certificate of Correction Branch is responsible for the handling of all statutory disclaimers filed under the first paragraph of 35 U.S.C. 253, whether the case is pending or patented, and all terminal disclaimers (filed under the second paragraph of 35 U.S.C. 253) except for those filed in an application or reexamination proceeding pending in a Technology Center (TC). This involves:

(A) Determining the compliance of the disclaimer with 35 U.S.C. 253 and 37 CFR 1.321 and 3.73;

(B) Notifying applicant or patentee when the disclaimer is informal and thus not acceptable;

(C) Recording the disclaimers in the record of the application file; and

(D) Providing the disclaimer data for printing in the *Official Gazette*.

IV. TERMINAL DISCLAIMER IN PENDING APPLICATION PRACTICE IN THE TECHNOLOGY CENTERS

Where a terminal disclaimer is filed in an application pending in a TC, it will be processed by the paralegal of the Office of the Special Program Examiner of the TC having responsibility for the application. The paralegal will:

(A) Determine compliance with 35 U.S.C. 253 and 37 CFR 1.321 and 3.73, and ensure that the appropriate terminal disclaimer fee set forth in 37 CFR 1.20(d) is/was applied;

(B) Notify the examiner having charge of the application whether the terminal disclaimer is acceptable or not;

(C) Where the terminal disclaimer is not acceptable, indicate the nature of the informalities so that the examiner can inform applicant in the next Office action. For an IFW application, complete the IFW terminal disclaimer form by checking the "Disapproved" box and have the form scanned into IFW;

(D) Where the terminal disclaimer is acceptable, record the terminal disclaimer in the record of the application as set forth below.

The paralegal will record an acceptable terminal disclaimer as being present in an application by:

For IFW applications:

(A) Completing the IFW terminal disclaimer form by checking the "Approved" box and having the form scanned into IFW; and

(B) Entering the terminal disclaimer into PALM for the application.

For application files that are maintained in paper:

For paper applications with 08/ and earlier series code

(A) Attaching a green label to the file wrapper;

(B) Stamping a notice on the file of the term which has been disclaimed (note that the blanks on the stamped notice for entering information on the patent(s) being disclaimed are no longer filled in);

(C) Endorsing the paper containing the terminal disclaimer submission on the "Contents" flap of the application file; and

(D) Entering the terminal disclaimer into the PALM system records, for the application.

For paper applications with 09/ and later series code

(A) Checking a box on the file wrapper which states that the terminal disclaimer has been filed (Any blanks for entering information on the patent(s) being disclaimed are no longer filled in. Note that applications with 10/ and later series codes no longer have such blanks to complete);

(B) Endorsing the paper containing the terminal disclaimer submission on the "Contents" flap of the application file; and

(C) Entering the terminal disclaimer into the PALM system records, for the application.

The paralegal completes a Terminal Disclaimer Informal Memo to notify the examiner of the nature of any informalities in the terminal disclaimer. The examiner should notify the applicant of the informalities in the next Office action, or by interview with applicant if such will expedite prosecution of the application. Further, the examiner should initial and date the Terminal Disclaimer Informal Memo and return it to the paralegal to indicate that the examiner has appropriately notified applicant about the terminal disclaimer. The paralegal will then discard the Terminal Disclaimer Informal Memo.

V. OTHER MATTERS DIRECTED TO TERMINAL DISCLAIMERS

A. Requirements of Terminal Disclaimers

A proper terminal disclaimer must disclaim the terminal part of the statutory term of any patent granted on the application being examined which would extend beyond the expiration date of the full statutory term, shortened by any terminal disclaimer, of the patent (or of any patent granted on the application) to which the disclaimer is directed. Note the exculpatory language in the second paragraph of the sample terminal disclaimer forms, PTO/SB/25 and PTO/SB/26, provided at the end of this Chapter. That language ("In making the above disclaimer, the owner does not disclaim...") is permissible in a terminal disclaimer.

A terminal disclaimer filed to obviate a nonstatutory double patenting rejection based on a commonly owned patent or application must comply with the requirements of 37 CFR 1.321(c). The terminal disclaimer must state that any patent granted on the application being examined will be enforceable only for and during the period that it and the patent to which the disclaimer is directed or the patent granted on the application to which the disclaimer is directed are commonly owned. See MPEP § 706.02(l)(2) for examples of common ownership, or lack thereof.

**

A terminal disclaimer filed to obviate a nonstatutory double patenting rejection based on a non-commonly owned patent or application disqualified under 35 U.S.C. 103(c) as a result of activities undertaken within the scope of a joint research agreement >under 35 U.S.C. 103(c)(2) and (3)< must comply with 37 CFR 1.321(d), which sets forth signature, waiver rights and enforceability requirements.

>

The terminal disclaimer must include a provision:

(1) waiving the right to separately enforce (a) any patent granted on that application or the patent being reexamined and (b) the reference patent, or any patent granted on the reference application which formed the basis for the double patenting; and

(2) agreeing that any patent granted on that application or patent being reexamined shall be enforceable only for and during such period that said patent and the reference patent, or any patent granted on the reference application, which formed the basis for the double patenting are not separately enforced.

A terminal disclaimer must state that the agreement is to run with any patent granted on the application being examined and is to be binding upon the grantee, its successors, or assigns.<

A statement of assignee interest in a terminal disclaimer that "A and B are the owners of 100% of the instant application..." is sufficient to satisfy the 37 CFR 1.321(b)(3) requirement that a terminal disclaimer "state the present extent of applicant's or assignee's ownership interest in the patent to be granted." Although the quoted statement does not identify what specific percentage is owned by A and what specific percentage is owned by B, the statement does provide consent to the terminal disclaimer by the entirety of the ownership of the application (A and B own all of the invention, regardless of the individual percentages they own).

The appropriate one of form paragraphs 14.27.04 to 14.27.08 (reproduced below) may be used to provide applicant or patent owner with an example of acceptable terminal disclaimer language. Additionally, copies of forms PTO/SB/25 and PTO/SB/26 (provided at the end of this Chapter) may be attached to the Office action to provide sample terminal disclaimers.

Pursuant to the last sentence of 35 U.S.C. 253, "any patentee or applicant may disclaim or dedicate to the public... any terminal part of the term, of the patent granted or to be granted". Accordingly, the disclaimer must be of a terminal portion of the term of the entire patent to be granted. A disclaimer of a terminal portion of the term of an individual claim, or individual claims will not be accepted. It is further noted that a disclaimer of the term of individual claims would not be appropriate since the claims of a pending application or proceeding are subject to cancelation, amendment, or renumbering. The statute does not provide for conditional disclaimers and accordingly, a proposed disclaimer which is made contingent on the allowance of certain claims cannot be accepted. The disclaimer should identify the disclaimant and his or her interest in the application and should specify the date when the disclaimer is to become effective.

B. *Effect of Disclaimers in Continuing Applications and in Reissues*

A terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application identified in the disclaimer unless by its terms it extends to continuing applications. For example, a terminal disclaimer filed in a parent application normally has no effect on a continuing application claiming filing date benefits of the parent application under 35 U.S.C. 120. A terminal disclaimer filed in a parent application to obviate a double patenting rejection *does, however, carry over* to a continued prosecution application (CPA) filed under 37 CFR 1.53(d) (effective July 14, 2003, CPAs are only available in design applications). The terminal disclaimer filed in the parent application carries over because the CPA retains the *same application number* as the parent application, i.e., the application number to which the previously filed terminal disclaimer is directed. If applicant does not want the terminal disclaimer to carry over to the CPA, applicant must file a petition under 37 CFR 1.182, along with the required petition fee, requesting the terminal disclaimer filed in the parent application not be carried over to the CPA; see below "Withdrawing a Terminal Disclaimer" (paragraph "A. Before Issuance of Patent"). If applicant files a Request for Continued Examination (RCE) of an application under 37 CFR 1.114 (which can be filed on or after May 29, 2000 for an application filed on or after June 8, 1995), any terminal disclaimer present will continue to operate, since a new application has not been filed, but rather prosecution has been continued in the existing application. A petition under 37 CFR 1.182, along with the required petition fee, may be filed, if withdrawal of the terminal disclaimer is to be requested.

Reissue applications: Where a terminal disclaimer was filed in an original application, a copy of that terminal disclaimer is not required be filed by applicant in the reissue.

For reissue application files that are maintained in paper:

The face of the file wrapper of the reissue application should, however, be marked by the examiner in order to indicate that a terminal disclaimer has been filed for the patent (and will be effective for the patent as it will be reissued). Further, a copy of the terminal disclaimer should be placed in the reissue application file by the Technology Center.

For IFW reissue applications:

The "Final SPRE Review" form will be filled in to indicate that a terminal disclaimer has been filed for the patent (and will be effective for the patent as it will be reissued). Further, a copy of the terminal disclaimer should be scanned into the reissue application file history by the Technology Center.

C. *Disclaimer Identifies the Wrong Target Application or Patent*

In some instances a terminal disclaimer filed to obviate an obviousness type double patenting rejection will identify the wrong target application or patent (i.e., an application or patent which is not the basis for the double patenting rejection). In these instances, a replacement terminal disclaimer identifying the correct target application or patent would be required by the examiner. Once a correct replacement terminal disclaimer is received, the next Office action should make it clear that "the second terminal disclaimer replaces the first terminal disclaimer, and the first terminal disclaimer is thus void." A second terminal disclaimer fee should not be assessed/charged, since the first fee is applied to the second terminal disclaimer.

D. *Two or More Copending Applications*

If two (or more) pending applications are filed, in *each* of which a rejection of one claimed invention over the other on the ground of provisional obviousness-type double patenting (ODP) is proper, the ODP rejection will be made in each application. If the ODP rejection is the only rejection remaining in the earlier filed of the two pending applications, (but the later-filed application is rejectable on other grounds), the examiner should then withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only rejection remaining in the later-filed application, (while the earlier-filed application is rejectable on other grounds), a terminal disclaimer must be required in the later-filed application, before the ODP rejection can be withdrawn.

If the ODP rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application be permitted to issue.

If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.

Where there are three applications containing claims that conflict such that an ODP rejection is made in each application based upon the other two, it is not sufficient to file a terminal disclaimer in only one of the applications addressing the other two applications. Rather, an appropriate terminal disclaimer must be filed in at least two of the applications to link all three together. This is because a terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application in which the terminal disclaimer is filed; it is not effective to link the other two applications to each other.

VI. FORM PARAGRAPHS

The following form paragraphs may be used to inform the applicant (or patent owner) of the status of a submitted terminal disclaimer.

¶ *14.23 Terminal Disclaimer Proper*

The terminal disclaimer filed on [1] disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of [2] has been reviewed and is accepted. The terminal disclaimer has been recorded.

Examiner Note:

1. In bracket 1, insert the date the terminal disclaimer was filed.
2. In bracket 2, list the Patent Number and/or Application Number (including series code and serial no.). Where an Application Number is listed, it must be preceded by the phrase --any patent granted on Application Number--.
3. If an assignment is submitted to support the terminal disclaimer, also use form paragraph 14.34 to suggest that the assignment be separately submitted for recording in the Office.
4. See MPEP § 1490 for discussion of requirements for a proper terminal disclaimer.
5. Use form paragraph 14.23.01 for reexamination proceedings.
6. For improper terminal disclaimers, see form paragraphs 14.24 *et seq*.

¶ *14.23.01 Terminal Disclaimer Proper (Reexamination Only)*

The terminal disclaimer filed on [1] disclaiming the terminal portion of the patent being reexamined which would extend beyond the expiration date of [2] has been reviewed and is accepted. The terminal disclaimer has been recorded.

Examiner Note:

1. In bracket 1, insert the date the terminal disclaimer was filed.
2. In bracket 2, list the Patent Number and/or Application Number (including series code and serial no.). Where an Application Number is listed, it must be preceded by the phrase --any patent granted on Application Number--.
3. If an assignment is submitted to support the terminal disclaimer, also use 14.34 to suggest that the assignment be separately submitted for recording in the Office.
4. See MPEP § 1490 for discussion of requirements for a proper terminal disclaimer.
5. For improper terminal disclaimers, see the form paragraphs which follow.

**>

¶ *14.24 Terminal Disclaimer Not Proper - Introductory Paragraph*

The terminal disclaimer filed on [1] disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of [2] has been reviewed and is NOT accepted.

Examiner Note:

1. In bracket 1, insert the date the terminal disclaimer was filed.
2. In bracket 2, list the Patent Number and/or Application Number (including series code and serial no.). Where an Application Number is listed, it must be preceded by the phrase --any patent granted on Application Number--.
3. One or more of the appropriate form paragraphs 14.26 to 14.32 MUST follow this form paragraph to indicate why the terminal disclaimer is not accepted.
4. Form paragraph 14.33 includes the full text of 37 CFR 3.73 and may be included in the Office action when deemed appropriate.
5. Form paragraph 14.35 may be used to inform applicant that an additional disclaimer fee will not be required for the submission of a replacement or supplemental terminal disclaimer.
6. Do not use in reexamination proceedings, use form paragraph 14.25 instead.

<

¶ *14.25 Terminal Disclaimer Not Proper - Introductory Paragraph (Reexamination Only)*

The terminal disclaimer filed on [1] disclaiming the terminal portion of the patent being reexamined which would extend beyond the expiration date of [2] has been reviewed and is NOT accepted.

Examiner Note:

1. In bracket 1, insert the date the terminal disclaimer was filed.
2. In bracket 2, list the Patent Number and/or the Application Number (including series code and serial no.). Where an Application Number is listed, it must be preceded by the phrase --any patent granted on Application Number--.
3. One or more of the appropriate form paragraphs 14.26 to 14.32 MUST follow this form paragraph to indicate why the terminal disclaimer is not accepted.
4. Form paragraph 14.33 includes the full text of 37 CFR 3.73 and may be included in the Office action when deemed appropriate.
5. Form paragraph 14.35 may be used to inform applicant that an additional disclaimer fee will not be required for the submission of a replacement or supplemental terminal disclaimer.

¶ *14.26 Does Not Comply With 37 CFR 1.321(b) and/or (c) "Sub-Heading" Only*

The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 and followed by one or more of the appropriate form paragraphs 14.26.01 to 14.27.03.

¶ *14.26.01 Extent of Interest Not Stated*

The person who has signed the disclaimer has not stated the extent of his/her interest, or the business entity's interest, in the application/patent. See 37 CFR 1.321(b)(3).

Examiner Note:

This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND 14.26.

¶ *14.26.02 Directed to Particular Claim(s)*

It is directed to a particular claim or claims, which is not acceptable, since "the disclaimer must be of a terminal portion of the term of the entire [patent or] patent to be granted." See MPEP § 1490.

Examiner Note:

This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ *14.26.03 Not Signed*

The terminal disclaimer was not signed.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ *14.26.04 Application/Patent Not Identified*

The application/patent being disclaimed has not been identified.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ *14.26.05 Application/Patent Improperly Identified*

The application/patent being disclaimed has been improperly identified since the number used to identify the [1] being disclaimed is incorrect. The correct number is [2].

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.
2. In bracket 1, insert --application-- or --patent--.
3. In bracket 2, insert the correct Application Number (including series code and serial no.) or the correct Patent Number being disclaimed.
4. A terminal disclaimer is acceptable if it includes the correct Patent Number or the correct Application Number or the serial number together with the proper filing date or the proper series code.

¶ *14.26.06 Not Signed by All Owners*

It was not signed by all owners and, therefore, supplemental terminal disclaimers are required from the remaining owners.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ *14.26.07 No Disclaimer Fee Submitted*

The disclaimer fee of $ [1] in accordance with 37 CFR 1.20(d) has not been submitted, nor is there any authorization in the application file to charge a specified Deposit Account or credit card.

Examiner Note:

1. In bracket 1, insert the fee for a disclaimer.
2. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26. If the disclaimer fee was paid for a terminal disclaimer which was not accepted, applicant does not have to pay another disclaimer fee when submitting a replacement or supplemental terminal disclaimer, and this form paragraph should not be used.

¶ *14.27.01 Lacks Clause of Enforceable Only During Period of Common Ownership*

It does not include a recitation that any patent granted shall be enforceable only for and during such period that said patent is commonly owned with the application(s) or patent(s) which formed the basis for the double patenting rejection. See 37 CFR 1.321(c)(3).

Examiner Note:

This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

**>

¶ *14.27.011 Lacks 37 CFR 1.321(d) statement for joint research agreement under 35 U.S.C. 103(c)(2)&(3)*

It does not include the waiver and enforceability provisions of 37 CFR 1.321(d). The terminal disclaimer must include a provision:

(1) waiving the right to separately enforce (a) any patent granted on that application or the patent being reexamined and (b) the reference patent, or any patent granted on the reference application which formed the basis of the double patenting; and

(2) agreeing that any patent granted on that application or patent being reexamined shall be enforceable only for and during such period that said patent and the reference patent, or any patent granted on the reference application, which formed the basis for the double patenting are not separately enforced.

See 37 CFR 1.321(d)(3).

Examiner Note:

This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26, and this paragraph should be followed by either form paragraph 14.27.07 or form paragraph 14.27.08.

<

¶ *14.27.02 Fails To Disclaim Terminal Portion of Any Patent Granted On Subject Application*

It fails to disclaim the terminal portion of any patent granted on the subject application.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND 14.26.

2. Use this form paragraph when the period disclaimed is not the correct period or when no period is specified at all.

3. When using this form paragraph, give an example of proper terminal disclaimer language using form paragraph 14.27.04 following this or the series of statements concerning the defective terminal disclaimer.

¶ *14.27.03 Fails To Disclaim Terminal Portion of Subject Patent*

It fails to disclaim the terminal portion of the subject patent.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND 14.26.

2. Use this form paragraph in a reissue application or reexamination proceeding when the period disclaimed is not the correct period or when no period is specified at all.

**>

¶ *14.27.04 Examples of Acceptable Terminal Disclaimer Language in Patent To Be Granted*

Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application was made, use:

The owner, ______________________, of __________ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number ______________, filed on ____________, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

II. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, use:

The owner, ______________________, of __________ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **reference patent** No. ______________ as the term of said prior patent is defined in 35 U.S.C. 154 and 173 , and as the term of said **reference patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **reference patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

Alternatively, Form PTO/SB/25 may be used for situation I, and Form PTO/SB/26 may be used for situation II; a copy of each form may be found at the end of MPEP § 1490.

Examiner Note:

1. To provide examples of acceptable terminal disclaimer language in a patent (e.g., for a reexamination situation), other than for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14:27.06.

2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.07 for making the disclaimer of the terminal portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.08 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

<

¶ *14.27.06 Examples of Acceptable Terminal Disclaimer Language in Patent (Reexamination Situation)*

Examples of acceptable language for making the disclaimer of the terminal portion of the patent being reexamined (or otherwise for an existing patent) follow:

I. If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application was made, or is otherwise believed to be applicable to the patent, use:

The patent owner hereby disclaims the terminal part of the instant patent, which would extend beyond the expiration date of the full statutory term of any patent granted on pending Application Number ____________, filed on ____________, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending application. The patent owner hereby agrees that the instant patent shall be enforceable only for and during such period that the instant patent and any patent granted on the above-listed pending application are commonly owned. This agreement is binding upon the patent owner, its successors, or assigns.

II. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, or is otherwise believed to be applicable to the patent, use:

The patent owner hereby disclaims the terminal part of the instant patent, which would extend beyond the expiration date of the full statutory term of reference patent No. ____________ as the term of said reference patent is defined in 35 U.S.C. 154 and 173, and as the term of said reference patent is presently shortened by any terminal disclaimer. The patent owner hereby agrees that the instant patent shall be enforceable only for and during such period that the instant patent and the reference patent are commonly owned. This agreement is binding upon the patent owner, its successors, or assign.

Examiner Note:

1. To provide examples of acceptable terminal disclaimer language in a patent to be granted on an application (generally, an application being examined), other than for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14.27.04.

2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.07 for making the disclaimer of the terminal portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.08 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

**>

¶ *14.27.07 Examples of Acceptable Terminal Disclaimer Language in Patent To Be Granted (activities undertaken within the scope of a joint research agreement)*

Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application was made, use:

The owner, ______________, of ______ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number ____________, filed on ____________, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application.

The owner of the instant application waives the right to separately enforce any patent granted on the instant application and any patent granted on the **reference** application. The owner of the instant application hereby agrees that any patent granted on the instant application and any patent granted on the **reference** application shall be enforceable only for and during such period that the instant application and the **reference** application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and any patent granted on the **reference** application, and are binding upon the owner of the instant application, its successors, or assigns.

Owner, or attorney/agent of record, of the instant application:
Signature:______________________
Printed/Typed name:______________

II. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, use:

The owner, ______________, of ______ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **reference patent** No. ______________, as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said **reference patent** is presently shortened by any terminal disclaimer.

The owner of the instant application waives the right to separately enforce the **reference patent** and any patent granted on the instant application. The owner of the instant application hereby agrees that the **reference patent** and any patent granted on the instant application shall be enforceable only for and during such period that the **reference patent** and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the owner of the instant application, its successors, or assigns.

Owner, or attorney/agent of record, of the instant application:
Signature:______________________
Printed/Typed name:______________

Examiner Note:

1. To provide examples of acceptable terminal disclaimer language in a patent (e.g., for a reexamination situation) for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14.27.08.
2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer in a situation other than one based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.04 for making the disclaimer of the terminal portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.06 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

¶ *14.27.08 Examples of Acceptable Terminal Disclaimer Language in Patent (Reexamination Situation; activities undertaken within the scope of a joint research agreement)*

Examples of acceptable language for making the disclaimer of the terminal portion of the patent being reexamined (or otherwise for an existing patent) follow:

I. If a provisional obviousness-type double patenting rejection over a Pending Application was made, or is otherwise believed to be applicable to the patent, use:

The patent owner hereby disclaims the terminal part of the instant patent, which would extend beyond the expiration date of the full statutory term of any patent granted on pending Application Number ____________, filed on ____________, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending application.

The patent owner waives the right to separately enforce the instant patent and the above-listed pending application. The patent owner agrees that the instant patent and any patent granted on the above-listed pending application shall be enforceable only for and during such period that the instant patent and the patent granted on the above-listed pending application are not separately enforced. The waiver, and this agreement, run with any patent granted on the above-listed pending application, and are binding upon the patent owner, its successors, or assigns.

Patent Owner, or attorney/agent of record:
Signature:______________________
Printed/Typed name:______________

II. If an obviousness-type double patenting rejection over a Reference Patent was made, or is otherwise believed to be applicable to the patent, use:

The patent owner hereby disclaims the terminal part of the instant patent, which would extend beyond the expiration date of the full statutory term of **reference patent** No. ______________, as the term of said **reference patent** is defined in 35 U.S.C. 154 and 173, and as the term of said **reference patent** is presently shortened by any terminal disclaimer.

The patent owner waives the right to separately enforce the instant patent and the **reference** patent. The patent owner agrees that the instant patent and the **reference patent** shall be enforceable only for and during such period that the instant patent and the **reference patent** are not separately enforced. The waiver, and this agreement, are binding upon the patent owner, its successors, or assigns.

Patent Owner, or attorney/agent of record:
Signature:______________________
Printed/Typed name:______________

Examiner Note:

1. To provide examples of acceptable terminal disclaimer language in a patent to be granted on an application (generally, an application being examined) for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14.27.07.
2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer in a situation other than one based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.04 for making the disclaimer of the terminal portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.06 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

<

¶ *14.28 Failure To State Capacity To Sign*

The person who signed the terminal disclaimer has failed to state his/her capacity to sign for the corporation, or other business entity or organization, and he/she has not been established as being authorized to act on behalf of the assignee.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND 14.26.

¶ *14.29 Not Recognized as Officer of Assignee - "Sub-Heading" Only*

The person who signed the terminal disclaimer is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

Examiner Note:

1. This form paragraph is to be used when the person signing the terminal disclaimer is not an authorized officer as defined in MPEP § 324.
2. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 and followed by form paragraphs 14.29.01 and/or 14.29.02 when appropriate. An attorney or agent of record is always authorized to sign the terminal disclaimer, even though there is no indication that he or she is an officer of the assignee.
3. Use form paragraph 14.29.02 to explain how an official, other than a recognized officer, may properly sign a terminal disclaimer.

¶ *14.29.01 Attorney/Agent Not of Record*

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.29.
2. An attorney or agent, however, may sign a terminal disclaimer provided he/she is an attorney or agent of record or is established as an appropriate official of the assignee. To suggest to the attorney or agent, not of record, how he/she may establish status as an appropriate official of the assignee to sign a terminal disclaimer, use form paragraph 14.29.02.

¶ *14.29.02 Criteria To Accept Terminal Disclaimer When Signed by a Non-Recognized Officer*

It would be acceptable for a person, other than a recognized officer, to sign a terminal disclaimer, provided the record for the application includes a statement that the person is empowered to sign terminal disclaimers and/or act on behalf of the assignee.

Accordingly, a new terminal disclaimer which includes the above empowerment statement will be considered to be signed by an appropriate official of the assignee. A separately filed paper referencing the previously filed terminal disclaimer and containing a proper empowerment statement would also be acceptable.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.29.
2. When form paragraph 14.29 is used to indicate that a terminal disclaimer is denied because it was not signed by a recognized officer nor by an attorney or agent of record, this form paragraph should be used to point out one way to correct the problem.
3. While an indication of the person's title is desirable, its inclusion is not mandatory when this option is employed.
4. A sample terminal disclaimer should be sent with the Office action.

**>

¶ *14.30 No Evidence of Chain of Title to Assignee - Application*

The assignee has not established its ownership interest in the application, in order to support the terminal disclaimer. There is no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original inventor(s) to the assignee and a statement affirming that the documentary evidence of the chain of title form the original owner to the assignee was, or concurrently is being, submitted for recordatoin pursuant to 37 CFR 3.11, or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the Office (37 CFR 3.73(b)).

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25.
2. Where an attorney or agent of record signs a terminal disclaimer, there is no need to provide a statement under 37 CFR 3.73(b). Thus, this form paragraph should not be used.
3. It should be noted that the documentary evidence or the specifying of reel and frame number may be found in the terminal disclaimer itself or in a separate paper.

¶ *14.30.01 No Evidence of Chain of Title to Assignee - Patent*

The assignee has not established its ownership interest in the patent, in order to support the terminal disclaimer. There is no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original inventor(s) to the assignee and a statement affirming that the documentary evidence of the chain of title form the original owner to the assignee was, or concurrently is being, submitted for recordatoin pursuant to 37 CFR 3.11, or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the Office (37 CFR 3.73(b)).

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25.
2. Where an attorney or agent of record signs a terminal disclaimer, there is no need to provide a statement under 37 CFR 3.73(b). Thus, this form paragraph should not be used.
3. It should be noted that the documentary evidence or the specifying of reel and frame number may be found in the terminal disclaimer itself or in a separate paper in the application.

<

¶ *14.30.02 Evidence of Chain of Title to Assignee - Submission Not Signed by Appropriate Party - Terminal Disclaimer Is Thus Not Entered*

The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission establishing the ownership interest is authorized to sign the submission (37 CFR 3.73(b)).

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25.
2. Where an attorney or agent of record signs a terminal disclaimer, there is no need to provide any statement under 37 CFR 3.73(b). Thus, this form paragraph should not be used.

3. This form paragraph should be followed by one of form paragraphs 14.16.02 or 14.16.03. In rare situations where BOTH form paragraphs 14.16.02 and 14.16.03 do not apply and thus cannot be used, the examiner should instead follow this form paragraph with a detailed statement of why the there is no authorization to sign.

4. Use form paragraph 14.16.06 to point out one way to correct the problem.

¶ *14.32 Application/Patent Which Forms Basis for Rejection Not Identified*

The application/patent which forms the basis for the double patenting rejection is not identified in the terminal disclaimer.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25.

2. Use this form paragraph when no information is presented. If incorrect information is contained in the terminal disclaimer, use form paragraphs 14.26 and 14.26.05.

**>

¶ *14.33 37 CFR 3.73 - Establishing Right of Assignee To Take Action*

The following is a statement of 37 CFR 3.73:

37 CFR 3.73 Establishing right of assignee to take action.

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to § 3.11; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

¶ *14.34 Requirement for Statement To Record Assignment Submitted With Terminal Disclaimer*

The assignment document filed on [1] is not acceptable as the documentary evidence required by 37 CFR 3.73. The submission of the documentary evidence was not accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11. See 37 CFR 3.11 and MPEP § 302.

Examiner Note:

1. In bracket 1, insert the date the assignment document was filed.

2. This form paragraph should be used when an assignment document (an original, facsimile, or copy) is submitted to satisfy 37 CFR 3.73(b) was not accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation, and the documentary evidence has not been recorded among the assignment records of the Office.

<

¶ *14.35 Disclaimer Fee Not Required Twice - Applicant*

It should be noted that applicant is not required to pay another disclaimer fee as set forth in 37 CFR 1.20(d) when submitting a replacement or supplemental terminal disclaimer.

Examiner Note:

1. This form paragraph can be used to notify an applicant that another disclaimer fee will not be required when a replacement or supplemental terminal disclaimer is submitted.

2. Use form paragraph 14.35.01 for providing notification to patent owner, rather than an applicant.

¶ *14.35.01 Disclaimer Fee Not Required Twice - Patent Owner*

It should be noted that patent owner is not required to pay another disclaimer fee as set forth in 37 CFR 1.20(d) when submitting a replacement or supplemental terminal disclaimer.

Examiner Note:

This form paragraph can be used to notify a patent owner that another disclaimer fee will not be required when a replacement or supplemental terminal disclaimer is submitted.

¶ *14.36 Suggestion That "Applicant" Request a Refund*

Since the required fee for the terminal disclaimer was previously paid, applicant's payment of an additional terminal disclaimer fee is not required. Applicant may request a refund of this additional terminal disclaimer fee by submitting a written request for a refund and a copy of this Office action to: Mail Stop 16, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. This form paragraph should be used to notify applicant that a refund can be obtained if another terminal disclaimer fee was paid when a replacement or supplemental terminal disclaimer was submitted.

2. Note - If applicant has authorized or requested a fee refund to be credited to a specific Deposit Account or credit card, then an appropriate credit should be made to that Deposit Account or credit card and this paragraph should NOT be used.

3. Use form paragraph 14.36.01 for providing notification to patent owner, rather than an applicant.

¶ *14.36.01 Suggestion That "Patent Owner" Request a Refund*

Since the required fee for the terminal disclaimer was previously paid, patent owner's payment of an additional terminal disclaimer fee is not required. Patent owner may request a refund of this additional terminal disclaimer fee by submitting a written request for a refund and a copy of this Office action to: Mail Stop 16, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. This form paragraph should be used to notify patent owner that a refund can be obtained if another terminal disclaimer fee was paid when a replacement or supplemental terminal disclaimer was submitted.

2. Note - If patent owner has authorized or requested a fee refund to be credited to a specific Deposit Account or credit card, then an appropriate credit should be made to that Deposit Account or credit card and this form paragraph should NOT be used.

**>

¶ *14.37 Samples of a Terminal Disclaimer Over a Pending Application and Assignee Statement Enclosed*

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome a provisional obviousness-type double patenting rejection over a pending application (37 CFR 1.321(b) and (c)).

Also enclosed is a sample Statement Under 37 CFR 3.73(b) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel_____, Frame_____" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:______ To:______" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

Examiner Note:

1. This form paragraph can be used to provide applicant samples of a terminal disclaimer which contains the necessary clauses to overcome a provisional obviousness-type double patenting rejection over a pending application and a Statement to be signed by an assignee to ensure compliance with 37 CFR 3.73(b).

2. Note that the requirements for compliance with 37 CFR 3.73 (b) have been made more liberal, such that certain specifics of the sample statement are no longer required. At present, in order to comply with 37 CFR 3.73(b), the assignee's ownership interest must be established by (a) filing in the application or patent evidence of a chain of title from the original owner to the assignee and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11, or (b) specifying in the record of the application or patent where such evidence is recorded in the Office (e.g., reel and frame number, etc.). The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee.

(See your Technology Center Paralegal or Special Program Examiner for copies of the sample terminal disclaimer and Statement Under 37 CFR 3.73(b) to enclose with the Office action. Alternatively, it is permissible to copy the sample terminal disclaimer found after MPEP § 1490 and the Sample Statement Under 37 CFR 3.73(b) found after MPEP § 324.)

¶ *14.38 Samples of a Terminal Disclaimer Over a Prior Patent and Assignee Statement Enclosed*

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome an obviousness-type double patenting rejection over a prior patent (37 CFR 1.321(b) and (c)).

Also enclosed is a sample Statement Under 37 CFR 3.73(b) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel_____, Frame_____" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:______ To:______" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

Examiner Note:

1. This form paragraph can be used to provide applicant samples of a terminal disclaimer which contains the necessary clauses to overcome an obviousness-type double patenting rejection over a prior patent and a Statement to be signed by an assignee to ensure compliance with 37 CFR 3.73(b).

2. Note that the requirements for compliance with 37 CFR 3.73 (b) have been made more liberal, such that certain specifics of the sample statement are no longer required. At present, in order to comply with 37 CFR 3.73(b), the assignee's ownership interest must be established by (a) filing in the application or patent evidence of a chain of title from the original owner to the assignee and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11, or (b) specifying in the record of the application or patent where such evidence is recorded in the Office (e.g., reel and frame number, etc.). The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee.

(See your Technology Center Paralegal or Special Program Examiner for copies of the sample terminal disclaimer and Statement Under 37 CFR 3.73(b) to enclose with the Office action. Alternatively, it is permissible to copy the sample terminal disclaimer found after MPEP § 1490 and the Sample Statement Under 37 CFR 3.73(b) found after MPEP § 324.)

¶ *14.39 Sample Assignee Statement Under 37 CFR 3.73(b) Enclosed*

Enclosed with this Office action is a sample Statement under 37 CFR 3.73(b) which an assignee may use in order to ensure compliance with the Rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel_____, Frame_____" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:______ To:______" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b).

Examiner Note:

1. This form paragraph can be used to provide applicant a sample of a Statement to be signed by an assignee to ensure compliance with 37 CFR 3.73(b).

2. Note that the requirements for compliance with 37 CFR 3.73 (b) have been made more liberal, such that certain specifics of the sample statement are no longer required. At present, in order to comply with 37 CFR 3.73(b), the assignee's ownership interest must be established by (a) filing in the application or patent evidence of a chain of title from the original owner to the assignee and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11, or (b) specifying in the record of the application or patent where such evidence is recorded in the Office (e.g., reel and frame number, etc.). The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee.

(See your Technology Center Paralegal or Special Program Examiner for a copy of the sample Statement Under 37 CFR 3.73(b) to enclose with the Office action. Alternatively, it is permissible to copy the sample Statement Under 37 CFR 3.73(b) found after MPEP § 324.)

<

VII. WITHDRAWING A RECORDED TERMINAL DISCLAIMER

If timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent, or in a reexamination proceeding, before the reexamination certificate issues. After a patent or reexamination certificate issues, it is unlikely that a recorded terminal disclaimer will be nullified.

A. Before Issuance Of Patent

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA).

Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 CFR 1.182 requesting withdrawal of the recorded terminal disclaimer. Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered. The filing of a continuing application other than a CPA, while abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer. The filing of a Request for Continued Examination (RCE) of an application under 37 CFR 1.114 will not nullify the effect of a terminal disclaimer, since a new application has not been filed, but rather prosecution has been continued in the existing application.

B. After Issuance Of Patent

The mechanisms to correct a patent — Certificate of Correction (35 U.S.C. 255), reissue (35 U.S.C. 251), and reexamination (35 U.S.C. 305) — are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner — e.g., intervening rights in the case of a reissue patent. See, e.g., *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U.S. 477, 24 USPQ 308 (1935).

Certificates of Correction (35 U.S.C. 255) are available for the correction of an applicant's mistake. The scope of this remedial provision is limited in two ways — by the nature of the mistake for which correction is sought and the nature of the proposed correction. *In re Arnott*, 19 USPQ2d 1049 (Comm'r Pat. 1991). The nature of the mistake for which correction is sought is limited to those mistakes that are:

(A) of a clerical nature,

(B) of a typographical nature, or

(C) of a minor character.

The nature of the proposed correction is limited to those situations where the correction does not involve changes which would:

(A) constitute new matter, or

(B) require reexamination.

A mistake in filing a terminal disclaimer does not fall within any of the categories of mistake for which a certificate of correction of applicant's mistake is permissible, and any attempt to remove or nullify the effect of the terminal disclaimer would typically require reexamination of the circumstances under which it was filed.

Although the remedial nature of reissue (35 U.S.C. 251) is well recognized, reissue is not available to correct all errors. It has been the Office position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. First, the reissue statute only authorizes the Director of the USPTO to reissue a patent "for the unexpired part of the term of the original patent." Since the granting of a reissue patent without the effect of a recorded terminal disclaimer would result in extending the term of the original patent, reissue under these circumstances would be contrary to the statute. Second, the principle against recapturing something that has been intentionally dedicated to the public dates back to *Leggett v. Avery*, 101 U.S. 256 (1879). The attempt to restore that portion of the patent term that was dedicated to the public to secure the grant of the original patent would be contrary to this recapture principle. Finally, applicants have the opportunity to challenge the need for a terminal disclaimer during the prosecution of the application that issues as a patent. "Reissue is not a substitute for Patent Office appeal procedures." *Ball Corp. v. United States*, 729 F.2d 1429, 1435, 221 USPQ 289, 293 (Fed. Cir. 1984). Where applicants did not challenge the propriety of the examiner's obvious-type double patenting rejection, but filed a terminal disclaimer to avoid the rejection, the filing of the terminal disclaimer did not constitute error within the meaning of 35 U.S.C. 251. *Ex parte Anthony*, 230 USPQ 467 (Bd. App. 1982), *aff'd*, No. 84-1357 (Fed. Cir. June 14, 1985).

Finally, the nullification of a recorded terminal disclaimer would not be appropriate in a reexamination proceeding. There is a prohibition (35 U.S.C. 305) against enlarging the scope of a claim during a reexamination proceeding. As noted by the Board in *Anthony*, *supra*, if a terminal disclaimer was nullified, "claims would be able to be sued upon for a longer period than would the claims of the original patent. Therefore, the vertical scope, as opposed to the horizontal scope (where the subject matter is enlarged), would be enlarged."

**>

PTO/SB/25 (07-06)
Approved for use through 09/30/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING "REFERENCE" APPLICATION	Docket Number (Optional)

In re Application of:

Application No.:

Filed:

For:

The owner*, ________________________________, of ________ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending reference Application Number ____________________, filed on ____________________, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the reference application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on said reference application, "as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application," in the event that: any such patent: granted on the pending reference application: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney or agent of record. Reg. No. ____________

______________________________ Signature ______________ Date

______________________________ Typed or printed name

______________ Telephone Number

☐ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this statement. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

PTO/SB/26 (07-06)
Approved for use through 09/30/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT	Docket Number (Optional)

In re Application of:

Application No.:

Filed:

For:

The owner*, ______________________, of ____________ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term prior patent No. ______________ as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later:
- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney or agent of record. Reg. No.______________

______________________________ Signature ______________ Date

______________________________ Typed or printed name

______________ Telephone Number

☐ Terminal disclaimer fee under 37 CFR 1.20(d) included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

If all the above-stated conditions are satisfied, a Certificate of Correction can be used to amend the patent to make reference to a prior copending application, or to correct an incorrect reference to the prior copending application, for benefit claims under 35 U.S.C. 120 and 365(c).

If any of the above-stated conditions is not satisfied, the filing of a reissue application (see MPEP § 1401 - § 1460) may be appropriate to pursue the desired correction of the patent for benefit claims under 35 U.S.C. 120 and 365(c).

1485 Handling of Request for Certificates of Correction [R-5]

A request for a Certificate of Correction should be addressed to:

>Commissioner for Patents
Office of Patent Publication<
ATTN: Certificate of Correction Branch
**
P.O. Box 1450
Alexandria, VA 22313-1450

Requests for Certificates of Correction will be forwarded to the Certificate of Correction Branch of the Office of Patent Publication, where they will be listed in a permanent record book.

If the patent is involved in an interference, a Certificate of Correction under 37 CFR 1.324 will not be issued unless a corresponding motion under 37 CFR 41.121(a)(2) or 41.121(a)(3) has been granted by the administrative patent judge. Otherwise, determination as to whether an error has been made, the responsibility for the error, if any, and whether the error is of such a nature as to justify the issuance of a Certificate of Correction will be made by the Certificate of Correction Branch. If a report is necessary in making such determination, the case will be forwarded to the appropriate group with a request that the report be furnished. If no certificate is to issue, the party making the request is so notified and the request, report, if any, and copy of the communication to the person making the request are placed in the file wrapper (for a paper file) or entered into the file history (for an IFW file), and entered into the "Contents" for the file by the Certificate of Correction Branch. The case is then returned to the patented files. If a certificate is to issue, it will be prepared and forwarded to the person making the request by the Office of Patent Publication. In that case, the request, the report, if any, and a copy of the letter transmitting the Certificate of Correction to the person making the request will be placed in the file wrapper (for a paper file) or entered into the file history (for an IFW file), and entered into the "Contents" for the file.

Applicants, or their attorneys or agents, are urged to submit the text of the correction on a special Certificate of Correction form, PTO/SB/44 (also referred to as Form PTO-1050), which can serve as the camera copy for use in direct offset printing of the Certificate of Correction.

Where only a part of a request can be approved, or where the Office discovers and includes additional corrections, the appropriate alterations are made on the form PTO/SB/44 by the Office. The patentee is notified of the changes on the Notification of Approval-in-part form PTOL-404. The certificate is issued approximately 6 weeks thereafter.

Form PTO/SB/44 should be used exclusively regardless of the length or complexity of the subject matter. Intricate chemical formulas or page of specification or drawings may be reproduced and mounted on a blank copy of PTO/SB/44. Failure to use the form has frequently delayed issuance since the text must be retyped by the Office onto a PTO/SB/44.

The exact page and line number where the errors occur in the application file should be identified on the request. However, on form PTO/SB/44, only the column and line number in the printed patent should be used.

The patent grant should be retained by the patentee. The Office does not attach the Certificate of Correction to patentee's copy of the patent. The patent grant will be returned to the patentee if submitted.

Below is a sample form illustrating a variety of corrections and the suggested manner of setting out the format. Particular attention is directed to:

(A) Identification of the exact point of error by reference to column and line number of the printed patent for changes in the specification or to claim number and line where a claim is involved.

(B) Conservation of space on the form by typing single space, beginning two lines down from the printed message.